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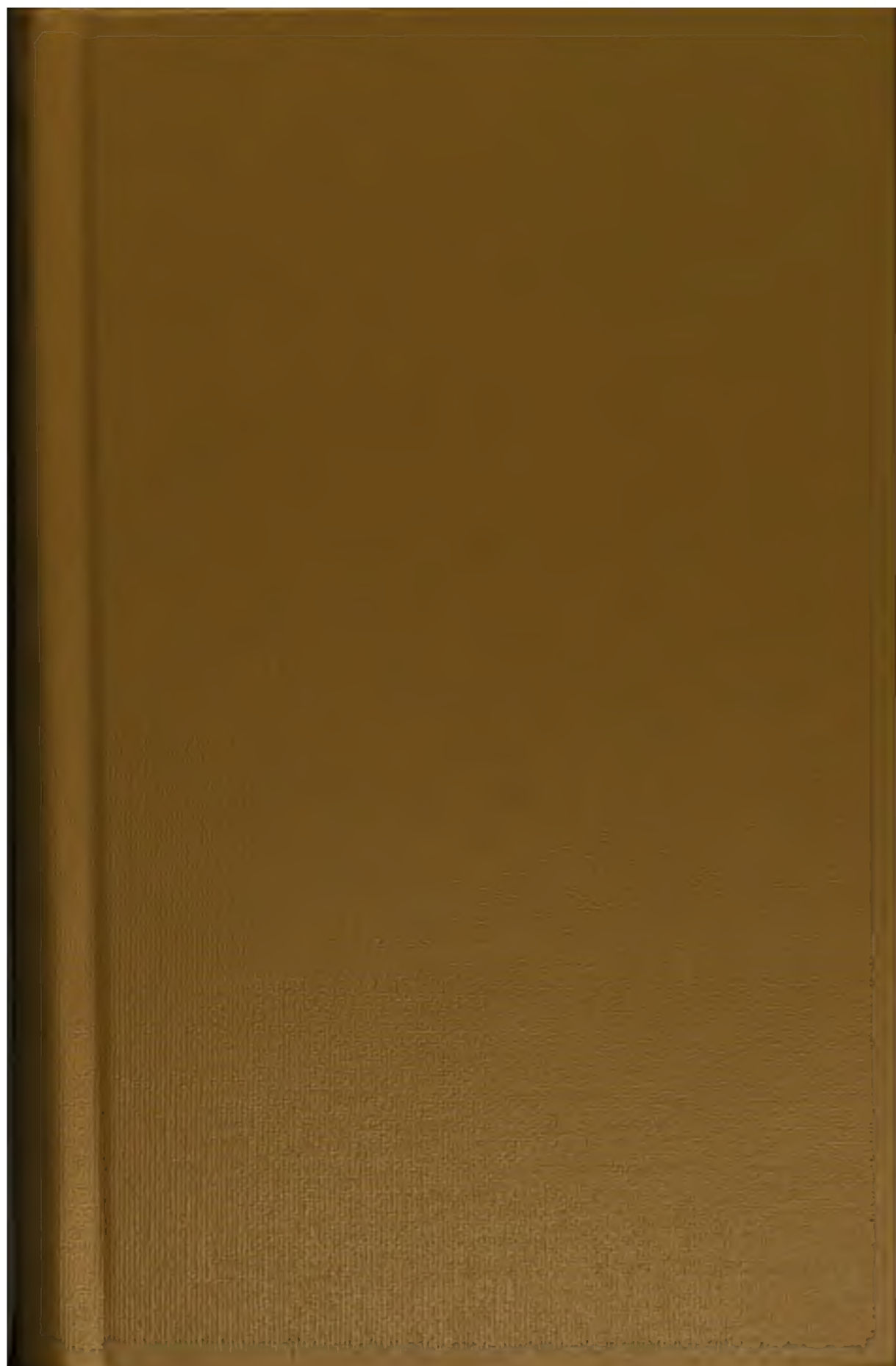
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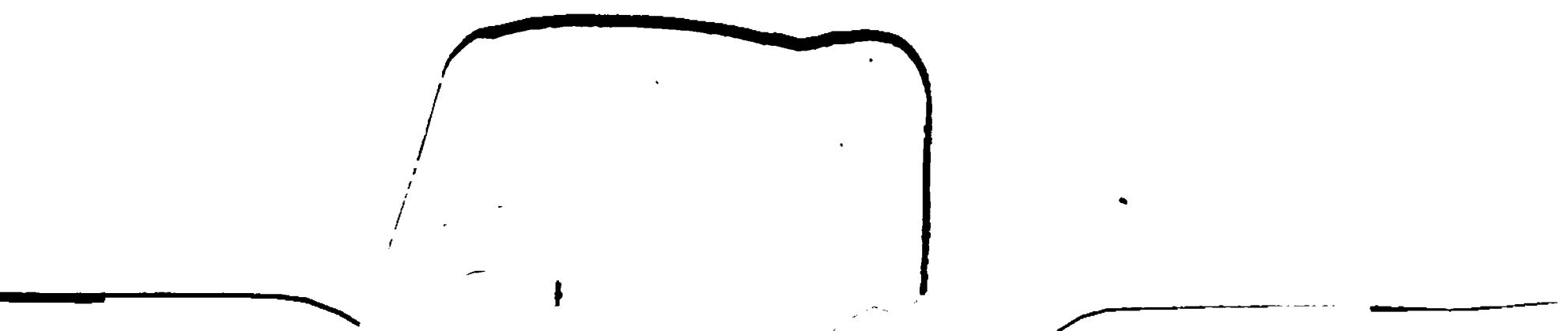
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A COLLECTION
OF
PATENT CASES,
DECIDED IN THE
SUPREME AND CIRCUIT COURTS
OF THE
UNITED STATES,
FROM THEIR ORGANIZATION TO THE YEAR 1850.
WITH
NOTES, AND A COPIOUS INDEX TO THE SUBJECT-MATTER.

BY JAMES B. ROBB,
COUNSELLOR AT LAW.

VOL. I.

BOSTON:
LITTLE, BROWN AND COMPANY.

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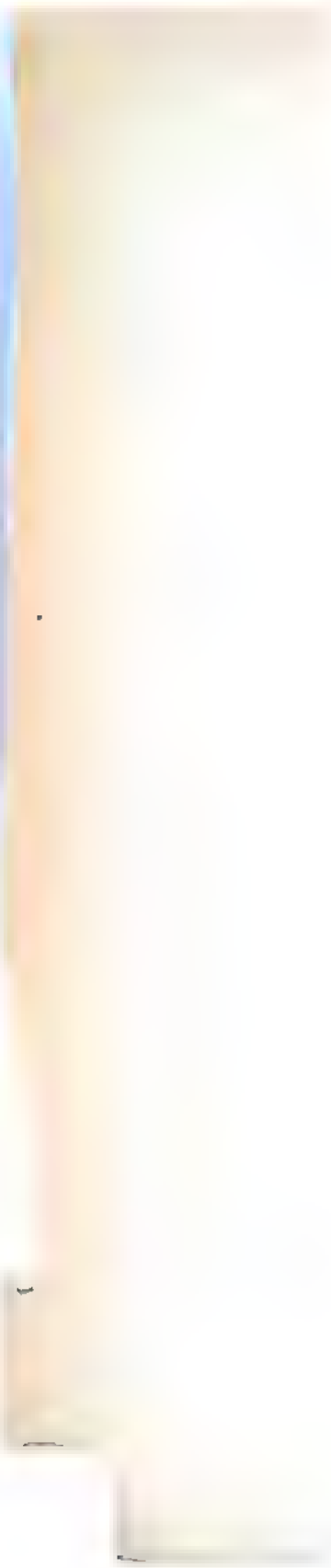
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RIVERSIDE, CAMBRIDGE:
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TO THE
HON. PELEG SPRAGUE,
JUDGE OF THE UNITED STATES FOR THE DISTRICT OF
MASSACHUSETTS,
THESE VOLUMES
ARE, WITH SENTIMENTS OF SINCERE RESPECT AND AFFECTION,
INSCRIBED,
BY THE EDITOR.



PREFACE.

THE collection of cases embraced in these two volumes, contain all of the Patent Cases decided in the Circuit Courts of the United States and reported prior to the first of January, 1850; and all of the cases decided in the Supreme Court of the United States to the same period. They are arranged as nearly as may be in chronological order; numbering one hundred and twenty-four cases, selected from sixty volumes of Reports, namely: Washington, Brockenboro', Peters, McLean, Paine, Gilpin, Gallison, Mason, Wallace, Sumner, Baldwin, Story, and Woodbury and Minot, of the Circuit Court Reports;—and Cranch, Wheaton, Peters, and Howard, of the Supreme Court Reports, thus embracing all of the decisions illustrating the principles of the Patent Laws of the United States. A few cases have been decided by the State Courts, involving, incidentally, questions arising under the Patent Laws, which have been omitted, as not affecting the principles or doctrines settled by the United States Courts. Exclusive jurisdiction of these subjects, in the administration of the Patent Laws, being vested in the United States Circuit and Supreme Courts.

The decisions upon the earlier statutes, in all cases which have been modified by subsequent legislation, have been appropriately noted, with reference to the statutes, a collection of which will be found in the Appendix, with marginal notes indicating the alterations and additional provisions.

The Index embraces all of the topics discussed and decided by these courts, and is so full as to greatly abridge the labor of search for the requisite authority.

It is proposed to continue this collection by the addition, from time to time, of volumes embracing the cases decided subsequent to the first of January, 1850, if the facilities afforded hereby shall be deemed sufficient to warrant it.

It is much to be regretted that the numerous decisions of his Honor Judge Sprague, in the Circuit Court for the District of Massachusetts, have not been reported. Their luminous exposition of the principles of the Patent Laws, in their application to the increasing and ever-varying mechanical developments of the laws of phenomena, in their progress from obvious to refined and intangible distinctions, which characterize the cases which he has been called upon to decide, would not only have enhanced the value of these volumes, but would have greatly enriched the science of mechanical jurisprudence.

Such of these decisions, however, as may have been preserved, will be collected and embraced in the subsequent volumes of these reports.

JAMES B. ROBB.

BOSTON, MAY 1st, 1854.

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A COLLECTION
OF
PATENT CASES
DECIDED IN THE
CIRCUIT AND SUPREME COURTS
OF
THE UNITED STATES.

REUTGEN v. KANOWBS AND GRAUNT.

[1 Wash. 168.]

Action for breach of a patent-right.

Whether the plaintiff was the first inventor of the machine for which he had obtained a patent, is a question for the decision of the jury; but they must be satisfied, that he is so in reference to all the world. *Aliter*, in England, the statute of James I. speaking only of new manufactures, *within the realm*.¹

Whether the improvement made by the defendant, in the machine invented by the plaintiff, is in *principle*, or in *form*, and *proportion*, is a question for the decision of the jury. If the improvement is in the principle, the inventor of the improvement has as much right to use the original invention, as the inventor has to use the improvement. An improvement in *form*, or *proportions*, gives no right.

Whether the specification has disclosed the whole truth, relative to the invention, or discovery? Whether there has been a concealment with a view to deceive? Is the concealment material? Could an *artist*, after the patent-right has expired, construct such a machine, by reference to the specification? These are questions for the decision of the jury.

¹ 2 Salkeld, 447.

Reutgen v. Kanowrs and Graunt. 1 Wash.

After an agreement between an original inventor of a machine, and the inventor of an improvement upon the machine, that they would mutually use the same, the patent should have issued in the names of both inventors; and the plaintiff, by taking out a patent in his own name, committed a fraud, and is to be considered as a trustee for the defendant. Such conduct may not entitle the defendant to a *nonsuit*, but the jury may give the plaintiff no more than nominal damages.

What will be considered as a license to use the invention, for which a patent has been obtained.

A plaintiff, in an action for a violation of a patent-right, may recover damages against one of two defendants, although the evidence given did not apply to both, for all torts are joint and several; and a plaintiff may recover damages against one defendant, although the other be acquitted. *Aliter*, in actions on contract.

THIS was an action to recover damages for the invasion of the plaintiff's patent-right to a machine for rounding [* 169] iron. It appeared in evidence, that the defendant, Kanowrs, was a farmer, and had on his farm, a common tilt, or hammer and anvil, worked by water. The plaintiff, a German, and poor, informed Kanowrs that he had invented a machine for rounding iron; but, from want of funds, had not been able to bring his theory to practice. He proposed to Kanowrs, to convert his common tilt into such a machine, and that he would work at it for the benefit of Kanowrs, for a certain sum for each ton of such iron which he should make. Having disclosed his plan, which was to use hammers of different concaves, Kanowrs objected to that, and proposed, instead of different hammers, the use of swedges. After some disagreement, whose plan should be adopted, a compromise took place, by agreeing first to try the swedges, which was done, and found to answer so well that they were never altered. The plaintiff, after working a year or two for Kanowrs at this tilt, in 1797, took a lease of it, (together with a part of the farm,) for three years; in which was a covenant, on the part of the plaintiff, to deliver back, at the end of the term, the tilt, with every thing belonging to it, in as good condition as he had received it. This was accord-

Reutgen v. Kanowrs and Graunt. 1 Wash.

ingly done; and the plaintiff, having thus acquired the means, he removed from Kanowrs'; and, in 1801, erected a tilt, precisely like the one he had left. The defendant, Kanowrs, then rented the old tilt to the other defendant, Graunt, who has continued to use it ever since. It was proved that the plaintiff and Kanowrs were to be in partnership in the benefits of this discovery, and were to obtain a patent in their joint names. But the plaintiff took it out in his own name, in the year 1796; and it is not accounted for, how the defendant's name was omitted. One witness said, that he had, since the erection of this machine, seen imported bolts, which appeared to him to have been rounded with a similar machine.

The cause was argued by Dallas and Sergeant, for plaintiff, and by Messrs. Ingersoll and Charles J. Ingersoll for defendants. The objection to the plaintiff's recovery were, that the machine * used by defendant [* 170] was different in principle from that mentioned in the plaintiff's specification; that there was sufficient evidence for the jury to say, the plaintiff was not the original inventor, but had brought it with him from Germany; that he could not, at any rate recover, as there was a partnership agreement between the parties, sufficient to constitute the plaintiff a trustee for defendant, Kanowrs; that the lease from Kanowrs to plaintiff was an acknowledgment of his right to the machine in question, the only one which it was pretended the defendants had used; and, lastly, that there being no evidence that Kanowrs had ever used the machine himself; this action, being joint against Kanowrs and Graunt, the plaintiff cannot recover, though he has proved it to have been used by Graunt.

The demand of the plaintiff was, under the Act of 17th April, 1800, for three times the value of the damages sustained.

Reutgen v. Kanowrs and Graunt. 1 Wash.

WASHINGTON, J., charged the jury. Your first inquiry is, whether the plaintiff was the original inventor of the machine mentioned in his patent and specification. One witness has stated, that he has seen imported bolts, since those made by the plaintiff, which seemed to have been made with the same machine. Whether the invention is of European origin, and imported here by the plaintiff, or has, since the erection of his machine, been carried to Europe, is a question most proper for your determination. It is only necessary for me to state, that, if the invention was brought over, that is, if it appears that the plaintiff was not the original inventor, in reference to other parts of the world as well as America, he is not entitled to a patent. This point has been decided otherwise in England, in consequence of the expression of the statute of James I., which speaks of new manufactures *within the realm*.

Your second inquiry is, have the defendants, or either of them, used a machine similar to the one mentioned in the plaintiff's patent and specification. The specification states the parts to be, a strong platform, of a given form, [* 171] with two *upright posts for a hammer to move in, and to be operated by a cog-wheel, connected with the handle of the hammer ; the force, water, or any thing else ; corresponding concaves in the hammer and anvil. The machine used by the defendant, Graunt, is of that description ; but in addition, swedges are used. The question is, is the defendant's improvement of swedges, an improvement on the *principle*, or the *form*, or *proportions* of the plaintiff's machine ; if the first, he has as much right to use his improvement, as the plaintiff has to use his original invention. If otherwise, and the defendant has used the original invention, thus altered, it is a violation of the plaintiff's right. .

The next inquiry is closely connected with the last. Does the specification contain the whole truth, relative to the dis-

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covery; and if not, has it been concealed *with a view to deceive*? As to the materiality of the thing concealed, could an artist, after plaintiff's right is expired, construct such a machine by looking at the specification? This also is a question for the jury.

I have hurried over these points, because it strikes the Court, that there remain to be considered much more important objections to the plaintiff's right to recover.

It is in proof (if the witnesses are credited by the jury) that the machine used by the defendant Graunt, was erected on Kanowrs' land, at his expense. That before it was done, Kanowrs, upon hearing the plan, suggested the improvement of swedges, which was adopted, and has since received the plaintiff's approbation. That the plaintiff frequently acknowledged the joint right of the defendant, to the invention, as partnership property; and that the patent was to be taken in their joint names. If the jury are satisfied of these facts, and that the defendant did not relinquish his right to a joint interest in the patent-right, then the plaintiff was guilty of a fraud, in obtaining it in his own name; he is in equity a trustee for the defendant, and though possibly, at law, a verdict must be rendered for plaintiff, still, the jury may give merely nominal damages.

* But there is another point still stronger. The [* 172] law gives an action against any person who violates the right of the plaintiff, *without his consent in writing*. Now, this machine was erected on the defendant's land, by the plaintiff, and at the defendant Kanowrs' expense. After this, the plaintiff took a lease of it for three years; thereby acknowledging the right of the defendant, Kanowrs, to this particular machine, and covenants to deliver it up to him at the end of the term, with every thing belonging to it, in as good order as he received it. That is, to deliver up, not the hammer and anvil in its original form, but the whole tilt, with the im-

Reutgen v. Kanowrs and Graunt. 1 Wash.

provements made on it by the plaintiff. Now, this covenant acknowledges the right of Kanowrs to this identical machine, and necessarily the right to use it. If he has granted the tilt to the defendant, he has, in law, granted the use of it; and consequently he cannot now say, that the defendant has used it without his license in writing. If he has a right to the machine, and to the use of it, he has a right to work it himself, or by his servants, or to lease it out to any other person.

As to the last point made by the defendant's counsel, I am of opinion, that if the above points were in favor of the plaintiff, he might recover against Graunt, though no proof were given against Kanowrs. For all torts are joint, as well as several, and the plaintiff may recover a verdict against one, though the other defendant be acquitted: otherwise, in contract.

Jury found for the defendant.

NOTE. — If the contract of several, be joint, and either of the parties be sued, he may plead in abatement, that the others are not joined; but he cannot take advantage of it at the trial; although it appear on the face of the declaration, that there are other parties to the contract. But, if one agree or bind himself to several, and one sue, the defendant may demur, upon oyer, of the contract; or in assumpsit, he may take advantage of it on the trial. 2 Blac. Rep. 696. 1 Saund. 154. n. 291.

If, in trespass against two, they both plead jointly, a several verdict cannot be given against all, if all be *found guilty*. But, if they [* 173] sever in their *pleas, several damages may be assessed. The jury may find them severally guilty as to part, and not guilty as to part; but may assess damages severally. 1 Esp. N. P. 419, 420. Bull. 93. 2 Strange, 1140. 5 Burr. 2790.

In all cases of trespass, the jury may find one defendant guilty, and the other not guilty. 1 Esp. N. P. 322. But in contracts, if the action is against several, and it cannot be supported against all, it wholly fails. See 3 East, 62. Evans's Pothier, 2 vol. 67. If one of the joint contractors be an infant, the other two may be sued; and if they plead in abatement, the plaintiff may reply the infancy of that one. But if he sue all, and one plead his infancy, judgment must be given against the plaintiff. 2 Evans's Pothier, 67. This is stated in a note, but the authority is not given. — W.

Evans v. Chambers. 2 Wash.

EVANS v. CHAMBERS.

[2 Wash. 125.]

Action for a violation of a patent-right.

If the allegations and suggestions in the petition for a patent are substantially recited in the patent, it will be sufficient; but the omission to do this will invalidate it.

THIS was an action for infringing the plaintiff's patent-right to certain improvements made in the manufactory of wheat, &c., by means of a hopperboy. The petition, the patent, dated 18th December, 1790, and the specification, were read, with proof that the defendant had erected similar machinery in his mill without permission.

Hare and Binney, for plaintiff.

Rawle, for defendant.

A nonsuit was moved for on the following grounds. First, that the patent does not recite that a petition was presented, and the suggestions and allegations of which are recited in the patent. It begins with reciting that the plaintiff "hath invented," &c. Second; the allegations and suggestions of the petition are not recited. Third; there is an interlineation in the patent, and it is this alone which speaks of the hopperboy. This avoids the patent, as it will any deed. That it was interlined after executed, is to be presumed; 1 Dall. 64. Fourth; it does not appear that the patent was recorded. Fifth; the patent is for more than the discovery, and it is therefore void; Bull. N. P. 77. The discovery is only of the cross-piece to the upright shaft for moving and cooling the flour; and it has been proved that the upright shaft, with a different kind of cross-piece, had been used long before the date of this patent; so that the patent gives the exclusive use to that in which the plaintiff was not entitled to the exclusive property.

Evans v. Chambers. 2 Wash.

[* 126] * For the defendant, it was stated, that the law does not require that the presentation of a petition should be recited. Second ; we have produced the petition and the material suggestions are recited. Third ; it is too late to object to the patent, on account of the interlineation, after it has been read. Fourth ; the recording of the patent is merely directory to the officer. The right vests independent of it, by the express words of the act of 1790. Fifth ; the patent only grants a right to the upright shaft and the other parts of the machinery, with the improvement of the hopperboy annexed. No person is precluded from using every part of the machine, without the newly invented hopperboy.

BY THE COURT. The second ground for a nonsuit is not to be gotten over. If the allegations and suggestions of the petition are substantially recited, it will be sufficient. But in this case they are not. All the recitals in the patent refer to the elevators, and other parts of the mill machinery, except that the use of the hopperboy is incidentally mentioned, without any description of its use, and the manner in which it is to work. But the petition gives a minute and full description of it, which substantially ought to have been recited ; particularly in this case, where the patent does not in any manner refer to the petition which has been read. Not that we mean to say that such a reference was necessary, if the suggestion of the petition had been substantially recited.

Nonsuit awarded.

Dawson v. Follen. 2 Wash.

DAWSON v. FOLLEN.

[2 Wash. 311.]

In an action for a violation of a patent granted by the United States for an alleged original invention, the plaintiff must satisfy the jury that he was the original inventor, in relation to every part of the world.

Although no proof was made, that the patentee knew that the discovery had been made prior to his, still he could not recover, if, in fact, he was not the original inventor.

THE action was brought for a violation of the plaintiff's patent-right for making suspenders.

The case was fully proved on the part of the plaintiff.

But the defendant introduced a number of witnesses, who proved in the most positive manner, that suspenders, precisely similar to the plaintiff's, had been used in England and France before the plaintiff pretended to have made the discovery, and still longer before his patent issued. Some evidence was given, that the plaintiff had in his possession one of those suspenders, before he obtained his patent, and of course knew that they had been invented in Europe. The question was left to the jury, under the charge of the Court.

WASHINGTON, J., (*Peters* absent,) informed the jury, that to entitle the plaintiff to recover, they must be satisfied that he was the *original inventor*, not only in relation to the United States, but to other parts of the world; in which respect, the Act of Congress differed from the law of England on this subject. That even if there were no proof that the plaintiff was acquainted with the circumstance that the discovery had before been made, still he could not recover, if in truth he was not the original inventor. Upon the evidence, the charge was strongly against the plaintiff.

Verdict for defendant.

Evans v. Weiss. 2 Wash.

OLIVER EVANS v. JOHN WEISS.

[2 Wash. 342.]

Construction of the Act of Congress, passed the 21st of January, 1808, entitled, "An Act for the relief of Oliver Evans."

The general law of patents declares, that the right to the patent belongs to him who is the first inventor, even before the patent is granted; and, therefore, any person who, knowing that another is the first inventor, yet doubting whether he will apply for a patent, constructs a machine invented by another, acts at his peril, and a subsequent patent will prevent his use of the machine thus erected.

THIS was an action on the case, for a violation of the plaintiff's patent-right, and comes on upon the following case agreed. The plaintiff being the inventor of the improvements in the manufacture of flour, hereafter mentioned, and the patent-right for the same, by him heretofore obtained, having been declared by this Court void, in the action of the said Evans against Chambers, and the time for which the said patent was granted having also run out, an Act of Congress, entitled, "An Act for the relief of Oliver Evans," was passed on the 21st of January, 1808, in consequence of which, the said Evans duly obtained letters-patent, bearing date the 22d of January, 1808, notice whereof was given to the defendant in February last.

On the 7th of May, 1802, during the continuance of the former patent, the defendant purchased of the plaintiff a right to use the said improvements at his mill on Wissihicon creek, in Philadelphia county, in this district, for one wheel and pair of stones; but prior to the passing of said Act of Congress, he had applied and used, and still continues to apply and use the same improvements for two wheels and two pair of stones in the same mill. The question submitted is, [* 343] whether the defendant * is liable for damages for the use of said improvements, in their application to this second wheel and pair of stones, since the Act of the

Evans v. Weiss. 2 Wash.

21st of January last ; and whether, if so, he is liable before notice from the plaintiff. If the opinion be in favor of the plaintiff, judgment to be entered generally, and the amount to be afterwards adjusted by the attorneys.

WASHINGTON, J., delivered the opinion of the Court. It is contended by the plaintiff, that the defendant is liable for using the plaintiff's improvement, in application to the second wheel and pair of stones, since the 22d of January, 1808 ; or, at all events, since the time when the defendant received notice of the plaintiff's patent ; because the proviso in the Act, passed on the 21st of January, 1808, "for the relief of Oliver Evans," extends only to cases of improvements erected for use, or used prior to the passage of that law, and does not protect the defendant from damages for using, after the issuing of the patent under this law, an improvement erected prior thereto. On the other side, it is insisted that such a construction would render this an *ex post facto* law, and consequently repugnant to the constitution. To avoid which, it should be so construed as to connect with the use of the improvement the erection of it subsequent to the grant of the patent.

Although the Court at the last term, and upon the first argument, felt strongly inclined to give it the construction contended for by the defendant, yet, upon further reflection, we are satisfied that we should do a violence to the words, which no rule of construction would warrant. The words of the proviso are, "Provided that no person who shall have used the said improvements, or have erected the same for use, before issuing said patent, shall be liable therefor ;" that is, shall be liable for having erected, or for having used the improvement at any time prior to the patent. But with respect to the use of it after the issuing of the patent, no protection whatever is afforded against the claim for damages under this law.

Evans v. Weiss. 2 Wash.

[*344] * The next inquiry is, does the *general law* give to the plaintiff a right of recovery against a person who erected a machine, prior to the issuing of a patent to the first inventor of it, and who afterwards made use of the same ?

The Act of Congress, of the 17th of April, 1800, which, as to this point, is the only law in force, declares that if any person, without permission from the inventor, shall make, devise, use, or sell the thing, whereof the exclusive right is secured to the patentee, he shall pay three times the damages sustained by the patentee, to be ascertained by a jury. Now, whatever doubt might have existed as to the meaning of the words "devise *and* use," in the fifth section of the Act of the 21st of February, 1793, thus connecting the using with the devising of the improvement, there can be none under the third section of the Act of 1800, which repeals the whole of the fifth section of the old law. It is plain that the *using* of an improvement invented by another, and secured by patent, is of itself an offence, no matter at what time such improvement was devised or made. Whether the word *devise*, which has been a good deal criticized, is synonymous with *make*, as Mr. Rawle seems to think it is, or means to *invent*, a mere act of the mind, which we deem very unreasonable, or to *contrive*, *plan*, *form*, or *design*, it is unnecessary in this case to decide, because the charge against the defendant, is the *using* of the plaintiff's improvement, unconnected with the making or devising it.

But it is objected to this construction, that it would render the law *ex post facto* in its operation, in respect to one who has erected this improvement, prior to the grant of the patent to the plaintiff.

It must be admitted, that cases of great hardship may occur, if, after a man shall have gone to the expense of erecting a machine, for which the inventor has not then, and never

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may obtain a patent, he shall be prevented from using it by the grant of a subsequent patent, and its relation back to the patentee's *prior invention. But the [* 345] law in this case, cannot be termed *ex post facto*, or even retrospective in its operation; because the general law declares, beforehand, that the right to the patent belongs to him who is the first inventor, even before the patent is granted; and, therefore, any person, who, knowing that another is the first inventor, yet doubting whether that other will ever apply for a patent, proceeds to construct a machine, of which it may afterwards appear he is not the first inventor, acts at his peril, and with a full knowledge of the law, that, by relation back to the first invention, a subsequent patent may cut him out of the use of the machine thus erected.

Not only may individuals be injured by a literal construction of the words of the law, but the public may suffer, if an obstinate or negligent inventor should decline obtaining a patent, and at the same time keep others at arm's length, so as to prevent them from profiting by the invention for a length of time, during which the fourteen years is not running on. But all these hardships must rest with Congress to correct. It is beyond our power to apply a remedy.

No such hardship exists in this case, where the defendant erected this improvement, with a knowledge not only that the plaintiff was the first inventor, but that he had absolutely obtained a patent, although it was afterwards declared invalid.

Upon the point of notice, we think that the Act of 1808, being a private one, the defendant is liable only from the time he received notice of the law.

Judgment for plaintiff.

NOTE.—In the case of Evans v. Jordan, February Term, 1815, the Supreme Court unanimously affirmed the construction given, in the above opinion, to the Act of January, 1808. The question of notice did not come up. Cranch's Reports, vol. ix. p. 199.

Tyler et al. v. Tuel. 6 Cranch.

TYLER AND OTHERS v. TUEL.

[6 Cranch, 324.]

An assignee of part of a patent-right cannot maintain an action on the case for a violation of the patent.¹

THIS was a case certified from the Circuit Court of the district of Vermont.

Tyler and others, as assignees of Benjamin Tyler, the original patentee of an improvement in grist-mills, which he called the *wry-fly*, or side wheel.

After a verdict for the plaintiffs, the judges of the court below, upon a motion in arrest of judgment, were divided in opinion upon the question "whether the plaintiffs, by their own showing, are legal assignees to maintain this action."

There were two counts in the declaration.

The first set forth the substance of the statutes upon the subject of patents for useful discoveries, the facts necessary to entitle the patentee to a patent for his invention, and the patent itself, together with the specification, dated February 20, 1800.

The averment of the assignment of the patent-right to the plaintiffs was in these words: "And the plaintiffs further say, that the said Benjamin Tyler afterwards, to wit, on the 15th day of May, in the year last aforesaid, at said Claremont, by his certain deed of that date, by him signed, sealed, and to the plaintiffs then and there by the said Benjamin delivered, and ready to be shown to the court, did, in consideration of the sum of six thousand dollars, to him before that time by the plaintiffs paid, grant, bargain, sell, assign
[* 325] * and set over to the plaintiffs, their executors, administrators and assigns, all the right, title and privi-

¹ See sec. 11 of the Act of July 4, 1836.

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lege in, unto, and over the said improvement in the said patent described, and thereby vested in the said Benjamin, in any part of the United States, *excepting* in the counties of Chittenden, Addison, Rutland, and Windham, in the State of Vermont."

The second count, omitting the recital of the statutes and of the patent, stated concisely the same facts. The averment of the assignment of the patent-right was as follows: "And the said Benjamin Tyler, afterwards, and before the expiration of the said fourteen years, to wit, at said Claremont, on the 15th day of May, in the year last aforesaid, by his certain deed of that date by him then and there signed, sealed, and to the plaintiffs delivered, assigned to the plaintiffs the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, in and throughout the United States, *excepting* in the counties of Chittenden, Addison, Rutland, and Windham, in the State of Vermont, as fully and amply as by said letters-patent the said Benjamin Tyler was thereto entitled, and all his title and interest in and unto said improvement, *excepting* as aforesaid."

Hubbard, for the defendant, contended that the assignment, being of *part* of the patent-right only, was not such as would authorize the assignees to maintain an action on the statute. Laws U. S. vol. 2, p. 202, § 4, 5.

The fourth section of the act declares, "that it shall be lawful for any inventor, his executor or administrator, to assign *the* title and interest in the said invention, at any time, and *the* assignee, having recorded the said assignment in the office of the Secretary of State, shall thereafter *stand in the place of the original inventor*, both as to *right* and responsibility, and so the assignees of assigns to any degree."

The fifth section provides, "that if any person shall make, devise, and use, or sell the thing so invented, the

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[* 326] * exclusive right of which shall, as aforesaid, have been secured to any person by patent, without the consent of the patentee, his executors, administrators, or assigns, first obtained in writing, every person so offending shall forfeit and pay to the patentee a sum that shall be at least equal to three times the price for which the patentee has usually sold or licensed to other persons the use of the said invention ; which may be recovered in an action on the case founded on this act, in the Circuit Court of the United States, or any other court having competent jurisdiction."

It is evident from the whole purview of the statute, especially from the 4th, 5th, 6th, and 10th sections, that no person can be considered as an assignee under the statute, who is not the assignee of the *whole* right of the original patentee.

Rodney, Attorney-General, contra.

Upon a motion in arrest of judgment, if the judges are divided, the motion fails, and the judgment must be entered of course. It must follow the verdict, unless sufficient cause be shown to the contrary. 1 Salk. 17. Ld. Raym. 271. 3 Mod. 156.

If there can be no assignment but of the whole right, then the exception of particular counties is void ; it being repugnant to the prior words and intention of the grant.

So if the jury find a fact inconsistent with a fact previously found, the latter fact shall be rejected. Cro. Car. 130 ; 3 East ; 6 Bac. Abr. 381 ; Plowd. 564 ; 1 Bl. Com. 89 ; 2 Co. 83 ; 8 Co. 56 ; Dyer, 351 ; 1 Co. 3 ; 1 Vent. 521 ; Cro. Eliz. 244.

The whole passed at law by the deed of assignment. The exceptions are in the nature of equitable assignments.

On a subsequent day, the Court directed the following opinion to be certified to the circuit court for the district of Vermont, viz. :

Park v. Little & Wood. 3 Wash.

* It is the opinion of the Court, that the plain- [* 327]
tiffs, by their own showing, are not legal assignees
to maintain this action in their own names, and that the judg-
ment of the Circuit Court be *arrested*.

PARK v. LITTLE & WOOD.

[3 Wash. 196.]

Action for an infringement of the plaintiff's patent-right to alarm-bells for fire-engines. The defendants opposed the claim, because the plaintiff had given the use of his invention to the Philadelphia fire company—that the invention is not an alarm-bell, as mentioned in the patent, nor a hose or fire-engine—that their bells differ in principle with the plaintiff's.

The plaintiff, not having assigned the whole of his title and interest in the invention, and no deed of assignment being recorded in the office of the Secretary of State, may recover, notwithstanding any agreement to assign. The question, whether the invention is new, will be decided, not by the fact that bells are not new, but whether the mode of ringing them, by the motion of the engine, and not by manual action, is new.

The thing for which the patent is granted should be truly and fully described in the specification. The matters not disclosed must appear to have been concealed for the purpose of deceiving the public.

If an invention is an improvement in *the principle* of a machine for which a patent has been granted, it is not a violation of the patent—if it is an improvement in the *form*, it is such a violation.

ACTION for the violation of the plaintiff's patent-right to alarm-bells for fire-engines.

The specification states the bell to be attached to a horizontal piece of iron, fixed into an upright elastic piece, the vibrations of which are regulated by a ball of four or five pounds on the top—the whole frame being fastened on the engine, and the bell made to ring by the motion of the wheels on which the engine is fixed. These bells were used on the Philadelphia fire hose engine, for whose use the plaintiff particularly intended it, for the purpose of informing the mem-

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bers, at night, where to find it. The defendants, being members of another hose company, erected on that engine a frame somewhat like gate-posts, with a post across, [* 197] to which were suspended two bells, * attached, like the house-bells, to a circular elastic spring. This is the alleged violation.

The objections to the plaintiff's recovery were: — 1. That his counsel stated, in the opening, that plaintiff had given the use of his invention to the Philadelphia fire company. 2. That this is neither a new nor a useful invention. 3. That it is called, in the patent, an alarm-bell for a fire-engine; whereas, it is not intended to give an alarm, but merely to distinguish the members of the Philadelphia company from other companies; and that a hose engine is not a fire-engine. Some other objections were made to the specification. 4. That the bells used by the defendants are on an entirely different principle from those of the plaintiff.

WASHINGTON, J., charged the jury. First point: The plaintiff is entitled to recover at law, no matter what private agreement subsists between him and any other person or persons, unless he has made a legal assignment and transfer of his interest in the invention: now, in this case, it does not appear that such an assignment has been made.

2. Whether this is a new and useful invention, you must decide. But the question is not, whether bells to give alarm or notice are new, but whether the use and application of them to fire-engines, to be rung, not by manual action, but by the motion of the carriage, for the purpose of alarm or notice, is a new invention, or improvement of an old one? The power of steam is not new, and yet its application for propelling boats would be considered as such. Nevertheless, you must decide, on the evidence, whether the application of these bells to fire-engines is new. As to the question of its

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utility, it is proved that the plaintiff has received fifty dollars from one fire company in Baltimore for the privilege of using his invention; and the fire insurance companies of this city, by voting sums of money to the Philadelphia company, on account of their using them, is some evidence of their opinion.

* 3. This is called, in the patent, an alarm-bell; [* 198] and so it certainly is, so far as it may give notice of a fire to the inhabitants, and to the members of the company of the engine to which they belong. A hose engine may as properly be called a fire-engine, as any other used for extinguishing fire. It is true, that the thing for which the patent is granted should be truly and fully described in the specification; but if this is done, so as clearly to distinguish it from all other things before known, and so as to enable any person skilled in the art of which it is a branch, or with which it is most nearly connected, to make and use the same, it is sufficient; the matters not disclosed must appear to have been concealed for the purpose of deceiving the public, to invalidate the patent.

4. The last question is, have the defendants, by the devising or using their bells, violated the plaintiff's right? The inquiries under this head are — 1st. Are the defendants' bells, as used by them, an improvement of the plaintiff's? You have seen and tried both, and can decide. 2d. Is it an improvement in the principle or in the form? If the former, then it is no invasion of the plaintiff's privilege; if the latter, it is.

Verdict for defendants.

Evans v. Jordan & Morehead. 1 Brock.

OLIVER EVANS v. JORDAN & MOREHEAD.

[1 Brock. 248.]

An old patent, securing to the inventor of improved machinery for the manufacture of flour and meal, the exclusive use of his invention for fourteen years, having expired, J. & M. erected machinery, adopting the improvements of the patentee, and subsequently, a special act of Congress was passed, authorizing the Secretary of State to issue a second patent for the same invention, for an additional term of fourteen years, which act contained the proviso, "*that no person who shall have used the said improvements, or have erected the same for use before the issuing of the said [second] patent, shall be liable to damages therefor.*" *Held*: That this proviso did not authorize the use of this improved machinery by J. & M. subsequent to the date of the second patent, and for such subsequent use, they were liable to damages to the patentee.

THIS was an action for damages brought by the plaintiff, against the defendants, for an alleged violation of a [* 249] patent issued * to him for certain improvements made by him in the art of manufacturing flour and meal.

In the year 1790, Oliver Evans obtained a patent, granting to him, for the term of fourteen years, the exclusive right of making, constructing, using, and vending, his invention in the structure of machinery, to be employed in the art of manufacturing flour and meal. After the expiration of the term for which this patent-right was secured, Jordan & Morehead, the defendants in this suit, constructed and used the improved machinery, invented by Oliver Evans. On the 21st of January, 1808, Congress passed a special act,¹ authorizing the Secretary of State, on application in writing, by Oliver Evans, to cause letters-patent to be made out in the manner and form prescribed by the general patent law, granting to him,

¹ "An Act for the relief of Oliver Evans." Act of January 21st, 1808. — [Editor.]

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for a term not exceeding fourteen years, "the full and exclusive right and liberty of making, &c., his invention, &c., in the art of manufacturing flour and meal, and in the several machines which he has discovered, invented, improved, and applied to that purpose: *Provided*, That no person who may have heretofore paid the said Oliver Evans for license to use his said improvements, shall be obliged to renew said license, or be subject to damages for not renewing the same: *And provided also*, That no person who shall have used the said improvements, or have erected the same for use, before the issuing of the said patent, shall be liable to damages therefor." The second patent was issued on the 22d of January, 1808, and this suit was brought in 1810. The defendants pleaded specially, that they had constructed and used the improved machinery of Oliver Evans, subsequently to the expiration of the first patent, and before the date of the second, and had continued to use the same ever since, as it was lawful for them to do, and to this plea the plaintiff demurred. The same question was also presented in other causes depending in this Court, in which the said Oliver Evans was plaintiff.

* The cause was argued at this Term, 1813, before MARSHALL, C. J., and TUCKER, J., and the following opinion was delivered by

MARSHALL, C. J. — These cases came on to be heard on demurrers to several pleas in bar which have been filed by the defendants. It is intended to present two questions for the consideration of the Court.

1st. Is Oliver Evans entitled to maintain this action against a person who has used his machinery subsequent to the date of his patent, but had constructed it previous to the passage of the act by which his patent was authorized?

2d. Is the case affected by the circumstance, that Oliver

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Evans had obtained a previous patent for the same discovery, which previous patent had expired before the construction of the machine, for the use of which the present suit is instituted?

This being one of those subjects which is, by the Constitution of the United States, delegated entirely to the government of the Union, the question which has been made must depend on the acts of Congress.

The act of 1793 authorizes the Secretary of State to issue a patent to the inventor of any new and useful art, securing to him "for a term, not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery."¹ This right could not be full and exclusive, if any other person should have a right to make, construct, use, or vend the invention which was the subject of the patent. The 5th section of the same act subjects to a specific penalty "any person who shall make, devise, and use, or sell the thing so invented." The terms "devise and use" being coupled together, it might well be questioned whether, under this law, any person would be subject to the penalty for using a machine which he had not also made or devised. But

this doubt is removed by the act of 1800.² The [*251] *3d section of that act repeals the 5th section of the act of 1793, and subjects to the damages therein prescribed "any person who shall make, devise, use, or sell," the invention of any other, which that other has secured by a patent.

This clause cannot be expressed in terms which would show more conclusively the intention of the legislature to

¹ Act to promote the progress of the useful arts. Feb. 21, 1793. 1 Story's Laws U. S., ch. 55, p. 800.—[*Editor.*]

² Act of April 17th, 1800. 1 Story's Laws U. S., ch. 25, p. 752.—[*Editor.*]

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subject each act contained in the enumeration to the penalty of the law, than those which are employed. It has, therefore, been deemed necessary, by the counsel for the defendants, to insist that the obvious construction ought to be overruled, either because it is unconstitutional, or because it is a manifest injustice, which ought not be ascribed to the legislature.

To subject any person to a penalty for using a machine, the invention of another, which had been constructed anterior to the patent, has been pronounced an *ex post facto* law, and, consequently, void.

But an act which prescribes conditions, under which alone a thing may be used in future, cannot be *ex post facto*. It attaches neither guilt nor punishment to a past act, but looks forward to future acts, and prohibits the future use of the machine invented by another, without compensating that other for his invention.

But it is contended that the injustice of exposing an individual to pay for the use of a machine, a sum which he may deem above its value, or to lose one which has been constructed at considerable expense, when he believed it might be lawfully constructed and freely used, is so glaring, that such a construction ought never, if it can be avoided, to be placed on an act of the legislature.

That an act ought so to be construed as to avoid gross injustice, if such construction be compatible with the words of the law, will not be controverted; but this principle is never to be carried so far as to thwart that scheme of policy which the legislature has the power to adopt. To that department is confided, without revision, the power of deciding on the justice as well as wisdom of measures relative to subjects on which they have the constitutional power to act. Wherever, then, their language admits of no doubt, their plain and obvious intent must prevail.

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[* 252] * In cases of patents, although some injustice may ensue from imposing a price to be paid to the inventor, on the future use of a machine which was constructed before the patent was obtained, yet the great fundamental principles of right, and of property, do not appear to be so vitally wounded as to induce the Court to resist and struggle against the obvious meaning of words.

The constitution gives to the legislature a power "to promote the progress of useful arts, by securing, for limited times, to inventors, the exclusive right to their respective discoveries." In the exercise of this constitutional power, the legislature has passed an act, prescribing the mode by which a patent to any invention may be obtained, and giving to the patentee the exclusive right to make, devise, use, or sell it, for fourteen years from the date of the patent.

The constitution and law, taken together, give to the inventor, from the moment of invention, an inchoate property therein, which is completed by suing out a patent. This inchoate right is exclusive. It can be invaded or impaired by no person. No person can, without the consent of the inventor, acquire a property in the invention. Whenever, then, previous to a patent, any person constructs a machine discovered by another, he constructs it subject to the right of that other. His right to use it is qualified by the paramount right of the inventor to prescribe the conditions on which he shall use it. Were it otherwise, the exclusive right in the discovery which the constitution authorizes Congress to secure to the inventor, and the exclusive right to use it after the date of the patent, which the act of Congress confers, would not be exclusive, but would be participated with every person who had constructed the machine previous to the emanation of the patent.

If gentlemen will recollect, that this inchoate and indefeasible property in the thing discovered commences with the

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discovery itself, and is only perfected by the patent subjecting the future use of the machine, constructed previous to a patent, to that price which the inventor demands from others, for the use of it, his discovery will not appear to be one of those violent *invasions of the sacred rights [* 253] of property, which would justify a Court in disregarding the plain meaning of words.

In deciding this first question, it still remains to inquire, whether, from the particular act under which Oliver Evans has obtained his patent, he derives rights as extensive as would have been conferred by the general law. In the enacting part of the law, reference is made to the general act, and it is declared that his patent grants, "for a term, not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to be used, his invention," &c.

In the enacting clause, there is found no difference between this particular law and the general law. A patent issued under the one, or the other, confers equal rights. Is this construction varied by the proviso? The first proviso is, "That no person who may have heretofore paid the said Oliver Evans for a license to use his said improvements, shall be obliged to renew the said license, or be subject to damages for not renewing the same." The second is, "That no person who shall have used the said improvements, or have erected the same for use, before the issuing of the said patent, shall be liable to damages therefor."

The second proviso has been supposed to comprehend the case at bar. But, surely, this would be extending the proviso far beyond the meaning of the words. Their obvious import is, that no person who shall have used the said improvements, or have erected the same for use, before the issuing of the said patent, shall be liable to damages for such previous use, or for such previous erection; but this no more

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excepts the future use of a machine previously erected, from the operation of the enacting clause, than it excepts from that operation a machine to be in future erected. The legislature, knowing that an inchoate right to the exclusive use of his discovery was vested in the inventor, from the moment of discovery, and only perfected by the patent, might deem it necessary to guard against a continuation, which [* 254] would make this patent relate back to * antecedent transactions. This may have been a superfluous caution, but such caution is often found in legislative proceedings.

This construction derives additional force from the first proviso. This does away the necessity of renewing licenses purchased under the former patent. The words of the proviso, certainly, apply to all former licenses, for which payment had been made, not to those for which no payment had been made, and shows that the legislature supposed it possible that the effect of the patent would be extended to such licenses.

An attempt has been made to impair the influence of this proviso, by its application to cases in which a license had been obtained and paid for, but the machine had not been constructed. There is nothing in the words to justify the idea that the legislature designed to limit their operation to such particular cases ; and to suppose their existence requires no inconsiderable effort of the imagination. It is difficult to assign a motive for purchasing, just before the expiration of a patent, a license to use a discovery, which the purchaser did not purpose to erect until the patent should expire.

It is, then, the opinion of the Court, that the Act for the relief of Oliver Evans, considered independent of any former patent, would authorize him to sustain an action for the use of his invention, after the date of his patent, although the machinery itself had been constructed before its date.

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Does the existence of a former patent affect the question of law? The Court can perceive no ground upon which to rest an affirmative answer to this question. That construction of the constitution which admits the renewal of a patent, is not controverted. A renewed patent, then, has the same obligation, and confers the same rights, with an original patent. The inchoate property which vested by the discovery, is prolonged by the renewed patent, as well as by the original patent. There may be powerful reasons with the legislature for guarding a renewed patent, by restrictions and regulations, not to be imposed on original patents; but these reasons address themselves to the * legislature only. [* 255] If they have been overlooked or disregarded in the hall of Congress, it is not for this Court to set them up.

NOTE. — The Court being divided in opinion, *pro forma*, on the question raised by the demurrer in this cause, the following order was made: “On the trial of this cause, it occurred, as a question, whether, after the expiration of the original patent granted to Oliver Evans, a general right to use his discovery was not so vested in the public, as to require and justify such a construction of the act passed in January, 1808, entitled, ‘An Act for the relief of Oliver Evans,’ as would exempt from either treble or single damages, the use, subsequent to the passage of the said act, of the machinery therein mentioned, which was erected subsequent to the expiration of the original patent, and previous to the passage of the act, entitled ‘An Act for the relief of Oliver Evans?’”

“Upon this question, the Court was divided in opinion, and it is, therefore, ordered to be certified to the Supreme Court for their decision and direction thereon.”

The Supreme Court of the United States unanimously sustained the above opinion of the Chief Justice. See 9 Cranch, 199; 3 Con. Rep. Sup. Ct. U. S. 358. The decisions of the United States Court, on cases arising under the Patent Act, are collated by Mr. Peters, in a note at the end of the case. — [Editor.]

Whittemore v. Cutter. 1 Gall.

WHITTEMORE v. CUTTER.

[1 Gall. 429.]

Under the Patent Act of 21st February, 1793, ch. 11, if the patentee has sold out a moiety of his patent-right, a joint action lies, by himself and his assignee, for a violation of it.

The making of a patented machine fit for use, and with design to use it for profit, in violation of the patent-right, is of itself a breach of the patent-right, for which an action lies.

If there be a mere making, and no user proved, nominal damages are to be given to the plaintiff. Where the law gives a remedy for a particular act, the doing of that act of itself imports a damage, for which an action lies.

If the oath, required by the Patent Act previous to the issuing of a patent, be not taken, still the patent is valid.

Under the Patent Act, no defect or concealment in any specification is sufficient to avoid a patent, unless it be *with intent to deceive the public*.

Counsel fees for prosecuting the suit are no proper item of damage in an action for violation of a patent.¹

THIS was an action for the violation of a patent-right in a machine for the making of cotton and wool cards. A verdict having been returned against the defendant, [* 430] he moved * for a new trial upon several grounds, which will appear in the opinion of the Court, delivered as follows, by

STORY, J. Several objections, which were taken to the opinion of the Court delivered to the jury at the trial, have been argued on the motion for a new trial, and we are now to pronounce as to their validity.

The first objection is founded on the incompetency of the plaintiffs to maintain the present action; one of the plaintiffs

¹ See *Allen v. Blunt et al.*; *Boston Manufacturing Co. v. Fiske et al.*; *Stimpson v. The Railroads*.

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being the original patentee, and the other an assignee of a moiety of the patent-right, deriving his title under the patentee. It is contended, that no action will lie in this court for an infringement of a patent-right in favor of an assignee, unless he be the assignee of the *whole title and interest*. And the language of the 4th section of the act of 21st February, 1793, ch. 11, and the case of *Tyler & al. v. Tuel*,¹ are relied on in support of the position.

It is true, that a party relying on an action given by a statute must bring himself within the provisions of the statute. But where, as in the present case, the law is remedial, it should receive a liberal construction, to effectuate the intentions of the legislature. Upon the very rigid construction which is assumed by the defendant's counsel, an action could not be maintained, where a joint patent should be obtained by two persons, and one of them should assign his whole interest. The action could not be jointly brought by the patentees, because one would have parted with his whole interest; nor jointly by the patentee and the assignee, for it would then be open to the very difficulty which is pressed upon us in this case; nor by either party separately, for it would be splitting the cause of action. Other cases might be put, in which the parties would be wholly without remedy. We are well satisfied, however, * that [* 431] the direction given at the trial on this point was correct. The statute gives to the assignee all the right and responsibility which the original inventor had in the undivided portion of the patent, which is conveyed; and an action may well be maintained by all the parties who, at the time of the infringement, are the holders of the whole title and interest. The case of *Tyler & al. v. Tuel* is clearly distinguishable. In the first place, it was brought by persons who did not pur-

¹ 6 Cranch, 325.

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port to have the whole patent-right in themselves. In the next place, there was, technically speaking, no assignment of the patent-right. The instrument could only operate as a covenant or license for the exclusive use of the patent-right in certain local districts. But a patent-right itself is unsusceptible of local subdivision. Nor is the present case within any of the mischiefs which were pressed on the Court in that case. The language of the 4th section does not seem to have contemplated the case of joint inventors; yet there can be no doubt, that being within the reason of the clause, they must be held within the purview. If either should die, can there be a question that the executor or administrator might well maintain an action jointly with the survivor for an infringement? and in what substantial respect can an assignee in law be considered as distinguishable from an assignee in fact? Upon the most mature reflection, we are satisfied that this objection cannot prevail upon the footing of the statute; and if urged at common law, the case of *Boulton & Watt v. Bull*,¹ where the action was brought by the inventor and his assignee of two thirds of the patent-right, would afford a complete answer.

Another objection is to the direction, that the making of a machine fit for use, and with a design to use it for profit, was an infringement of the patent-right, for which an action was given by the statute. This limitation of the making [* 432] * was certainly favorable to the defendant, and it was adopted by the Court from the consideration that it could never have been the intention of the legislature to punish a man who constructed such a machine merely for philosophical experiments, or for the purpose of ascertaining the sufficiency of the machine to produce its described effects.

¹ 2 H. Bl. 463.

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It is now contended by the defendant's counsel, that the making of a machine is, under no circumstances, an infringement of the patent. The 1st section of the Act of 1793 expressly gives to the patentee, &c., "the full and exclusive right and liberty of making, constructing, using, and vending to others to be used," the invention or discovery. The 5th section of the same act gives an action against any person who "shall make, devise, use, or sell" the same. From some doubt whether the language of the section did not couple the making and *using* together to constitute an offence, so that making without using, or using without making, was not an infringement, the legislature saw fit to repeal that section; and by the 3d section of the Act of 17th April, 1800, ch. 25, gave the action against any person who should "make, devise, use, or sell" the invention. We are not called upon to examine the correctness of the original doubt, but the very change in the structure of the sentence affords a strong presumption that the legislature intended to make every one of the enumerated acts a substantive ground of action.

It is argued, however, that the words are to be construed distributively, and that "making" is meant to be applied to the case of a *composition* of matter, and not to the case of a machine. That it is clear, that the use of certain compositions, (as patented pills,) could not be an infringement, and unless making were so, there would be no remedy in such cases. We cannot feel the force of this distinction. The word "making" is equally as applicable to machines, as * to compositions of matter; and we see [* 433] no difficulty in holding, that the using or vending of a patented composition is a violation of the right of the proprietor.

It is farther argued, that the making of a machine cannot be an offence, because no action lies, except for *actual damage*, and there can be no actual damages, or even a rule

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for damages, for an infringement by making a machine. We are, however, of opinion, that where the law gives an action for a particular act, the doing of that act imports of itself a damage to the party. Every violation of a right imports some damage, and if none other be proved, the law allows a nominal damage.

On the whole, we see no reason for departing from the plain import of the language of the statute, and this objection also must be overruled.

Another objection is to the direction, that the oath taken by the inventor not being conformable to the statute, formed no objection to the recovery in this action. The statute requires that the patentee should swear, "that he is the true inventor or discoverer of the art, machine, or improvement." The oath taken by Whittemore was, that he was the true "*inventor or improver* of the machine." The taking of the oath was but a prerequisite to the granting of the patent, and in no degree essential to its validity. It might as well have been contended that the patent was void, unless the thirty dollars required by the 11th section of the act, had been previously paid. We approve of the direction of the Court on this point, and overrule this objection..

Another objection is to the direction respecting the specification. It was as follows: "That if the jury should be satisfied that the specification and drawings filed by the patentee in the office of the Secretary of State, were not made in such full, clear and exact terms and manner as to [* 434] * distinguish the same from all other things before known, and to enable any person skilled in the art or science, of which it is a branch, or with which it is most nearly connected, to make and use the same, this would not be sufficient to defeat the right of the plaintiffs to recover in this action, unless the jury were also satisfied that the specification and drawings were thus materially defective and ob-

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scure *by design*, and the concealment made for the purpose of deceiving the public. In this respect our law differed from the law of England. That if the specification and drawings were thus materially defective, it afforded a presumption of a designed concealment, which the jury were to judge of. That in deciding as to the materiality of the deficiencies in the specification and drawings, it was not sufficient evidence to disprove the materiality, that, by studiously examining such specification and drawings, a man of extraordinary genius might be able to construct the machine, by inventing parts, and by trying experiments. The object of the law was, to prevent the expenditure of time and money in trying experiments, and to obtain such exact directions, that, if properly followed, a man of reasonable skill in the particular branch of the art or science might construct the machine, and if, from the deficiencies, it was impracticable for such a man to construct it, the deficiencies were material." In order fully to understand the objection to this direction, it is necessary to advert to the third section of the act of 1793, which specifies the requisites to be complied with in procuring a patent, and the sixth section of the same act, which states certain defences, of which the defendant may avail himself to defeat the action, and to avoid the patent. The third section, among other things, requires the party applying for a patent to deliver a written description of his invention, and of the manner of using, or process of compounding the same, in *such full, clear, and exact [*435] terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most intimately connected, to make, compound, and use the same; and in the case of any machine, he shall fully explain the principle, and the several modes, in which he has contemplated the application of that principle, or character, by

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which it may be distinguished from other inventions. The sixth section provides, among other things, that the defendant may give in his defence, that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect, *which concealment or addition shall fully appear to have been made for the purpose of deceiving the public.*

It is very clear, that the sixth section does not enumerate all the defences of which the defendant may legally avail himself; for he may clearly give in evidence, that he never did the act attributed to him, that the patentee is an alien not entitled under the act, or that he has a license or authority from the patentee. It is therefore argued, that if the specification be materially defective, or obscurely or so loosely worded, that a skillful workman in that particular art could not construct the machine, it is a good defence against the action, although no intentional deception has been practised. And this is beyond all question the doctrine of the common law; and it is founded in good reason, for the monopoly is granted upon the express condition that the party shall make a full and explicit disclosure, so as to enable the public, at the expiration of his patent, to make and use the invention or improvement in as ample or beneficial a manner as the patentee himself. If, therefore, it be so obscure, loose, and imperfect, that this cannot be done, it is defrauding [* 436] the public of all the consideration *upon which the monopoly is granted.¹ And the motive of the party, whether innocent or otherwise, becomes immaterial, because the public mischief remains the same.

It is said, that the law is the same in the *United States*, notwithstanding the wording of the sixth section, for there is

¹ Buller, N. P. 77; *Turner v. Winter*, 1 T. R. 602.

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a great distinction between a concealment of material parts, and a defective and ambiguous description of all the parts; and that in the latter case, although there may be no intentional concealment, yet the patent may be avoided for uncertainty as to the subject-matter of it. There is considerable force in the distinction at first view; and yet, upon more close examination, it will be difficult to support it. What is a defective description, but a concealment of some parts necessary to be known in order to present a complete view of the mechanism? In the present case, the material defects were stated, among other things, to consist in a want of a specific description of the dimensions of the component parts, and of the shapes and position of the various knobs. Were these a concealment of material parts, or a defective and ambiguous disclosure of them? Could the legislature have intended to pronounce, that the concealment of a material spring should not, unless made with design to deceive the public, avoid the patent, and yet that an obscure description of the same spring should at all events avoid it? It would be somewhat hazardous to attempt to sustain such a proposition.

It was probably with a view to guard the public against the injury arising from defective specifications, that the statute requires the letters-patent to be examined by the attorney-general, and certified to be in conformity to the law, before the great seal is affixed to them. In point of practice, this must unavoidably be a very insufficient security, and the policy of the provision that has changed the *com- [* 437] mon law, may be very doubtful. This, however, is a consideration proper before another tribunal. We must administer the law as we find it. And, without going more at large into this point, we think that the manifest intention of the legislature was, not to allow any defect or concealment in a specification to avoid the patent, unless it arose

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from an intention to deceive the public. There is no ground, therefore, on which we can support this objection.

Considering, however, the importance of the question in a general view, if the cause had rested on this point, I should have been disposed to have had it certified, on a division of opinion, for the determination of the Supreme Court.

Another objection is to the direction to the jury, that the letters-patent were to be considered as granted for an improvement in manufacturing cards, and not for the whole machine described in the specification. This direction was given under impressions derived from the case of *Boulton & Watts v. Bull*; but we are now satisfied that the direction was erroneous. The declaration is for an infringement of the patented *machine*, and although the letters-patent state, that the grant is for "a new and useful improvement in manufacturing cards," yet the specification must be considered as controlling the generality of expression, and limiting the grant to the machine specifically described therein. It is indeed clear, from all the other papers in the cause, that the invention and the patent have always been considered by the patentees as confined to a specific machine.

The last objection which has been urged, is to the direction, that the extraordinary expenses of vindicating the right of the plaintiffs, such as counsel fees and expenses of witnesses beyond the taxable costs, ought to be considered as items of actual damage. And such, at the trial, we had considered the established rule to be in estimating [* 438] * damages in cases of mere tort, whether the action was for the redress of a personal injury, or the vindication of a personal right. Since the trial, however, we have seen the case of *Arcambal v. Wiseman*,¹ in which the question, as to counsel's fees, was directly before the Supreme

¹ 3 Dall. 306.

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Court. There can be no doubt that the case was founded on a tort; and we feel ourselves bound by that decision, whatever might have been the opinion we should otherwise have been disposed to entertain.

For the errors, therefore, in the two last exceptions, a new trial must be granted.

A new trial awarded.

JOHN WOODCOCK v. DAVID PARKER AND ANOTHER.

[1 Gall. 438.]

The original inventor of a machine, who has reduced his invention to practice, is entitled to a priority of patent-right, although subsequently the same machine may have been invented by another person.¹

The inventor of an improvement cannot entitle himself to a patent more broad than his invention.²

THIS was an action on the case for a violation of a patent-right of the plaintiff for splitting leather. The cause was tried at this term before *Story, J.*, in the absence of the District Judge. The plaintiff, at the trial, produced his letters-patent, dated 8th May, 1809, securing to him the patent-right of a machine for splitting leather. The defendants admitted

¹ See *Bedford v. Hunt* (1 Mason, R. 302); *Evans v. Eaton* (3 Wheaton, R. 434); *S. C.* (1 Peters, C. C. Rep. 322); *Shaw v. Cooper* (7 Peters, S. C. Rep. 292); *Dawson v. Hillen* (2 Wash. C. C. Rep. 311); *Reutger v. Kanowes et al.* (1 Id. 168); *Whitney v. Emmett* (1 Baldwin, C. C. Rep. 303).

² See *Lowell v. Lewis* (1 Mason R. 189); *Moody v. Fiske* (2 Id. 112); *Wyeth v. Stone* (1 Story's R. 273). See, also, *Brunton v. Hawkes* (4 B. & Al. 540); *The King v. Ellice* (Dav. Patent Cases, 144); *Phillips on Patents*, p. 223 – 231; *Whitney v. Emmett* (1 Baldw. R. 303); *Earle v. Sawyer* (4 Mason, R. 1).

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the use of a similar machine, but contended that the machine was the invention of one Samuel Parker, (under whom they claimed,) who had obtained his original letters-patent for the same invention, dated the 9th July, 1808, and let-
[* 439] ters-patent for certain improvements therein, * dated the 26th of April, 1809. The principal questions between the parties were, 1. Whether Woodcock or Parker was the first inventor of the machine in controversy, and entitled to the patent. 2. Whether, admitting the plaintiff to be the original inventor of the machine, in its present improved state, his patent was not too broad, and did not include machinery previously invented and applied to the same purpose by the said Parker.

STORY, J., in summing up the cause, directed the jury as follows: The first inventor is entitled to the benefit of his invention, if he reduce it to practice and obtain a patent therefor, and a subsequent inventor cannot, by obtaining a patent therefor, oust the first inventor of his right, or maintain an action against him for the use of his own invention. In the present case, as the defendants claim their right to use the machine in controversy by a good derivative title from Samuel Parker, if the jury are satisfied that said Parker was the first and original inventor of the machine, the plaintiff cannot, under all the circumstances, maintain his action; notwithstanding he may have been a subsequent inventor, without any knowledge of the prior existence of the machine, or communication with the first inventor. It is not necessary to consider, whether, if the first inventor should wholly abandon his invention, and never reduce it to practice, so as to produce useful effects, a second inventor might not be entitled to the benefit of the statute patent; because here there is not the slightest evidence of such abandonment. Parker is proved to have put his machine in operation; it produced

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useful effects ; and he followed up his invention by obtaining a patent from the department of state.

As to the second question, if the machine, for which the plaintiff obtained a patent, substantially existed before, and * the plaintiff made an improvement only [* 440] therein, he is entitled to a patent for such improvement only, and not for the whole machine ; and under such circumstances as this present patent is admitted to comprehend the whole machine, it is too broad, and therefore void. It is not necessary, to defeat the plaintiff's patent, that a machine should have previously existed in every respect similar to his own ; for a mere change of former proportions will not entitle a party to a patent. If he claim a patent for a whole machine, it must in substance be a new machine ; that is, it must be a new mode, method, or application of mechanism, to produce some new effect, or to produce an old effect in a new way. In the present case, if all parts of the machine, except the spring plate, (which the plaintiff claims as emphatically his own invention,) existed before, and were applied to produce the same effects in the same manner ; and the plaintiff has established the spring plate to be his exclusive invention, still his patent ought to have been confined to such improvement, and not to have comprehended the whole machine. Unless, therefore, the plaintiff establish his exclusive right to the whole machine, as now organized, as his own invention, he cannot be entitled to the verdict of the jury.

The jury found a verdict for the defendants ; and a bill of exceptions was taken to the direction of the judge, but no writ of error has ever been sued to the Supreme Court.

George Blake and Dexter for the plaintiff.

Prescott and Otis for the defendants.

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AMOS WHITTEMORE ET AL. v. WILLIAM F. CUTTER.

[1 Gall. 478.]

Patent-right. If a person be the inventor of an improvement only, and not of the whole machine, he is entitled to a patent for no more than his improvement.¹

What constitutes the identity or diversity of two machines, so as to give or take away the right to a patent.²

If a machine produce several different effects, by a particular combination of machinery, and these effects are produced in the same way in another machine, and a new effect added, the inventor of the latter cannot entitle himself to a patent for the whole machine.³

If an inventor make a gift of his invention to the public, and suffer it to go into general use, he cannot afterwards resume the invention, and hold a patent.⁴

In an action for violation of a patent-right, the plaintiff can recover for *actual damages* only, and not for a vindictive recompense.

If a user of the patented machine be proved, the measure of damages is the value of the use, during the time of the user. If a making only of the machine be proved, the plaintiff is entitled to nominal damages only. Neither the price, nor the expense of making the machine, is a proper measure of damages.

In an action on a patent-right, the jury are to find single damages, and the court will treble them.

THIS was an action for the infringement of the plaintiff's patent-right, as set forth in the declaration. The cause was tried before Judge *Story*, at this term, in the absence of the

¹ See note to page 438, *ante*.

² See *Gray v. James*, (1 Peters, C. C. R. 396); *Phillips on Patents*, 128 to 133, where the cases are cited and commented on.

³ See note to 438, *ante*.

⁴ *Morris v. Huntington* (1 Paine's R. 348); *Mellus v. Silsbee* (4 Mason R. 108); *Bedford v. Hunt* (1 Mason, 304); *Grey v. James* (1 Peters, C. C. R. 394); *Pennock et al. v. Dealogao* (2 Peters, S. C. Rep. 1); *Wyeth v. Stone* (1 Story's Rep. 273); *Reed v. Cutter* (1 Ib. 590); *Saunders v. Smith* (3 Mylne & Craig, 711, 735).

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District Judge ; the verdict found by the jury at a former term having been set aside, and a new trial granted.¹ After summing up the evidence, the judge directed the jury as follows :

If the plaintiff, Amos Whittemore, be not the inventor of the whole machine, but only of an improvement thereof, his patent is too broad, and utterly void ; for it is clearly a patent for the whole machine. Whether he be the inventor of the whole machine is, under all the circumstances of the case, a question of fact. It is difficult to define the exact cases, when the whole machine may be deemed a new invention, and when only an improvement of an old machine ; the cases often approach very near to each other. In the present improved state of machinery, it is almost impracticable not to employ the same elements of motion, and in some particulars, the same manner of operation, to produce any new effect. Wheels, with their known modes of operation, and known combinations, must be of very extensive employment in a great variety of new machines ; * and [* 480] if they could not, in the new invention, be included in the patent, no patent could exist for a whole machine embracing such mechanical powers.

Where a specific machine already exists, producing certain effects, if a mere addition is made to such machine, *to produce the same effects* in a better manner, a patent cannot be taken for the whole machine, but for the improvement only. The case of a watch is a familiar instance. The inventor of the patent lever, without doubt, added a very useful improvement to it ; but his right to a patent could not be more extensive than his invention. The patent could not cover

¹ *Ante*, p. 429.

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the whole machine as improved, but barely the actual improvement. The same illustration might be drawn from the steam engine, so much improved by Messrs. Watt & Boulton. In like manner, if to an old machine, some new combinations be added, to produce *new effects*, the right to a patent is limited to the new combinations. A patent can, in no case, be for any effect only, but for an effect produced in a given manner, or by a peculiar operation. For instance, no patent can be obtained for the admeasurement of time, or the expansive operations of steam; but only for a new mode or new application of machinery, to produce these effects; and therefore, if new effects are produced by an old machine in its unaltered state, I apprehend that no patent can be legally supported, for it is a patent for an effect only.

On the other hand, if *well known effects* are produced by machinery in all its combinations *entirely new*, a patent may be claimed for the whole machine. So if the principles of the machine are new, either to produce a new or an old effect, the inventor may well entitle himself to the exclusive right of the whole machine. By the principles of a machine, (as these words are used in the statute,) is not meant the original elementary principles of motion, which philosophy [* 481] * and science have discovered, but the *modus operandi*, the peculiar device or manner of producing any given effect. The expansive powers of steam, and the mechanical powers of wheels, have been understood for many ages; yet a machine may well employ either the one or the other, and yet be so entirely new in its mode of applying these elements, as to entitle the party to a patent for his whole combination. The intrinsic difficulty is to ascertain, in complicated cases like the present, the exact boundaries between what was known and used before, and what is new, in the *mode of operation*.

The present machine is to make cotton and woollen cards.

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These were not only made before the present patent, by machinery, but also by machinery which, at different times, exhibited very different stages of improvement. The gradual progress of the invention, from the first rude attempts to the present extraordinary perfection, from the slight combination of simple principles to the present wonderful combinations, in ingenuity and intricacy scarcely surpassed in the world, has been minutely traced by the witnesses on the stand.

The jury, then, are to decide, whether the principles of Mr. Whittemore's machine are altogether new, or whether his machine be an improvement only on those which have been in use before his invention. I have before observed, that the principles are the *mode of operation*. If the same effects are produced by two machines by the same mode of operation, the principles of each are the same. If the same effects are produced, but by combinations of machinery operating substantially in a different manner, the principles are different.

The great stages, (if I may so say,) in making the cards by Whittemore's machine, which admit of a separate and distinct operation in the machinery, are, 1. The forming * and bending the wire. 2. The pricking [* 482] the leather. 3. The sticking the wire into the leather; and, 4. The crooking the wire after its insertion. Were either of these effects produced in the machines formerly in use by a combination of machinery, or mode of operation, substantially the same as in this machine? If so, then clearly his patent could only be for an improvement, and of course it is void; if not, then his patent is free from any objection on the ground of being broader than his invention. It will not be sufficient to protect the plaintiff's patent, that this specific machine, with all its various combinations and effects, did not exist before; for if the different effects were all produced by the *same application* of machinery, in sepa-

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rate parts, and he merely combined them together, or added a new effect, such combination would not sustain the present patent, any more than the artist, who added the second hand or repeater to a watch, could have been entitled to a patent of the whole watch.¹ Nor will it protect the plaintiff's patent, that Mr. Amos Whittemore was the inventor of all the material improvements in the old machine, (as is asserted,) if he suffered them to be used freely and fully by the public at large for so many years, combined with all the usual machinery; for in such a case I think he must be deemed to have made a gift of them to the public, as much as a person who voluntarily opens his land as a highway, and suffers it to remain for a length of time devoted to public use. How far there is any such acquiescence or assent to such public use is, of course, open to the consideration of the jury.

Such are the material principles, which, as to this point, I think it proper to state.

As to the rule, by which the plaintiff's damages are to be estimated, it is clear by the statute, that only the *actual damages* sustained can be given. By the terms [* 483] "actual * damages," in the statute, are meant such damages as the plaintiffs can actually prove and have *in fact* sustained, as contradistinguished to mere imaginary or exemplary damages, which in personal torts are sometimes given. The statute is highly penal, and the legislature meant to limit the single damages to the real injury done, as in other cases of violation of personal property, or of incorporeal rights. In mere personal torts, as assaults and batteries, defamation of character, &c., the law has, in pro-

¹ Bevell v. Moore (2 Marsh. R. 211); Hill v. Thompson (8 Taunt. R. 375); Brunton v. Hawkes (4 B. & Ald. 540); Munter v. Maver (1 Neville & Perry, 595).

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per cases, allowed the party to recover, not merely for any actual injury, but for the mental anxiety, the public degradation and wounded sensibility, which honorable men feel at violations of the sacredness of their persons or characters. But the reason of the law does not apply to the mere infringement of an incorporeal right, such as a patent, and the legislature meant to confine the damages to such a sum as would compensate the party for his actual loss.

If the jury are of opinion that an user of the machine is actually proved in this case, the rule of damages should be the value of the use of such a machine, during the time of the illegal user.

If the jury are of opinion that a making of the machine only is proved, as there is no evidence in the case, to show any actual damages by the making, they ought to give nominal damages to the plaintiffs. For where the law has given a right, and a remedy for the violation of it, such violation of itself imports damage; and in the absence of all other evidence, the law presumes a nominal damage to the party.

The counsel for the plaintiffs have argued, that although there is no evidence of actual damage, the jury ought to give damages either to the full value of the expense of making the machine, or of the price at which such a machine might be sold. But neither of these estimates can form a * rule for damages for the illegal making of [* 484] the machine. As to the expense of making the machine, it is obvious that it is an expense altogether incurred by the defendant, and is not a loss sustained by the plaintiffs. The latter neither found the materials nor the labor. How then can it be an actual damage sustained by them? As to the price for which such a machine would sell, it is open to the same, and to this farther objection; that the *price* is compounded of the value of the materials and the workmanship, and also of the *right of user* of the machine. Now, admit-

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ting the plaintiffs recover in this action, there can be no pretence, that thereby a legal right will pass to the defendant to use the machine made by him. Every future use will be an infringement of the plaintiff's patent; and, therefore, if the plaintiffs could in this suit recover such price, they not only would recover for materials and labor which they never furnished, and for a right of user which never passed from them, but also for that which might lawfully be the subject of another action, viz.: the future user of the defendant's machine; so that there might be a double recovery for the same supposed injury.

At the former trial, the Court were pressed with the difficulty of finding any rule to estimate the plaintiff's damages, when none were actually proved, by the making of the machine; and I still adhere to the decision then made, that in such case the plaintiffs can recover nominal damages only.

The jury, if satisfied of the plaintiff's right to recover, will estimate the plaintiff's single damages, according to the principles which I have stated, as they shall find the facts of a making or of a user of the machine. The Court will treble the damages found by the jury in awarding the proper judgment.

[* 485] * The jury found a verdict for the plaintiffs, that the defendant was guilty of making the machine only, and assessed single damages at \$350.

Dexter and Prescott for the plaintiffs.

Pitman for defendant.

Sawin et al. v. Guild. 1 Gall.

JOHN P. SAWIN AND ANOTHER v. JOHN GUILD.

[1 Gall. 485.]

The sale of the *materials* of a patented machine, by a sheriff, on an execution against the owner, is not such a sale as subjects the sheriff to an action for an infringement of the patent-right, under the Patent Act of the 17th of April, 1800, ch. 25.

STORY, J., delivered the opinion of the Court.

This is an action on the case for the infringement of a patent-right of the plaintiffs, obtained in February, 1811, for a machine for cutting brad nails. From the statement of facts agreed by the parties, it appears that the defendant is a deputy sheriff of the county of Norfolk, and having an execution in his hands against the plaintiffs for the sum of \$567.27 debt and costs, by virtue of his office, seized and sold, on said execution, the *materials* of three of said patented machines, which were at the time complete and fit for operation, and belonged to the plaintiffs. The purchaser, at the sheriff's sale, has not, at any time since, put either of the said machines in operation; and the whole infringement of the patent consists in the seizure and sale by the defendant as aforesaid. The question submitted to the Court is, whether the complete materials, of which a patented machine is composed, can, while such machine is in operation by the legal owner, be seized and sold on an execution against him.

The plaintiffs contend, that it cannot be so seized and sold, and they rely on the language of the third section of * the Act of the 17th of April, 1800, ch. 25, [* 486] which declares that if "any person, without the consent of the patentee, his or her executors, &c., first obtained in writing, shall make, devise, use, or *sell* the thing, whereof the exclusive right is secured to the said patentee, such person, so offending, shall forfeit," &c.

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It is a sound rule of law, that every statute is to have a reasonable construction; and its language is not to be interpreted so as to introduce public mischiefs, or manifest incongruities, unless the conclusion be unavoidable. If the plaintiffs are right in their construction of the section above stated, it is practicable for a party to lock up his whole property, however great, from the grasp of his creditors, by investing it in profitable patented machines. This would undoubtedly be a great public mischief, and against the whole policy of the law, as to the levy of personal property in execution. And upon the same construction, this consequence would follow, that every part of the materials of the machine might, when separated, be seized in execution, and yet the whole could not be, when united; for the exemption from seizure is claimed, only when the whole is combined and in actual operation under the patent.

We should not incline to adopt such a construction, unless we could give no other reasonable meaning to the statute. By the laws of Massachusetts, property like this is not exempted from seizure in execution; and an officer who neglected to seize, would expose himself to an action for damages, unless some statute of the United States should contain a clear exception. No such express exception can be found; and it is inferred to exist only by supposing, that the officer would, by *the sale*, make himself a wrong-doer, within the clause of the statute above recited. But within the very words of that clause, it would be no offence to *seize* [* 487] the machine in execution.¹ The whole *offence must consist in a *sale*. It would therefore follow, that the officer might lawfully seize; and if so, it would be somewhat strange, if he could not proceed to do those acts, which alone by law could make his seizure effectual.

¹ *Here v. Stevenson* (3 Bos. & Pull. 565, S. P.)

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This Court has already had occasion to consider the clause in question, and upon mature deliberation, it has held that *the making* of a patented machine to be an offence within the purview of it, must be the making with an intent to use for profit, and not for the mere purpose of philosophical experiment, or to ascertain the verity and exactness of the specification.¹ In other words, that the making must be with an intent to infringe the patent-right, and deprive the owner of the lawful rewards of his discovery.

In the present case, we think that a sale of a patented machine, within the prohibitions of the same clause, must be a sale not of the materials of a machine, either separate or combined, but of a complete machine, with the right, express or implied, of using the same in the manner secured by the patent. It must be a tortious sale, not for the purpose merely of depriving the owner of the materials, but of the use and benefit of his patent.

There is no pretence, in the case before us, that the officer had either sold or guaranteed a right to use the machine in the manner pointed out in the patent-right. He sold the *materials* as such, to be applied by the purchaser as he should by law have a right to apply them. The purchaser must therefore act on his own peril, but in no respect can the officer be responsible for his conduct.

Conformably to the agreement of the parties, a nonsuit must be entered.

Fairbanks for the plaintiffs.

W. D. Sohier and *D. Davis* for the defendant.

¹ *Whittemore v. Cutter* (*ante*, p. 429).

Goodyear v. Mathews. 1 Paine.

AMASA GOODYEAR v. ANSON MATHEWS.

[1 Paine, 300.]

A patent, under the law of 1793, is valid, although the invention may have been in use for years anterior to the patent, if the patentee was the original inventor.

A patent for an entire machine is valid, although the invention consists only of an improvement on such machine; but the patentee is entitled to an exclusive use of no more than his improvement.

THIS was an action on the case for the breach of a patent-right.

The patentee, G. W. Robinson, was the inventor of a mode of casting hard metal buttons, with wire eyes, in metal moulds, and the plaintiff was the assignee of the patent.

It appeared on the trial, that several years before the date of the patent, the patentee had taken out another patent for the same thing, but had described his invention so imperfectly that the patent was void. The present patent was [* 301] taken * out, nothing having been done to affect the old one. For several years, during the first patent, the public had disregarded it, and used the invention without restraint.

N. Smith and *S. P. Staples* for the plaintiff.

S. H. Woodruff and *T. S. Williams* for the defendant, contended, that the invention having been used publicly and freely for several years before the date of the patent declared on, the patentee could not resume the exclusive use of his invention as he had attempted. And also, that the patent was too broad, and covered more than the invention.

LIVINGSTON, J., charged the jury as follows on these points:—The first question of law which occurs in this cause is,

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whether the defendant be liable for using the plaintiff's improvement, provided it shall appear that the invention were known or used previous to the application for the patent, if the plaintiff can show that he was actually the inventor anterior to such knowledge or use by others. This is a question of some difficulty, and one which will never be considered as satisfactorily settled, until it be decided by the Supreme Court of the United States. But the Circuit Courts for the Districts of Pennsylvania and of New York having decided the same question, this Court prefers, in the present case, to adhere to those decisions. The opinion of the Court then is, that if you are satisfied that moulds of the construction described in the patent, were known and in use at the time of obtaining the patent, yet if at the same time you believe that the patentee was the inventor of these moulds, although such invention may have been years previous to his application for a patent, he or his assignees are entitled to recover.

* If a patent be taken out for an entire machine, [* 302] when the invention consists only of an improvement on such machine, it is said by the defendant's counsel that the whole patent is void. This, gentlemen, is not the opinion of the Court;¹ for although a patent be obtained for more than the improvement, the patentee is not entitled to more than his improvement, nor is he at liberty to make, use, or vend the original discovery, or to prosecute any person who shall use such original discovery without ingrafting on it the improvement invented by the patentee, especially in a case like the present, where the application was for a patent for the invention of a new and useful improvement in moulds for casting metal buttons.

¹ See the cases of *Whittemore v. Cutter*, (1 Gal. Rep. 479); *Lowell v. Lewis*, (1 Mason's Rep.); *Evans v. Eaton*, (1 Peters C. C. Rep. 323, *contra*.)

Odiorne v. Winkley. 2 Gall.

ODIORNE v. WINKLEY.

[2 Gall. 51.]

A witness cannot be asked a collateral question not relevant to the matter in issue, barely to test his credibility.¹

The original inventor is, at all events, entitled to the patent for his invention.

If a person invent an improvement only on a machine, he is not entitled to a patent of the whole machine.²

The identity or diversity of two machines depends, not on the employment of the same elements or powers of mechanics, but upon the producing of the given effect by the same mode of operation, or the same combination of powers.

CASE for infringement of a patent-right of one Jesse Reed for cutting and heading nails at one operation. The plaintiff claimed as assignee of said Reed.

At the trial, the plaintiff produced and proved the patent of said Reed, dated the 22d of February, 1807, and an assignment to himself of the whole of Reed's patent-right. He also proved, that the machine was a highly useful invention, and that the defendant used two machines, which, in the opinion of the plaintiff's witnesses, cut and headed nails at one operation, substantially upon the same principles, and by the same mode of operation, as the plaintiff's machines, though there were some differences in the structure and operations of some particular parts. The plaintiff also gave evidence of the value of the use of the machines, so used by the defendant, during the time stated in the declaration, and claimed damages to the amount of the value so proved.

¹ *Crowley v. Page*, (7 Carr & Payne, 789); *Harris v. Tiffel*, (2 Campb. R. 637); *Commonwealth v. Buzzell*, (16 Pick. R. 157); *Ware v. Ware*, (8 Greenl. R. 42); *Howell v. Leak*, (2 Campb. R. 14); *Pengal v. Nicholson*, (Wightw. R. 64); Greenl. on Ev. § 432, and cases cited in note.

² *Whittemore v. Cutter*, (1 Gall. 478, note.)

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The defendant, in his defence, relied on three points. 1. That the machines used by him were not substantially, in principles and mode of operation, like the plaintiff's. 2. That if they were, still that the plaintiff ought not to recover, because the machines so used by him were the invention of one Jacob Perkins, under whom he claimed, who had invented, used, and patented the same, long before the * invention and patent of the said Jesse Reed; that [*52] Reed's patent was too broad, it including Perkins's invention aforesaid, upon which Reed had made some improvements, but could not thereby entitle himself to a patent for more than his improvement. 3. That Reed had surreptitiously obtained his patent for the discovery of another man, to wit, of Jacob Perkins. The defendant filed a specification of special matter to be given in evidence under the general issue.

The defendant then produced and proved a patent to Jacob Perkins, dated the 14th of February, 1799, and models were introduced and exhibited to the jury, of Reed's machine, and Perkins's machine; and a number of witnesses were examined by each party, to prove the identity or diversity of the two machines, in all substantial respects, in their principles and modes of operation.

One of the defendant's witnesses, Allan Pollock, having been examined, and having testified, that in his judgment the principles and modes of operation of both machines were substantially the same, and having, with reference to the models before him, explained his reasons for his opinion, and described the powers, principles, and adjustments of both machines, the counsel for the plaintiff produced the model of another nail machine, invented and used by a third person, *under whom neither party claimed*, long before the machine either of Reed or of Perkins existed, and proposed to interrogate the witness as to the principles and mode of operation

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of said machine, and how far it coincided with, or differed from Perkins's machine, in order, as the counsel stated, to show by his answers, and by other testimony, the incorrectness of the witness in his preceding examination, and in his knowledge of mechanics, and to enable the jury [* 53] more fully to estimate the * testimony of the witness. This was objected to on the part of the defendant's counsel.

STORY, J. I am of opinion, that it is an improper inquiry, and overrule it. It can, at best, amount to no more than going into collateral inquiries, not relevant to the matter in issue, barely to prove a witness to be incorrect. And I hold it a clear rule of law, that a witness cannot be asked as to a mere collateral fact, having no relevancy to the issue, in order to draw from him an answer, which might, by other evidence, be shown incorrect, and thereby to discredit him. Besides, if the inquiry were gone into, it would embarrass the jury, by drawing their attention to the principles of a machine not in controversy before the Court, and, whichever way the question as to such machine might be settled, it could have no legal tendency to prove the identity or diversity of the two machines in controversy.¹

After the testimony was closed on each side, STORY, J., directed the jury to the following effect:—

The first question for consideration is, whether the machines used by the defendant are substantially, in their principles and mode of operation, like the plaintiff's machines. If so, it was an infringement of the plaintiff's patent to use them, unless some of the other matters offered in the defence

¹ See *S. P. Rex v. Watson*, (2 Starkie, N. P. 149, 150, 151); *Spendley v. Willett*, (7 East. R. 108.)

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are proved. Mere colorable alterations of a machine are not sufficient to protect the defendant.

The original inventor of a machine is exclusively entitled to a patent for it. If another person invent an improvement on such machine, he can entitle himself to a patent for such improvement only, and does not thereby acquire a right to patent and use the original machine; and if he * does procure a patent for the whole of such a ma- [* 54] chine with the improvement, and not for the improvement only, his patent is too broad, and therefore void. It is often a point of intrinsic difficulty to decide, whether one machine operates upon the same principle as another. In the present improved state of mechanics, the same elements of motion, and the same powers, must be employed in almost all machines. The lever, the wheel, and the screw, are powers well known; and if no person could be entitled to a patent who used them in his machine, it would be in vain to seek for a patent. The material question, therefore, is not whether the same elements of motion, or the same component parts are used, but whether the given effect is produced substantially by the same mode of operation, and the same combination of powers, in both machines. Mere colorable differences, or slight improvements, cannot shake the right of the original inventor. To illustrate these positions: suppose a watch was first invented by a person, so as to mark the *hours* only, and another person added the work to mark the minutes, and a third the seconds; each of them using the same combinations and modes of operations, to mark the hours, as the first. In such a case, the inventor of the second hand could not have entitled himself to a patent embracing the inventions of the other parties. Each inventor would undoubtedly be entitled to his own invention, and no more. In the machines before the Court, there are three great stages in the operations, each producing a given and distinct effect.

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1. The cutting of the iron for the nail. 2. The griping of the nail. 3. The heading of the nail. If one person had invented the cutting, a second the griping, and a third the heading, it is clear that neither could entitle himself to a patent for the whole of a machine, which embraced the inventions of the other two, and, by the same mode [* 55] of operation, produced *the same effect; and, if he did, his patent would be void. Some machines are too simple to be thus separately considered; others again are so complex as to be invented by a succession of improvements, each added to the other. And, on the whole, in the present case, the question for the jury is, whether, taking Reed's machine and Perkins's machine together, and considering them with their various combinations, they are machines constructed substantially upon the same principles, and upon the same mode of operation. If they are, then Reed's patent is void, and the plaintiff is not entitled to recover; and the finding of the jury upon the first special point stated in the defendant's specification of defence must essentially depend upon their decision upon this question.

As to the question whether the patent was surreptitiously obtained, there is no direct or positive proof that Reed had ever seen Perkins's machine before he obtained a patent, but there is evidence from which the jury may legally infer the fact, if they believe that evidence. It is a presumption of law, that when a patent has been obtained, and the specifications and drawings recorded in the patent-office, every man who subsequently takes out a patent for a similar machine, has a knowledge of the preceding patent. As in Chancery, it is a maxim, that every man is presumed to have notice of any fact, upon which he is put upon inquiry by documents within his possession, if such fact could, by ordinary diligence, be discovered upon such inquiry. It is also a presumption of fact, that every man, having within his power

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the exact means of information, and desirous of securing to himself the benefit of a patent, will ascertain for his own interest, whether any one on the public records has acquired a prior right.

The jury will judge, under all the circumstances of this case, whether either or any of the points of defence are *sustained by the evidence; and if so, [* 56] they will find their verdict accordingly. If they find a verdict for the plaintiff, the Court will treble the damages.

Verdict for defendant.

A motion for a new trial was afterwards made and abandoned, and judgment was entered upon the records of a *vacatur* of the patent.

Fairbanks and *B. Whitman* for the plaintiff.

Selfridge and *Prescott* for the defendant.

EVANS v. JORDAN AND MOREHEAD.

[9 Cranch, 199.]

THE Act of January, 1808, for the relief of Oliver Evans, does not authorize those who erected his machinery between the expiration of his old patent and the issuing of the new one, to use it after the issuing of the latter.

TODD, J. — Absent.

THIS was a case certified from the Circuit Court for the district of Virginia, in which the judges were divided in opinion upon the question, whether after the expiration of the original patent granted to Oliver Evans, a general right to use his discovery was not so vested in the public as to require and justify such a construction of the act passed in January, 1808, entitled "An Act for the relief of Oliver Evans," as to

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exempt from either single or treble damages, the use, subsequent to the passage of the said act, of the machinery therein mentioned, which was erected subsequent to the expiration of the original patent and previous to the passage of the said act. The act (vol. 9, p. 20) authorizes the Secretary of State to issue letters-patent to Oliver Evans, in the manner and form prescribed by the general patent law, granting to him for the term of 14 years the exclusive right of making, using, and vending for use the machinery in question, "*provided*, that no person who may have heretofore paid the said Oliver Evans for license to use his said improvements, shall be obliged to renew the said license, or be subject to damages for not renewing the same ; *and provided also*, that no person who *shall have* used the said improvements, *or have* erected the same for use, before the issuing of the said patent, shall be liable to damages *therefor*."

Harper, for the plaintiff.

The former patent of the plaintiff having expired, Congress, in consideration of the particular circumstances of his case, authorized a new patent to issue for another term of 14 years. Between the expiration of the old and the issuing of the new patent, the defendants had erected and used and continued to use the plaintiff's machinery in the manufacture of flour, contending that they were protected by the proviso of the Act of January 21st, 1808.

We contend that the proviso does not authorize them to continue the use of the machinery after the issuing of the new patent, but merely protects them from damages for *having* used and for *having* erected for use the machinery in question, *prior* to the issuing of the new patent.

The second patent was intended to place Evans in the situation in which he would have been if the first patent had continued in force, except as to his right to damages for acts

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done in the intermediate time between the first and second patent. If the defendants chose to continue to use the machinery after the new patent, they were bound to pay for the right to use it.

E. J. Lee, and P. B. Key, contra.

If the construction contended for on the other side be correct, the proviso was wholly useless, because the defendants needed no such protection. Evans could have no claim against them for acts done after his patent had expired, and before the issuing of the new patent. The defendants had a full and perfect right to erect and use the machinery.

A law to oblige them now to abandon * their pro- [* 201] perty or to pay what Mr. Evans may choose to exact, is in the nature of an *ex post facto* law ; and although it may not be absolutely unconstitutional, yet is so far within the spirit of the constitution, that this Court will not give such a construction to the proviso, if it can possibly be avoided. The proviso says that no person *who shall have erected the machinery for use* shall be liable to damages therefor. The defendants *had* erected the machinery for use, and are consequently not liable therefor. What can the proviso mean, unless to give those who are in the situation of the defendants the right to use their own machines lawfully erected ? The inventions had become public property ; every one had a right to use them. Congress did not mean to take away that vested right from those who had availed themselves of it. To deprive a person of the *use* of his property is equivalent to depriving him of the property itself. Congress could not mean to do this. This Court will give the act such an equitable construction, as will give effect to the proviso.

Harper, in reply.

The words of the proviso are clear and explicit, and admit

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not of construction. The legislature may have supposed that the new patent, which was intended to be a continuation of the old one, might have subjected those, who had already erected the machinery, to damages, and intended to guard against them. It is not certain that under the law, under which the patent issued, this would not have been the effect; but it is sufficient if the legislature supposed it would have been. We are not bound to show the motives of the legislature; if their words are clear and explicit, there is no room for construction. The acts which are protected by the proviso are acts done *before* the issuing of the patent; the opposite counsel contend, that the legislature, when they said "*before*," meant *after*. The proviso is too plain to bear an argument.

Todd, J. — Absent. March 4th.

WASHINGTON, J., delivered the opinion of the Court as follows:

[* 202] * The question certified to this Court, by the Circuit Court for the district of Virginia, and upon which the opinion of this Court is required, is, whether, after the expiration of the original patent granted to Oliver Evans, a general right to use his discovery was not so vested in the public as to require and justify such a construction of the act passed in January, 1808, entitled "An Act for the relief of Oliver Evans," as to exempt from either treble or single damages, the use, subsequent to the passage of the said act, of the machinery therein mentioned, which was erected subsequent to the expiration of the original patent and previous to the passage of the said act.

The act, upon the construction of which the judges of the Circuit Court, were opposed in opinion, directs a patent to be granted, in the form prescribed by law, to Oliver Evans for 14 years, for the full and exclusive right of making, constructing, using, and vending to be used, his invention, discovery,

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and improvements in the art of manufacturing flour and meal, and in the several machines which he has discovered, invented, improved, and applied to that purpose.

The *proviso* upon which the question arises is in the following words: “ *provided*, that no person who may have heretofore paid the said Oliver Evans for license to use the said improvements, shall be obliged to renew said license, or be subject to damages for not renewing the same; and, *provided also*, that no person who shall have used the said improvements, or have erected the same for use, before the issuing of the said patent, shall be liable to damages therefor.”

The language of this last proviso is so precise, and so entirely free from all ambiguity, that it is difficult for any course of reasoning to shed light upon its meaning: It protects against any claim for damages which Evans might make, those who may have used his improvements, or who may have erected them for use, *prior to the issuing of his patent* under this law. The protection is limited to acts done prior to another act thereafter to be performed, to wit, the issuing of the patent. To extend it, by construction, to acts which might be done subsequent to the issuing of the patent, would be to make, not to interpret the law.

* The injustice of denying to the defendants the [* 203] use of machinery which they had erected after the expiration of Evans’s first patent, and prior to the passage of this law, has been strongly urged as a reason why the words of this proviso should be so construed as to have a prospective operation. But it should be recollected that the right of the plaintiff to recover damages for using his improvement after the issuing of his patent under this law, although it had been erected prior thereto, arises not under this law, but under the general law of the 21st of February, 1793.¹ The provisos in

¹ The 5th section of the act of 21st February, 1793, which is the only section of that act which gives damages for violation of the patent-right, is

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this law profess to protect, against the operation of the general law, three classes of persons ; those who had paid Evans for a license prior to the passage of the law ; those who *may have used* his improvements ; and those who *may have erected* them for use, before the issuing of the patent.

The legislature might have proceeded still further, by providing a shield for persons standing in the situation of these defendants. It is believed that the reasonableness of such a provision could have been questioned by no one. But the legislature have not thought proper to extend the protection of these provisos beyond the issuing of the patent under that law, and this Court would transgress the limits of judicial power by an attempt to supply, by construction, this supposed omission of the legislature. The argument, founded upon the hardship of this and similar cases, would be entitled to great weight, if the words of this proviso were obscure and open to construction. But considerations of this nature can never sanction a construction at variance with the manifest meaning of the legislature, expressed in plain and unambiguous language.

The argument of the defendants' counsel that unless the construction they contend for be adopted, the proviso is senseless and inoperative, is susceptible of the same answer.

[* 204] * Whether the proviso was introduced from abundant caution, or from an opinion really entertained by the legislature that those who might have erected these improvements, or might have used them prior to the issuing of the patent, would be liable to damages for having done so, it is impossible for this Court to say. It is not difficult, however, to imagine a state of things which might have afforded some ground for such an opinion.

repealed by the 4th section of the act of the 17th of April, 1800, vol. 5, p. 90, the 3d section of which act gives treble damages, for the violation of any patent granted pursuant to that act, or the act of 1793.

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Although this Court has been informed, that the judge, who delivers this opinion, knows that the former patent given to Evans had been adjudged to be void by the Circuit Court of Pennsylvania, prior to the passage of this law, yet that fact is not recited in the law, nor does it appear that it was within the view of the legislature: and if that patent-right had expired by its own limitation, the legislature might well make it a condition of the new grant that the patentee should not disturb those who had violated the former patent. This idea was certainly in the mind of the legislature which passed the act of the 21st of February, 1793, which, after repealing the act of the 10th of April, 1790, preserves the rights of patentees under the repealed law only in relation to violations committed after the passage of the repealing law.

If the decision above mentioned was made known to the legislature, it is not impossible but that a doubt might have existed whether the patent was thereby rendered void *ab initio*, or from the time of rendering the judgment; and if the latter, then the proviso, would afford a protection against all preceding violations. But whatever might be the inducements with the legislature to limit the proviso, under consideration, as we find it, this Court cannot introduce a different proviso totally at variance with it in language and intention.

It is the unanimous opinion of this Court that the act passed in January, 1808, entitled "An Act for the relief of Oliver Evans," ought not to be construed as to exempt from either treble or single damages, the use, subsequent to the passage of the said act, of the machinery therein mentioned, which was erected subsequent to the expiration of the original patent, and previous to the passage of the said act. Which opinion is ordered to be certified to the Circuit Court for the district of Virginia.

Tryon v. White. 1 Peters, C. C.

TRYON v. WHITE.

[1 Peters, C. C., 96.]

It is not a foundation for a nonsuit that the declaration for an invasion of a patent-right, does not lay the act complained of to be "against the form of the statute," under which the rights of plaintiff are derived. *Contra formam statuti*, is a matter of form, and may be cured by verdict.

When the declaration professes to set forth the specification in a patent, as part of the grant, the slightest variance is fatal, and the defendant is entitled to claim a nonsuit. In general, it is sufficient to state the grant in substance in the declaration.

ACTION for violating a patent-right of the plaintiff, for a machine for making combs.

After reading the pleadings, the defendant moved for a nonsuit, on the ground that the declaration does not lay the act complained of to be against the form of the statute, but merely claims damages at common law.¹ To support the practice of a motion for a nonsuit, at this stage of the cause, the counsel cited 1 Esp. Rep. 484; 2 Camp. 397; 1 Id. 253.

On the other side, the counsel contended, that the declaration states the patent to be granted under the act [* 97] of Congress, and * brings them into court, and also states the case precisely within the act. *Contra formam statuti*, therefore, need not have been laid. Mr. Chitty gives the forms of declarations in this case, in which these words are not inserted.²

The Court refused to direct a nonsuit on this ground, inclining to the opinion, that, as the case stated in the declaration, is precisely within the act of Congress, to which the

¹ 1 Com. Dig. 329; 1 Chitty on Plead. 357; 2 East, 341; Wil. Rep. 599; Fessenden's Forms, 209; 3 Wooddessen, 214; 4 Burr. 2387; 5 Johns. Rep. 175; 1 Saund. 135, p. 4; 4 Burr. 2333, 2351.

² 1 Chitty, 336.

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declaration refers ; *contra formam*, &c., is matter of form, the want of which would be cured by verdict.

The declaration, after stating the patent, which refers to the specification, proceeds to set forth the specification *verbatim* ; but in doing so, the word *whirl* in the specification, is called *wheel* in the declaration. The specification speaks of the *wheel* and the *whirl*, as distinct parts of the machine. For this variation, the defendant renewed his motion for a nonsuit.¹

WASHINGTON, J. This is an action brought upon a grant to recover damages for the privilege secured by it. The grant refers to the specification, to explain what is granted ; and, although it would have been sufficient to state in the declaration the substance of the grant, yet, when it professes to set forth the specification as a part of the grant, according to its tenor, the slightest variance is fatal.

Nonsuit directed.

A rule was afterwards granted, to show cause at the next Court, why the nonsuit should not be set aside.

¹ Bull. 6 ; Vin. Tit. Variance, A.

EVANS v. KREMER. 1 Peters, C. C.

EVANS v. KREMER.¹

[1 Peters, C. C., 215.]

IF to an action for a violation of a patent-right, the defendant plead the general issue ; it is sufficient in the notice of special matter to state, that the plaintiff is not the original inventor of the machine, for which the patent has been obtained, if the defence is founded on such an allegation ; and it is not necessary to state in the notice who was the inventor, or who had previously used the machine. If the notice specifies some persons who used the machine, the use thereof by others may be given in evidence.

THIS was an action for the violation of the plaintiff's patent-right to the *hopper-boy*, part of his machinery for manufacturing flour. Upon the general issue, the defendant gave the plaintiff notice in writing, that at the trial he should contend that the plaintiff was not the original inventor of the *hopper-boy*, but that the same had been used long before the plaintiff's discovery, in certain mills, which were mentioned by name in the notice. The defendant, at the trial, proved that a *hopper-boy* had been used in the mills so specified in the notice, some years before the date of the plaintiff's first patent ; and was proceeding to prove the use of it in other mills, not specified in the notice. This was objected to.

WASHINGTON, J. That the plaintiff was not the original inventor, is a plea in bar, and if this be the ground of defence, the plaintiff must come prepared to prove that he was. Had the defendant filed a special plea on this point, he need not have set out in his plea the particular facts on which the plea

¹ The Act of July 4, 1836, provides that whenever the defendant relies upon the fact of a *previous* invention, knowledge, or use of the thing patented, he shall state in his notice of special matter the names and places of residence of those who he intends to prove possessed such prior knowledge of the thing, and where the same had been used.

Evans v. Kremer. 1 Peters, C. C.

was grounded, or specified the mills where the hopper-boy had been used. Neither was it necessary for him to make such specification in his notice, when he chose to avail himself of the permission granted by the act of Congress, of pleading the general issue, and giving the special matter in evidence. The special matter of defence is, that the plaintiff is not the original *inventor, for that the machine [*216] was known and used before the time when he claimed to be the inventor ; and notice of this was sufficient without being more specific. This was sufficient to prevent surprise, and to warn the plaintiff to be prepared to maintain his title, in relation to the question of original discovery. To go further, might lead, step by step, to introduce a degree of nicety and precision in these notices, which would be productive of great inconvenience, and would render the privilege of pleading the general issue, rather disadvantageous to the defendant than a benefit. The evidence was admitted.¹

NOTE. Before the opening was concluded, the plaintiff's counsel, because of the absence of their client, suffered a nonsuit.

Messrs. *Ingersoll, Rawle* and *C. J. Ingersoll*, for plaintiff.

Messrs. *Binney, Sergeant*, and *J. R. Ingersoll*, for defendant.

¹ In the case of *Evans v. Eaton*, the Circuit Court of Pennsylvania having admitted testimony similar to that which was allowed to be given in this case, upon the same notice ; an exception was taken to the opinion of the Court, and the principles laid down by the Circuit Court in the case of *Evans v. Kremer*, were recognized and affirmed by the Supreme Court of the United States. 3 Wheaton, 503.

Oliver Evans v. Eaton. 1 Peters, C. C.

OLIVER EVANS v. EATON.

[1 Peters, C. C., 322.]

ACTION for the violation of a patent-right.

A grant by the legislature of a state, of an exclusive privilege in an invention for a limited time, does not imply an irrevocable contract with the people, that at the expiration of the period the invention shall become their property. The state may revive the grant, or refuse it, and in the latter case, at the end of the period, the invention may be used by any one.

There is nothing in the Constitution of the United States which forbids Congress to pass laws violating the obligation of contracts, although such a power is denied to the States.

In the notice of special matter, to be given in evidence by the defendant, certain mills were mentioned, where a machine, of which the plaintiff claimed to be the inventor, was in use prior to the date of the alleged discovery of the plaintiff. It is competent to the defendant to give evidence of the use of the machine in other mills, than those mentioned in the notice of special matter.

If a witness is sworn on his *voir dire*, no other evidence to prove him incompetent can be given. But if, in any part of his examination, it should afterwards appear that the witness was incompetent, his testimony will be set aside by the Court.

The Court will not permit the plaintiff to put a question to a witness, called by him to rebut the defendant's testimony, which is not intended to contradict or discredit the defendant's witnesses, and which question is not rendered necessary by evidence given by the defendant.

Although counsel profess that the object of testimony which is offered by them was to discredit one of the witnesses of the opposite party, yet if the Court consider the testimony cannot have that effect, they will not permit it to be given.

The patent granted to Oliver Evans, contains no grant of a right to the several machines, but it is confined to *the improvements in the art of manufacturing flour* by those machines; although the Act of Congress, authorizing the grant of the patent, authorized the issuing of a patent for *the several machines*, as well as for the *entire improvement*.

The schedule annexed to letters-patent, is part of the patent, so far as it is a *description of the machine*, but no further.

Summary of the provisions of the patent laws.

A patent may be for a new and useful *art*; but it must be practical, and it must be explicable, and referrible to something which may prove it to be useful.

• Oliver Evans v. Eaton. 1 Peters, C. C.

* The discovery must not only be useful, but new, and it must not [* 323] have been known and used before in any part of the world ; and the title of the patentee to an invention may be impeached, although he was ignorant at the time he received the letters-patent that the invention had been in use before his discovery.

If the discovery be of an *improvement* only, it must be of an improvement in the principles of a machine, art, or manufacture before known or used ; if the *form* or *proportions* are improved, it is not a discovery.

The grant of an exclusive privilege by the patent, can only be for the discovery recited and described in the patent and specification.

If the patentee is the discoverer of an *improvement*, and the patent is for the whole machine, it is void.

A machine or an improvement, may be new and entitled to a patent, although parts of it were before known and used.

The combination of old machines to produce a new and useful result, is a discovery for which a patent may be granted.

A recovery cannot be had by the patentee of the discovery of a useful combination of known machines, in an action against any one who may use one of the known machines of which the combination is formed.

Quære. If, in an action for the violation of a patent for a new and useful improvement by the combination of machines, the plaintiff can recover against one who has used one of the machines, employed in such combination although he may have been the inventor of the machine used by the defendant, In such a case, the inventor should take out a patent for each machine of which he may have been the discoverer, and he should institute an action for the violation of his rights under such a patent.

An offer to the patentee of an invention, to take from him a license to use his alleged discovery, does not take away the right of the person who made the offer to deny afterwards that the patentee was the original inventor.

There is no limitation of the period in which, when the general issue is pleaded to an action on a patent, the defendant may give in evidence that the patentee is not the original inventor.

If the original inventor of a machine abandons the use of it and does not take out a patent for it, no other person can entitle himself to a patent for the machine.

ACTION for a violation of the plaintiff's patent-right to his improvement in the art of manufacturing flour, &c.

The declaration contains a number of counts, charging a breach of the whole patent, and also charging the defendant with having made and used each particular machine,

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[* 324] by means * of which this manufacture is performed and which are particularly described in the schedule.¹

¹ "TO JAMES MADISON, ESQ., SECRETARY OF STATE.

The Petition of Oliver Evans, of the city of Philadelphia, a citizen of the United States, respectfully sheweth,

That your petitioner having discovered certain useful improvements, applicable to various purposes, but particularly to the art of manufacturing flour and meal, prays a patent for the same, agreeably to the act of Congress, entitled, "An Act for the relief of Oliver Evans."

The principles of these improvements consist,

1. In the subdivision of the grain, or any granulated or pulverized substance; in elevating and conveying them from place to place, in small separate parcels; in spreading, stirring, turning, and gathering them by regular and constant motion, so as to subject them to artificial heat, the full action of the air to cool and dry the same when necessary, to avoid danger from fermentation, and to prevent insects from depositing their eggs during the operation of the manufacture.

2. In the application of the power which moves the mill, or other principal machine, to work any machinery which may be used to apply the said principles, or to perform the said operations by constant motion, and continued rotation, to save expense and labor.

The machinery by him already invented, and used for applying the above principles, consists of an improved elevator, an improved conveyor, an improved hopper-boy, an improved drill, and an improved kiln-drier. For a particular explanation of the principles, and a description and application of the machines which he has so invented and discovered, he refers to the specifications and drawings hereunto annexed; and he is ready, if the Secretary of State shall deem it necessary, to deliver models of the said machines.

OLIVER EVANS.

DESCRIPTION

Of the several machines invented by Oliver Evans, and used in his improvement on the process of the art of manufacturing flour or meal from grain, and which are mentioned in his specification as applicable to other purposes.

No. I. — THE ELEVATOR.

Plate vi. Fig. 1. AB, represents an elevator for raising grain for the

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*** To this declaration the general issue was [* 325] pleaded, and notice of the special matter of defence**

granary O, and conducting it by spouts into a number of different garners as may be necessary, where a mill grinds separate parcels for toll or pay. The upper pulley being set in motion, and the little gate, A, drawn, the buckets fill as they pass under the lower, and empty as they pass over the upper pulley, and discharge into the movable spout B, to be by it directed to any of the different garners.

Fig. 2. Part of the strap and bucket, showing how they are attached.

A, a bucket of sheet iron, formed from the plate 8, which is doubled up and riveted at the corners, and riveted to the strap.

B, a bucket made of tough wood, say willow, from the form 9, being bent at right angles at e c, one side and bottom covered with leather, and fastened to the strap by a small strap of leather, passing through the main strap, and tacked to its sides.

C, a lesser bucket of wood, bottomed with leather, the strap forming one side of it.

D, a lesser bucket of sheet iron, formed from the plate 11, and riveted to the strap which forms one side of the bucket.

Fig. 6. The form of a gudgeon for the lower pulley.

7. The form of the gudgeons of the shaft of the upper pulley.

12. The form of the buckle for tightening the elevator strap.

Fig. 17, Plate vii. represents an elevator, applied to raise grain into a granary, from a wharf, &c., by a horse.

16, represents an elevator raising the meal in a grist-mill.

18, represents an elevator wrought by a man.

Plate viii. 35, 39, represents an elevator raising grain from the hold of a ship.

33, 34, represents an elevator raising meal from three pair of stones, in a flour mill, with all the improvements complete.

Plate ix. Fig. 1, CD represents an elevator raising grain from a wagon. E represents the movable spout, and manner of fixing it, so as to direct the grain into the different apartments.

Plate x. 2, 3, and 11, 12, represents elevators, applied to raise rice in a mill for hulling and cleaning rice.

The straps of elevators are best made of white harness leather.

No. II. — THE CONVEYOR.

Plate vi. Fig. 3, represents a conveyor for conveying meal from the millstones into the elevator, stirring it to cool at the same operation, show-

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intended to be relied on at the trial, was given to the plaintiff. The material defence stated in the notice was, that the

ing how the flights are set across the spiral line, to change from the principle of an endless screw, to that of a number of ploughs, which answer better for the purpose of moving meal, showing also the lifting flights set broadside foremost, and the manner of connecting it to the lower pulley of the elevator which turns it.

Fig. 4. The gudgeon of the lower pulley of the elevator connected to the socket of the conveyor.

5. An end view of the socket, and the band which fastens it to the conveyor.

Plate viii. 37, 36, — 4 represents a conveyor for conveying grain from a ship to the elevator 4 — 5, with a joint at 36, to let it rise and lower with the tide.

44 — 45. A conveyor for conveying grain to different garners from an elevator.

31 — 32. A conveyor for conveying tail flour to the meal elevator, or the coarse flour to the eye of the stone.

Plate ix. Fig. 11, represents a conveyor from conveying the meal from two pair of stones, to the elevator connected to the pulley, which turns them both.

Plate x. 2 — 11, represents conveyors applied to convey rice, in a rice mill, from a boat or wagon to the elevator, or from the fan to an elevator.

No. III. — THE HOPPER-BOY.

Plate vii. Fig. 12, represents a hopper-boy complete for performing all the operations specified, except that only one arm is shown.

AB, the upright shaft; CED, the arms, with flights and sweeps.

E, the sweeper to fill the bolting hoppers HH.

CFE, the brace, or stay, for steadying the arms.

P, the pulley, and W, the weight, that is to balance the arms, to make them play lightly on the meal, and rise or fall, as the quantity increases or diminishes.

ML, the leader, N, the hitch stick, which can be moved along the leading line, to shorten or lengthen it.

Fig. 13. SSS, the arms turned bottom up, showing the flights and sweepers complete at one end, and the lines on the other end show the mode for laying out for the flights, so as to have the right inclination and distance, according to the circle described by each, and so that the flights of one end may track between those of the other. The sweepers and the

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plaintiff is not the original * inventor of the hopper- [* 326]
boy described in the schedule, but that the same

flights at each end of the arms are put on with a thumb-screw, so that they may be moved, and so that these flights may be reversed, to drive meal outwards from the centre, and at the same time trail it round the whole circle ; this is of use sometimes, when we wish to bolt one quantity which we have under the hopper-boy, without bolting that which we are grinding, and yet to spread that which we are grinding to dry and cool, laying round the hopper-boy, convenient to be shovelled under it, as soon as we wish to bolt it.

Fig. 15. The form of the pivot for the bottom of the upright shaft.

14. The plate put on the bottom of the shaft to rest on the shoulder of the pivot ; this plate is to prevent the arm from descending so low as to touch the floor.

Plate viii. Fig. 25, represents a hopper-boy attending two bolts in a mill, with all the improvements complete.

Plate ix. The hopper-boy is shown over QQ. Fig. 4 is the arm turned upside down, to show the flights and sweepers.

No. IV. — THE DRILL.

Plate vi. Fig. 1. HG represents a drill conveying grain from the different garners to the elevator, in a mill for grinding parcels for toll or pay.

Plate vii. Fig. 16. Bd a drill, conveying meal from the stones in a grist mill, to the elevator.

The strap of this machine may be made broad, and the substance to be moved may be dropped on its upper surface, to be carried and dropped over the pulley, at the other end ; in this case it requires one bucket like those of the elevator, to bring up any that may spill off the strap.

For full and complete directions for proportioning all the parts, constructing and using the above described machines, see the book which I have published for that express purpose, entitled, " The Young Millwright and Miller's Guide." See plate viii. representing a mill, with three pair of millstones, with all the improvements complete, except the kiln-drier.

No. V. — THE KILN-DRIER.

Plate ix. Fig. 2. A, the stove, which may be constructed simply of six plates, and inclosed by a brick wall, lined with a mortar composed of pulverized charcoal and clay. B, the pipe for carrying off the smoke. CC, the air-pipes, connecting the space between the stove and wall with the conveyor. DD, the pipes for the heated air to escape.

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had been used in certain mills, which are named, and in sundry others which are not enumerated, long before the pretended discovery of the plaintiff.¹

The air is admitted at the air-hole below, regulated by a register, as experience shall teach to be best, so as not to destroy the principle which causes the flour to ferment easily, and rise in the process of baking. The conveyors must be covered close; the meal admitted by small holes as it falls from the millstones.

OLIVER EVANS."

Witness, { Samuel H. Smith,
 { Jo. Gales, Jun.

THE UNITED STATES OF AMERICA.

To all to whom these Letters-Patent shall come :

Whereas Oliver Evans — of the city of Philadelphia, a citizen of the United States, hath alleged that he hath invented a new and useful improvement in the art of manufacturing flour and meal, by means of certain machines, which he terms an improved elevator, an improved conveyor, an improved hopper-boy, an improved drill, and an improved kiln-drier: which machines are moved by the same power that moves the mill or other principal machinery, and in their operation, subdivide any granulated or pulverized substance, elevate and carry the same from place to place, in small and separate parcels, spread, stir, turn, and gather them by regular and constant motion, so as to subject them to artificial heat, and the air to dry and cool when necessary: a more particular and full description, in the words of the inventor, is hereby annexed in a schedule; which improvement has not been known or used before his application — has affirmed that he does verily believe that he is the true inventor or dis-

¹ EVANS v. EATON.

SIR, — Please to take notice, that upon the trial of these causes respectively, the respective defendants will give in evidence, under the general issue the following special matters, viz. :

1. That the improved hopper-boy, per which *inter alia*, the plaintiff in his declaration alleges, that he has obtained a patent, was not originally discovered by the patentee, but had been in use anterior to the supposed discovery of the patentee, in sundry places, viz., at the mill of George Fry and Jehu Hollingsworth, in Dauphin county, Pennsylvania, at Chris-

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* The plaintiff gave in evidence, an act of the [* 327] legislature of Pennsylvania, dated the 29th of March,

coverer of the said improvement, and, agreeably to the act of Congress, entitled, "An Act for the relief of Oliver Evans," which authorizes the Secretary of State to secure to him by patent, the exclusive right to the use of such improvement in the art of manufacturing flour and meal, and in the several machines which he has discovered, improved, and applied to that purpose, he has paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose: *These are therefore* to grant, according to law, to the said Oliver Evans, his heirs, administrators, or assigns, for the term of fourteen years, from the twenty-second day of January, 1808, the full and exclusive right and liberty of making, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Oliver Evans himself, in the schedule hereto annexed, and is made a part of these presents.

In testimony whereof, I have caused these Letters to be made Patent, and the seal of the United States to be hereunto affixed.

[SEAL.]

Given under my hand, at the city of Washington, this twenty-second day of January, in the year of our Lord, one thousand eight hundred and eight, and of the Independence of the United States of America, the thirty-second.

TH. JEFFERSON.

By the President,

JAMES MADISON, Secretary of State.

tian Stouffer's mill, in Warwick township, Lancaster county, Pennsylvania, at Jacob Stouffer's mill in the same county, at Richard Downing's mill, in Chester county, Pennsylvania, at Buffington's mill, on the Brandywine, at Daniel Hutton's mill, in Lancaster county, Pennsylvania, at Henry Stouffer's mill, in York county, Pennsylvania, at Diehl's mill, in the same county, or at some of the said places; and also in sundry other places in the said State of Pennsylvania, the State of Maryland, and elsewhere in the United States.

2. That the patent given to the plaintiff, as he alleges in his declaration,

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1787, granting to the plaintiff the exclusive privilege of making, using, and vending to be used, his invention of the art of

City of Washington, to wit:

I DO HEREBY CERTIFY, That the foregoing Letters-Patent were delivered to me on the twenty-second day of January, in the year of our Lord, one thousand eight hundred and eight, to be examined; that I have examined the same, and find them conformable to law. And I do hereby return the same to the Secretary of State, within fifteen days from the date aforesaid, to wit: on this twenty-second day of January, in the year aforesaid.

C. A. RODNEY, Attorney-General of the United States.

THE SCHEDULE

Referred to in these letters-patent, and making part of the same, containing a description, in the words of the said Oliver Evans, of his improvements in the art of manufacturing flour and meal.

“My first principle is to elevate the meal as fast as it is ground in small separate parcels, in continued succession and rotation, to fall on the cooling floor, to spread, stir, turn, and expose it to the action of the air, as much as possible, and to keep it in constant and continual motion, from the time it is ground until it be bolted; this I do to give the air full action, to extract the superfluous moisture from the meal, while the heat, generated by the friction of grinding, will repel and throw it off, and the more

is more extensive than his discovery or invention, for that certain parts of the machine in the said patent, called an improved hopper-boy, and which the plaintiff claims as his invention or discovery, viz., the upright shaft, arms, and flights, and sweeps, or some of them, and those parts by which the meal is spread, turned, and gathered, at one operation, and also several other parts, were not originally invented or discovered by him, but were in use prior to his said supposed invention or discovery, viz., at the places above mentioned or some of them.

3. That the said patent is also more extensive than the plaintiff's invention or discovery, for that the application of the power that moves the mill or other principal machine to the hopper-boy, is not an original invention or discovery by the plaintiff, but was in use anterior to his said supposed invention or discovery, viz., at the places above-mentioned, or at some of them.

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manufacturing flour, for *fourteen years. Also the [* 328] patent upon which this action is brought, dated the

effectually dry and cool the meal, fit for bolting in the course of the operation, and save time and expense to the miller. Also to avoid all danger from fermentation, by its laying warm in large quantities as is usual; and to prevent insects from depositing their eggs, which may breed the worms often found in good flour. And further to complete this principle, so as to dry the meal more effectually, and to cause the flour to keep sweet a longer space of time, I mean to increase the heat of the meal as it falls ground from the millstones, by application of heated air, that is to say, to kiln-dry the meal as it is ground, instead of kiln-drying the grain as usual. The flour will be fairer and better than if made from kiln-dried grain, the skin of which is made so brittle that it pulverizes and mixes with the flour. This principle I apply by various machines which I have invented, constructed, and adapted to the purposes hereafter specified, numbered 1, 2, 3, 4, 5.

My second principle is to apply the power that moves the mill or other principal machine to work my machinery, and by them to perform various operations which have always heretofore been performed by manual force, and thus greatly to lessen the expense and labor of attending mills and other works.

The application of those principles, including that of kiln-drying the meal, during the process of the manufacture, or otherwise to the improvement of the process of manufacturing flour, and for other purposes, is what

4. That the said patent is void, because it purports to give him the exclusive property, in an improvement in the art of manufacturing meal, by means of a certain machine, termed an improved hopper-boy, of which the said plaintiff is not the original inventor or discoverer, parts of the machine, in the description thereof referred to by the patent, having been in use anterior to the plaintiff's said supposed discovery, viz., at the places above mentioned, or some of them, and the said patent and description therein referred to, contains no statement, specification, or description, by which these parts, so used as aforesaid, may be distinguished from those of which the said plaintiff may have been the inventor or discoverer; protesting at the same time, that he has not been the inventor or discoverer, of any of the parts of the said machine.

5. That the improved elevator described in the declaration, or referred to therein, was not originally discovered by the plaintiff, but was anterior to his said supposed discovery or invention, described in certain public

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22d of January, 1808. It recites the allegation of the plaintiff, that he had invented a new and useful improvement in

I claim as my invention and improvement in the art, as not having been known or used before my discovery, knowing well that the principles once applied by one set of machinery, to produce the desired effect, others may be contrived and variously constructed, and adapted to produce like effects in the application of the principles, but perhaps none to produce the desired effect more completely, than those which I have invented and adapted to the purposes, and which are hereinafter specified.

No. 1. THE ELEVATOR. — Its use is to elevate any grain, granulated or pulverized substances. Its use in the manufacture of flour or meal is to elevate the meal from the millstones in small separate parcels, and to let it fall through the air on the cooling floor as fast as it is ground. It consists of an endless strap, rope, or chain, with a number of small buckets attached thereto, set to revolve round two pulleys, one at the lowest, and the other at the highest point between which the substance is to be raised. These buckets fill as they turn under the lower, and empty themselves as they turn over the pulley. The whole is inclosed by cases of boards to prevent waste.

No. 2. THE CONVEYOR. — Its use is to convey any grain, gran-
 works or books, viz., in Shaw's Travels, in the first volume of the Universal History, in the first volume of Mortimer's Husbandry, in Ferguson's Mechanics, in Vitruvius, in Bossue's Historie des Mathematiques, in Wolf's Cours de Mathematiques, in Desagulier's Experimental Philosophy, and in Pronoy's Architecture Hydraulique, or in some of them.

6. That the said patent is more extensive than the invention or discovery of the plaintiff, because certain parts of the machine, called an improved elevator, were anterior to the plaintiff's said supposed invention or discovery, described in certain public works or books, viz., the works or books above mentioned, or some of them; and that the said patent is void, because it neither contains, nor refers to any specification or description, by which the parts so before described, in said public works, (or books,) may be distinguished from those parts of which the plaintiff may be the inventor or discoverer; protesting at the same time, that he has not been the inventor or discoverer of any of the parts of the said machine.

I am, respectfully,

C. J. Ingersoll, for plaintiff.

March 8, 1816.

your obedient servant,

HOR. BINNEY, for defendant.

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the art of manufacturing flour and meal, by * means [* 329]
of certain machines, which he terms an improved

lated or pulverized substances, in a horizontal, ascending, or descending direction. Its use in the process of the art of manufacturing flour, is to convey the meal from the millstones, as it is ground, to the elevator, to be raised, and to keep the meal in constant motion, exposing it to the action of the air; also in some cases to convey the meal from the elevator to the bolting hopper, and to cool and dry it fit for bolting, instead of the hopper-boy, No. 3; also to mix the flour after it is bolted; also to convey the grain from one machine to another, and in this operation to rub the impurities off the grain. It consists of an endless screw, set to revolve in a tube, or section of a tube, receiving the substance to be moved at one end, and delivering it at the other end; but for the purpose of conveying flour or meal, I construct it as follows: instead of making it a continued spiral, which forms the endless screw, I set small boards, called flights, at an angle crossing the spiral line; these flights operate like so many ploughs following each other, moving the meal from one end of the tube to the other with a continued motion, turning and exposing it to the action of the air to be cooled and dried. Sometimes I set some of the flights to move broadside foremost, to lift the meal from one side to fall on the other, to expose it to the air more effectually.

No. 3. THE HOPPER-BOY. — Its use is to spread any grain, granulated or pulverized substances, over a floor or even surface, to stir it and expose it to the air to dry and cool it, when necessary, and at the same time to gather it from the circumference of the circle it describes, to or near the centre, or to spread it from the centre to the circumference, and leave it in the place where we wish it to be delivered, when sufficiently operated on. Its use in the process of manufacturing flour, is to spread the meal as fast as it falls from the elevator over the cooling floor, on the area of a circle of from eight to sixteen feet more or less in diameter, according to the work of the mill, to stir and turn it continually, and to expose it to the action of the air to be dried and cooled, and to gather it into the bolting hoppers, and to attend the same regularly. It consists of an upright shaft made round at the lower end, about two thirds of its length, and set to revolve on a pivot in the centre of the cooling floor; through this shaft, say five feet from the floor, is put a piece called the leader, and the lower end of the shaft passes very loosely through a round hole in the centre of another piece called the arms, say from eight to sixteen feet in length, this last piece revolving horizontally, describes the

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elevator, an improved conveyor, an improved hopper-boy, an improved drill, and an improved kiln-drier, which machines

circle of the cooling floor, and is led round by a cord, the two ends of which are attached to the two ends of the arms, and passing through a hole at each end of the leader, so that the cord will reeve to pull each end of the arms equally. The weight of the arms is nearly balanced by a weight hung to a cord, which is attached to the arms, and passes over a pulley near to the upper end of the upright shaft, to cause the arms to play lightly, pressing with only part of their weight on the meal that may be under it. The foremost edges of the arms are sloped upwards, to cause them to rise over and keep on the surface of the meal as the quantity increases; and if it be used separately and unconnected with the elevator, the meal may be thrown with shovels within its reach, while in motion, and it will spread it level, and rise over it until the heap be four feet high or more, which it will gather into the hoppers, always taking from the surface, after turning it to the air a great number of times. The underside of these arms are set with little inclining boards, called flights, about four inches apart next the centre, and gradually closing to about two inches next the extremities, the flights of the one arm to track between those of the other, they operate like ploughs, and at every revolution of the machine, they give the meal two turns towards the centre of the circle, near to which are generally the bolting hoppers. At each extremity of the arms there is a little board attached to the hindmost edge of the arm to move side foremost; these are called sweepers; their use is to receive the meal as it falls from the elevator, and trail it round the circle described by the arms, that the flights may gather it towards the centre from every part of the circle; without these, this machine would not spread the meal over the whole area of the circle described by the arms. Other sweepers are attached to that part of the arms which pass over the bolting hoppers, to sweep the meal into them.

But if the bolting hoppers be near a wall and not in the centre of the cooling floor, then in this case the extremity of the arms are made to pass over them, and the meal from the elevator let fall near the centre of the machine, and the flights are reversed to turn the meal from the centre towards the circumference, and the sweepers will sweep it into the hoppers. Thus this machine receives the meal as it falls from the elevator on the cooling floor, spreads it over the floor, turns it twice over at every revolution, stirs and keeps it in continual motion, and gathers it at the same operation into the bolting hoppers, and attends them regularly. If

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are moved by the same power that moves the mill,
or other principal * machinery ; and in their opera- [* 330]

the bolting reels are stopped, this machine spreads the meal and rises over it, receiving under it from one, two, to three hundred bushels of meal, until the bolts are set in motion again, when it gathers the meal into the hoppers, as the heap diminishes, it follows it down until all is bolted. I claim as my invention, the peculiar properties or principles which this machine possesses, viz., the spreading, turning, and gathering the meal at one operation, and the rising and lowering of its arms by its motion, to accommodate itself to any quantity of meal it has to operate on.

No. 4. THE DRILL.—Its use is to move any grain, granulated or pulverized substance, from one place to another ; it consists, like the elevator, of an endless strap, rope, or chain, &c., with little rakes instead of buckets, (the whole cased with boards to prevent waste,) revolving round two pulleys or rollers. Its use in the process of the manufacture of flour, is to draw or rake the grain or meal from one part of the mill to another. It receives it at one pulley, and delivers it at the other, in a horizontal, ascending, or descending direction, and in some cases may be more conveniently applied for that purpose than the conveyor. I claim the exclusive right to the principles, and to all the machines above specified, and for all the uses and purposes specified, as not having been heretofore known or used before I discovered them. They may all be united and combined in one flour-mill, to produce my improvement on the art of manufacturing flour complete, or they may each be used separately for any of the purposes specified and allotted to them, or to produce my improvement in part, according to the circumstances of the case.

No. 5. THE KILN-DRIER.—To kiln-dry the meal after it is ground, and during the operation of the process of manufacturing flour, I take a close stove of any common form, and inclose it with a wall made of the best non-conductor of heat, leaving a small space between the stove and the wall, to admit air to be heated in its passage through this space. I set this stove below the conveyor that conveys the meal from the millstones as ground, into the elevator, and I connect the space between the stove and the wall, to the conveyor tube by a pipe entering near the elevator, and I cover the conveyor close, and set a tube to rise from the end of the conveyor tube near the millstones, for the heated air to ascend and escape as up a chimney. I make fire in the stove, and admit air at the bottom of the space between it and the wall round it, to be heated and pass along the conveyor tube, meeting the meal which will be heated by the hot air,

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tion, subdivide any granulated or pulverized substances, elevate and carry the same from place to place, in small and

and the superfluous moisture will be more powerfully repelled and thrown off, and the meal will be dried and cooled as it passes through the operation of the elevator and hopper-boy. The flour will be fairer than if the grain had been kiln-dried, and it will keep longer sweet than flour not kiln-dried. I set all my machines in motion by the common means of cog and round tooth, and pinion straps, ropes, or chains, well known to every millwright.

Arrangement and connection of the several machines, so as to apply my principles to produce my improvements complete.

I fix a spout through the wall of the mill for the grain to be emptied into from the wagoner's bag, to run into a box hung at the end of a scale-beam, to weigh a wagon load at a draught. From this box it descends into the grain elevator, which raises it to a granary over the cleaning machines, and as it passes through them, it may be directed into the same elevator to ascend to be cleaned a second time, and then descends into a granary, over the hopper of the millstones to supply them regularly, and as ground it falls from the several pair of millstones into the conveyors, where it is dried by the heated air of the kiln-drier, and is conveyed into the meal elevator, to be raised and dropped on the cooling floor, within reach of the hopper-boy, which receives and spreads it over the whole area of the circle which it describes, stirring and turning it continually, and gathering it into the bolting hoppers which it attends regularly. That part of the flour which is not sufficiently bolted by the first operation, is conveyed by a conveyor or drill into the elevator, to ascend with the meal to be bolted over again, and that part of the meal which has not been sufficiently ground at the first operation, is conveyed by a conveyor or drill, and let run into the eye of the millstone to be ground over.

Thus the whole of the operations which used to be performed by manual labor, is, from the time the wheat is emptied from the wagoner's bag, or from the ship's measure, until it enters the bolts, and the manufacture be completed in the most perfect manner, performed by the machinery moved by the power which moves the mill, and this machinery keeps the meal in constant motion during the whole process, drying and cooling it more completely, avoiding all danger from fermentation, and preventing insects from depositing their eggs, and performing all the operations of grinding and bolting to much greater perfection, making the greatest possible quantity of the best quality of flour out of the grain, saving much time

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separate parcels ; spread, stir, turn, and gather them, by regular and constant motion, so as to subject them * to artificial heat, and the air to dry and cool when [* 331] necessary. It then recites the material parts of the act of Congress, passed on the 2d of January, 1808, “ for the relief of Oliver Evans,” and concludes by granting “ to the said Evans for * fourteen years, the full and [* 332] exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Oliver Evans himself, in the annexed schedule, and is made a part of these presents.”

* The schedule describes the principles of the [* 333] machine in the manner, but more fully than they are stated in the patent, and also the principles, the form, and use of each particular machine ; and claims as his invention the peculiar properties or * principles [* 334] which each machine possesses ; and in particular as

and labor and expense to the miller, and preventing much from being wasted, by the motion of the machines being so slow as to cause none of the flour to rise in form of dust, and be carried away by the air, and the cases of the machines being made close, prevents any from being lost.”

OLIVER EVANS.

Witnesses, { Samuel H. Smith,
 { Jo. Gales, Jun.

Washington County, District of Columbia, viz.

This 4th day of November, 1807, personally appeared before me, a Justice of the Peace in and for the said county, Oliver Evans, who, being duly affirmed according to law, declares that he is a citizen of the United States, and that his usual place of residence is in the city of Philadelphia, and that he verily believes that he is the true and original inventor of the improvements herein above specified, for which he solicits a patent.

OLIVER EVANS.

Affirmed before me,

SAM. H. SMITH.

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to the hopper-boy, the spreading, turning, and gathering the meal, at one operation, and the rising and lowering of its arms by its motion, to accommodate itself to the quantity of meal it has to operate upon.

[* 335] * The plaintiff gave evidence to prove his discovery to have been as early as the year 1783, and to have been brought into use in the year 1785. He also proved it to be a highly useful invention, in the [* 336] saving of manual labor, increasing the * quantity and improving the quality of the flour. He also proved that the defendant had in use in his mill a hopper-boy, constructed precisely like the plaintiff's. That he had offered to take out a license from the plaintiff, but refused to pay the sum demanded.

The plaintiff having closed his evidence, a motion [* 337] was made * to nonsuit the plaintiff. It was contended, that after the expiration of the plaintiff's privilege granted to him by this State, the right to his invention became vested in the people of the State, by an implied contract with the government; and that therefore Congress could not, consistently with the Constitution of the United States, grant to the plaintiff an exclusive right to the invention.

By THE COURT. Neither the premises upon which this motion is founded, nor the conclusion can be admitted. It is not true that the grant of an exclusive privilege to an invention for a limited time, implies a binding and irrevocable contract with the people, that at the expiration of the period the invention shall become their property. The State has a perfect right to renew the grant at the end of the period or to refuse to do so; and in the latter case, it is a matter of course that the invention may be used by any person who chooses to do so. In like manner may Congress renew a patent-right or decline to do so.

But even if the premises were true, still there is nothing in

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the Constitution of the United States which forbids Congress to pass laws violating the obligation of contracts, although such a power is denied to the States individually.

The defendant produced a number of witnesses who described a machine called Stouffer's machine or hopper-boy, which had been in use in many mills from the year 1764. The construction of this machine is an upright shaft, sometimes round but most commonly square, passing through a board somewhat in the form of an S, with strips of wood nailed on the lower side for the purpose of moving, stirring, mixing, and delivering the flour into the hopper-chest; this machine is moved by the bolting gears. The witnesses stated that the action of this machine cools and dries the flour sufficiently to be packed from the bolting chest. Some of the witnesses were of opinion that this machine does not cool the flour as well as the plaintiff's, even independent of the elevators; many witnesses, however, expressed a different opinion.

* The plaintiff objected to the defendant giving [*338] any evidence to prove that this machine was used in mills, other than those particularly named in the notice.

This objection was overruled, for the reasons stated in the case of *Evans v. Kremer*. (To this opinion an exception was taken.)

A question also arose, whether, when a witness is sworn on his *voir dire*, any evidence can be given to prove him to be incompetent, except such as arises from his own acknowledgments. The Court decided that it could not. But if it should, in any subsequent stage of the examination, appear, by other evidence, that he is not a competent witness, the Court will set him aside.

The plaintiff's counsel asked one of their own witnesses, called to rebut the evidence given by the defendant, whether John, Peter, and Jacob Stouffer, who it had been proved had

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the Stouffer hopper-boy in their mills, had taken out licenses under the plaintiff. This was objected to, and the objection was decided by the Court to be well taken ; it not being stated that the question was intended to contradict or discredit any of the defendant's witnesses ; nor that it was rendered necessary by any evidence given by the defendant. If the license was purchased by those persons, it neither directly, nor by fair inference, proves any thing in relation to the matter in controversy. (This opinion was excepted to.)

The plaintiff offered to prove that the father of Mr. Rine, one of the defendant's witnesses, had taken a license from the plaintiff, for the purpose, as the counsel stated, to discredit the witness.

By the Court. Although the counsel proposes to offer this evidence to discredit one of the defendant's witnesses, yet as it is obvious that it cannot, in the most remote degree, have this effect, it is improper to give it. (Motion overruled.)

It was contended by the plaintiff's counsel, first, That an art as well as a machine may constitute a patentable [* 339] interest ; *so likewise the application of a new principle to an old machine, to produce a new result, or a combination of old machines to produce a new result in an old art ; even a principle may be patented, if it be applied to any useful purpose.¹

Second. The plaintiff having a patent for the whole improvement, composed of sundry machines, has a right to all and each of the machines, and may maintain an action against any person who makes or uses them separately. The Act for the relief of Oliver Evans, authorizes a patent to be made to him for the whole and for each machine, and the plaintiff, in his schedule, which is part of the patent, claims an exclusive right to each.

¹ 8 Durn. & East, 95 ; 2 H. Blac., 463 ; Fessenden's Law of Patents, 231 ; 1 Gallison, 481 ; *ante*, 42.

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Third. It is not necessary that the plaintiff should be the first discoverer, if he was a real *bond fide* discoverer, without knowing that a similar discovery had previously been made ; this is clearly the meaning of the word " true " in the tenth section, with which the word " original " in the sixth section is synonymous. The word *first* is used in the statute of James, and was no doubt dropped intentionally by Congress.

Fourth. Though the plaintiff should not be the original discoverer, yet, after the defendant's offer to take a license under him, it does not lie in his mouth to make that defence.

Fifth. As the tenth section limits the bringing of a *scire facias* to three years, under the equity of that section, no person should be permitted, after three years, to set up the defence mentioned in the sixth section.

Sixth. Admit Stouffer's machine to be similar in principle to the plaintiff's, still, as he never obtained a patent for it, it was thereby abandoned and might be patented by the plaintiff.¹

Upon the evidence it was contended that the two machines differ in form, in principle, and in effect.

* On the other side it was argued, that this patent [* 340] is broader than the discovery, it not being possible for the plaintiff to contend that he has any merit beyond that of an improvement. If the discovery amount to any thing, it is to that, and consequently the patent could only be for an improvement, whereas this is for the whole machine, under the name of an improved hopper-boy. But though called an improved hopper-boy, it is not so described in the specification, nor is it stated in what the improvement consists, which is necessary to the validity of the patent. 1 Gallison, 480.

Upon the evidence it was contended that Stouffer's hopper-boy is older, and was in use a great many years before the

¹ 1 Gallison, 482 ; *ante*, 43.

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plaintiff's discovery ; that it is the same in form, in principle, and effect ; performs all its functions as well, and in the same manner.

WASHINGTON, J., charged the jury. The plaintiff derives his title to the patent in question, under the private act of Congress, passed for the relief of Oliver Evans, on the 2d of January, 1808. His action, however, is founded on his patent, and I should not notice the above act, if the plaintiff's counsel had not relied upon it, to prove that the plaintiff is entitled to an exclusive property, not only in the *entire improvement*, but in the *several machines*, which are employed to produce the specified results.

It would certainly seem that Congress intended this, and why the patent is not as broad as the law, I cannot conjecture, unless it was apprehended that some difficulty might occur in the construction of the patent, in relation to these machines, had it pursued the words of the law. But be this as it may, it is certain that the patent contains no grant of a right to the several machines, but is confined to *the improvement in the art of manufacturing flour* by means of those machines, and therefore the plaintiff can claim no right which is not included in the patent. It has been stated that the schedule [* 341] is part of the * patent, and that this contains a claim of the invention of the peculiar properties and principles of the hopper-boy. Without noticing the extraordinary nature of such a claim, it is granted that the schedule is to be considered as a part of the patent, so far as it is *descriptive* of the machines, but no further ; and even if this claim had been stated in the body of the patent, it would have conferred no right which that instrument does not grant.

I now proceed to state such parts of the law concerning patent-rights¹ as may be necessary for deciding the ques-

¹ Laws of the United States, vol. ii. 348.

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tions which have been made in this cause. It authorizes the President to grant a patent for the exclusive right to make, construct, use, and vend to be used, any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, &c., not known or used before the application. As to what constitutes an improvement, it is declared that it must be in the principle of the machine, and that a mere change in the form or proportions of any machine, shall not be deemed a discovery. Previous to obtaining the patent, the applicant is required to swear or affirm that he verily believes that he is the true inventor or discoverer of the art, machine, or improvement, for which he solicits a patent; and he must also deliver a written description of his invention and of the manner of using it, so clear and exact as to distinguish the same from all other things before known, and to enable others, skilled in the art, to construct and use the same.

From this short analysis of the law, the following rules may be deduced :

First. That a patent may be for a new and useful *art* ; but it must be practical ; it must be applicable and referable to something which may prove it to be useful. A mere abstract principle is unsusceptible of appropriation by patent. The intention of Congress is very obvious, from the language of this law. *The applicant for a patent [* 342] must show *how the principle is to be used and applied to some useful purpose*. The granting words of the patent are still more explicit ; they are, “ *to make, construct, use, and vend to be used.*”

Second. The discovery must be not only useful, but *new* ; it must not have been known or used before in any part of the world.

It is contended by the plaintiff's counsel, that the title of the patentee cannot be impeached, unless it is shown that he

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knew of a prior discovery of the same art, machine, &c., and that *true* and *original* are synonymous, in the intention of the legislature.

As it is not pretended that true and original mean the same thing in common parlance, I proceed to inquire whether the legislature intended to use them as such. As to this, there can scarcely be two opposed opinions. The first section, referring to the allegations of the applicant for a patent, speaks of the discovery as something *not known or used before the application*. And in the sixth section it is declared that the defendant may give in evidence that the thing secured by patent was not *originally* discovered by the patentee, but had been in use or had been described in some public work, *anterior to the supposed discovery*. Now, if *original* does not mean *first*, the preceding expressions in the first and sixth sections, most certainly do.

Third. If the discovery be of an *improvement* only, it must be an improvement in the principle of a machine, art, or manufacture, before known or in use. If only in the form or proportions, it has not the merit of a discovery which can entitle the party to a patent.

Fourth. The grant can only be for the discovery, as recited and described in the patent and specification. If the grantee is not the original discoverer of the art or machine for which the grant is made, the whole is void. If, therefore, the patent be for the whole of a machine, and the discovery was only of an improvement, the patent is void.

[*343] *Fifth. A machine or an improvement may be new, and the proper subject of a patent, although the parts of it were before known and in use. The combination, therefore, of old machines to produce a new and useful result, is a discovery for which a patent may be granted.

The above principles will apply to most of the questions which have been discussed in this cause.

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It was strongly insisted upon by the defendant's counsel, that the patent in this case is broader than the discovery, the evidence having clearly proved that in relation to the hopper-boy, for the using of which this suit is brought, the plaintiff can pretend to no discovery beyond that of an improvement in a machine known and in use many years before the alleged discovery of the plaintiff.

This argument proceeds upon the supposition that the plaintiff has obtained a patent for the *hopper-boy*, which is entirely a mistake. It is for an improvement in the art of manufacturing flour by means of a hopper-boy, and four other machines described in the specification, and not for other of the machines so combined and used. That the plaintiff is the original discoverer of this improvement is contested by no person; and, therefore, it cannot with truth be alleged that the patent is broader than the discovery, or that the plaintiff could not support an action on this patent against any person who should use the whole discovery.

But, can he recover against a person who has made or used one of the machines, which in part constitutes the discovery? The plaintiff insists that he may, because, having a right to the whole, he is consequently entitled to the parts of which that whole is composed.

This may be good logic, but I must be permitted to question the soundness of the conclusion in point of law. For, will it be seriously contended that a person may acquire a right to the exclusive use of a machine, because, when used in combination with others, a new and useful result is produced, which he could *not have acquired [* 344] independent of that combination? If he can, then if A were proved to be the original inventor of the hopper-boy, B of the elevator, and so on as to the other machines, and had either obtained patents for their respective discoveries, or chose to abandon them to the public, the plaintiff,

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although it is obvious he could not have obtained separate patents for those machines, might nevertheless deprive the original inventors in the first instance, and the public in the other, of their acknowledged right to use those discoveries, by obtaining a patent for an improvement which consists in a combination of those machines to produce a *new* result. An argument which leads to a consequence so glaringly unjust, if not absurd, cannot possibly be a sound one. It would not be more unreasonable to contend that if the plaintiff were the patentee of the hopper-boy, which consists of a shaft, an arm, &c., he might bring an action against any person who, in the manufacturing of flour, should make use of a shaft or any other of the component parts of his hopper-boy.

I presume, therefore, that the plaintiff's counsel could not mean to contend for this right, except in a case where the patentee was the original discoverer of the particular machine or part, for which his suit is brought; and if so, we are still brought to the question whether, in point of fact, the plaintiff was the original discoverer of this machine, called the hopper-boy.

But before I proceed to consider that question, I would ask whether it is quite clear that this action can be maintained, although it were proved beyond all controversy that the plaintiff was the original inventor of this machine? And this inquiry is made, not with a view to decide the question, because it was not discussed at all at the bar, but for the purpose of preventing a conclusion being drawn from the silence of the Court, that we considered the action would lie. I will merely suggest some of the difficulties with which, upon a superficial view of the question, we are forcibly struck.

[* 345] * The patent is the foundation of the action, and the gist of the action is the violation of a right which the patent has granted. But is the exclusive right to the hopper-boy granted by this patent? It certainly is not, although this ma-

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chine constitutes a part of the improvement of which the plaintiff was the original discoverer, and it is for that improvement, and that only, for which the grant is made. If the grant, then, is not of this particular machine, can it be sufficient for the plaintiff to prove that he was the original discoverer of it, to entitle him to a recovery?

Again, could the plaintiff have obtained a separate patent for the hopper-boy, in case he was the original inventor of it, without first swearing or affirming that he was the true inventor of that machine? But has he, or could he have taken such an oath in this case? Most assuredly not; because the prescribed form of the oath is, that he is the inventor of the art, machine, or manufacture *for which he solicits a patent*. Now, as the patent which he solicited was not for the *hopper-boy*, but for *an improvement in the manufacture of flour*, he might with safety take that oath, although he knew at the time that he was not the true inventor of the hopper-boy; and thus it would happen, that he would indirectly obtain the full benefit of a patent-right to this machine, which he could not have directly obtained, without doing what it must be admitted in this case he has not done. But this is not all. If the law has provided for fair and original discoverers a remedy where their rights are invaded by others, it has provided likewise correspondent protection to others, where they have not this merit. Now, let me ask, what judgment the District Court could render, if, upon a *scire facias* to repeal this patent, it had appeared, incontestably, that the plaintiff was not the true original discoverer of the hopper-boy? Certainly not that which the law has prescribed, viz. for the repeal of the patent, because it would be monstrous to vacate the whole patent for an invention of which the patentee was the acknowledged inventor, because he was not the inventor of one of the constituent parts of the discovery for which no grant * was made. But the Court would [* 346] be compelled either to do this, or to dismiss the *scire*

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facias; and if the latter, then the plaintiff would in effect have the exclusive right to a machine which could not be impeached in the way prescribed by law, although he should himself acknowledge that he was not the true and original inventor of it, and that he knew he was not so at the time he applied for his patent.

Still further: suppose this jury should find that the plaintiff was not the original inventor of this machine, would not the Court be prevented from declaring the patent void, under the provisions of the sixth section of the law, for the reasons assigned why the District Court could not render that judgment upon a *scire facias*?

Nay, it may well be doubted whether the defence now set up by the defendant can be made at all in this action, inasmuch as the defendant cannot allege, in the words of the sixth section, that "*the thing secured by patent* was not originally discovered by the patentee," because, in point of fact, the thing patented was originally discovered by the patentee, although the hopper-boy may not have been. But if this defence cannot be made, does not that circumstance afford a strong argument against this action?

But, it has been asked by the plaintiff's counsel, can it be right that the plaintiff should be deprived of the benefit of his discovery by the mere omission of the defendant to use one or more of the machines which compose the entirety of his discovery? To this question the answer is obvious. If the plaintiff is not the inventor of the parts, he has no right to complain that they are used, if not in a way to infringe his right to their combined use. If he is the original inventor of the different machines constituting the whole discovery, or any of them, he might have obtained a separate patent for those of which he was the original inventor; in which case, the objections stated, would not have been in his way.

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Upon the whole, although we give no positive opinion on this * point, we think it at least admits [* 347] of a serious doubt whether this action can be maintained.

But if an action will lie upon this patent, against the defendant for having used the hopper-boy, still the plaintiff cannot recover, if it has been shown to the satisfaction of the jury that he was not the original discoverer of that machine.

It appears, by the testimony of the defendant's witnesses, that Stouffer's hopper-boy was in use many years before the alleged discovery of the plaintiff's. That the two machines differ from each other very little in form, in principle, or in effect. They are both worked by the same power which works the mill, and they both stir, mix, cool, dry, and conduct the flour to the bolting chest. Whether the flights and sweepers in the plaintiff's hopper-boy are preferable to the cleats used in Stouffer's; or whether, upon the whole, the former is a more perfect agent in the manufactory of flour than the latter, are questions which the Court will not undertake to decide. Because, unless the plaintiff is the original inventor of the hopper-boy, he cannot, although he had obtained a separate patent for it, recover in this action, however useful the improvements may be which he has made in this machine. If the plaintiff had obtained a patent for his hopper-boy, it would have been void, provided the jury should be of opinion, upon the evidence, that his discovery does not extend to the whole machine, but merely to an improvement in the principle of an old one. And if this should be their opinion in the present case, the plaintiff cannot recover.

There remain to be decided, some points of law which were discussed at the bar.

First. It was contended by the plaintiff's counsel, that the

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defendant having offered to take a license from the plaintiff, if he would have consented to reduce the price of it to forty dollars, he is not now at liberty to deny that the plaintiff is the original inventor of this machine. This argument has no

weight in it; not merely because the offer was re-
[* 348] jected, and is therefore * as if it had not been made,

but because the law prevents the plaintiff from recovering, if it appear that he was not the original inventor. If the offer amounted to an acknowledgment that the plaintiff was the original inventor, (and further it could not go,) this may be used as evidence of that fact; but it would not entitle the plaintiff to a verdict, if the fact is proved to be otherwise.

Second. The counsel for the plaintiff have strongly insisted that upon the equity of the tenth section of the law, the defence set up in this case ought not to be allowed after three years from the date of the plaintiff's patent. This argument might, with some propriety, perhaps, be addressed to the legislature, but is improperly urged in this place. The law has declared that, in actions of this kind, the defendant may plead the general issue, and give in evidence that the plaintiff was not the original inventor of the machine for which the patent was granted. The legislature has not thought proper to limit this defence in any manner; and shall this Court do it? But, what seems to be conclusive upon this point, is, that the argument would tend to defeat altogether the provisions of the sixth section, which authorize this defence to be made. For if it could not be set up after three years from the date of the patent, it would be in the power of a patentee to avoid it altogether, by forbearing to bring suits, until after the expiration of that period. And thus, although the law has carefully provided two modes for vacating a patent improvidently granted, the patentee, though not the original inventor, and however surreptitiously he may have obtained his patent, may

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secure his title to the exclusive use of the invention of another, if he can for three years avoid an inquiry into the validity of that title.

Third. The last point is, that Stouffer's invention was abandoned, and consequently might be appropriated by the plaintiff. The premises may be admitted but not the conclusion. If Stouffer was the original inventor of the hopper-boy, and chose *not to obtain a patent for it, [*349] it became public property by his abandonment. He could maintain no action against any person for using it, nor could any other person obtain a patent for it, because he would not be the original inventor.

Verdict for defendant.

A writ of error was taken out to the Supreme Court, and the decision of that court in this case, will be found in 3 Wheaton, p. 454.

ABNER STEARNS, IN ERROR, v. WILLIAM BARRETT.

[1 Mason, 153.]

The proceedings under the 10th section of the Patent Act of 21st of February, 1793, ch. 11, are in the nature of a *scire facias* at the common law, to repeal a patent.

Upon a judgment entered upon such a suit, error lies to the Circuit Court.

A verdict, which is repugnant or uncertain in a material point, is void.

The refusal of a Court to amend a verdict is not matter which can be assigned for error.

Upon a trial under the general issue, under the 10th section of the Patent Act, the burden of proof, that the patent was obtained surreptitiously, or upon false suggestion, lies on the plaintiff.

If a patent has been obtained by the plaintiff, upon the defendant's refusal to submit to an arbitration, according to the provisions of the 9th section of the Patent Act, and the defendant subsequently obtain a patent for the same invention, this is not *conclusive* proof that the latter was obtained surreptitiously, or upon false suggestion.

THIS was a proceeding in the District Court, under the

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10th section of the Act of the 21st of February, 1793, ch. 11, to repeal a patent-right granted to the defendant, upon the allegation, that it was obtained surreptitiously and upon false suggestion. Upon a motion, supported by affidavit, a rule to show cause, why process should not issue to repeal the letters-patent, was granted, upon the return of which, the District Court, after hearing the parties, made the rule absolute ; and process was ordered by the Court to issue against the defendant, to show cause *why the letters-patent should not be repealed* ; and it was further ordered, that the applicant should file his allegations with due specifications. A further allegation, with specifications, was accordingly filed, by way of amendment of the original complaint, and thereupon the said process duly issued. The original affidavit alleged, that the letters-patent were obtained surreptitiously and upon false suggestion ; and that the plaintiff was the true and original inventor of the machines in controversy.

The amended complaint alleged, that the machines described in the letters-patent to the defendant, “ were [* 154] not invented by him, * but by another.” And after specifying, under a videlicet, the particulars of the invention, and alleging, that they were not invented by the defendant, concluded by alleging, “ that the same machines, in all respects, in which they are new, are and were of the invention of another ; and were known, and secured by patent, previously, to the complainant, as in and by his specification or affidavit originally filed, to which this is an amendment and addition, is alleged.” Upon the return of the process, the defendant duly appeared and filed the following plea and answer. “ And now the said Barrett comes and defends, &c., when, &c., and for cause, why the said letters-patent should not be repealed, saith, that his letters-patent were not upon false suggestion or surreptitiously obtained, in manner and form as set forth in the writ of said Stearns ; but

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that the said new and useful improvement, for which his said letters-patent issued, as in said complaint is set forth, was invented by him, the said Barrett, in manner and form as he, in his former answer to the first complaint of said Stearns, hath alleged, and therefore he puts himself upon the country." And the plaintiff put himself, as to this issue, upon the country likewise.

The issue, so joined by the parties, was tried by a jury, who returned the following verdict: "The jury agree, that the plaintiff and defendant were both concerned in the invention of the reel, or machine for dying all kinds of woven and silk goods, and a frame for finishing the same. They find that the plaintiff has not supported his allegations, and therefore find a verdict for the defendant." Upon this verdict a judgment was rendered by the Court, by consent of the parties, for the defendant. At the trial, a bill of exceptions was taken by the plaintiff to the charge of the Court. The bill of exceptions stated, at large and *in hæc verba*, the testimony of all the witnesses on each side, and all the other evidence introduced by the parties. It then stated the points insisted upon by the counsel, and then * the [* 155] charge of the Court upon these points, as follows:

"Whereupon the said counsel for the complainant insisted then and there before the said Hon. Judge, on the behalf of the said Stearns, that the said several matters, so produced and given in evidence on the part of the said complainant as aforesaid, were sufficient, and ought to be admitted and allowed as decisive evidence that the said Barrett had surreptitiously obtained his said patent, and was not the inventor of all the essential parts of the said machines. The said counsel particularly insisted, that the refusal of the said Barrett, in the manner disclosed in the evidence aforesaid, to appoint an arbitrator on his part, in compliance with the requirement of the law of the United States, in such case provided, and

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his, the said Barrett's, obtaining his said patent afterwards, in the manner disclosed in the evidence aforesaid, was contrary to the statute in such case; and thereupon the said counsel for the complainant prayed of the said Hon. Judge to admit and allow the said matters so as aforesaid produced and given in evidence to be conclusive evidence that the said patent of the said Barrett was obtained surreptitiously. The counsel for the complainant farther insisted, that, as to the invention of the said machines, it was incumbent on the complainant to produce only general evidence to show that said Barrett was not the inventor, and that the burden of evidence thereupon devolved on the respondent; and it became incumbent on him to prove, that he, the said respondent, was the sole and exclusive inventor of all, and every essential part of the said machines respectively, as set out and described in his specification; and thereupon the said counsel prayed the Hon. Judge to admit and allow the evidence aforesaid to be conclusive that the patent of the said Barrett was obtained upon false suggestion, and to instruct and direct the jury,

that unless the said Barrett had proved, beyond a [* 156] reasonable doubt, that he was the sole * and exclusive inventor of all the essential parts of the machines aforesaid, described in his specification, and stated in his patent, that they, said jurors of the jury aforesaid, should return a verdict for the complainant.

But to this the counsel for the respondent, on his behalf, did then and there insist before the said Hon. Judge, that the matters and evidence aforesaid, so produced and proved as aforesaid, did not amount to, nor ought to be held to be, conclusive evidence against the said Barrett to prove that his patent aforesaid was obtained surreptitiously or upon false suggestion as aforesaid.

And the said Hon. Judge did then and there declare and deliver his opinion to the jury aforesaid, as follows, namely :

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As to the first point, the Judge directed the jury, that though it should appear to them from the evidence that there were conflicting claims for a patent by the respective parties, at the office of the Secretary of State, and that a reference was recommended or directed, and that said Stearns did offer to refer such conflicting claims of himself and said Barrett to arbitrators, to be appointed according to the provisions of the law in such case, and named an arbitrator or referee on his behalf, and gave notice thereof to said Barrett; and though said Barrett should have refused, on his part, to appoint an arbitrator or referee, and afterwards a patent was issued to Stearns, and, subsequent to the date of said Stearns' patent, one was issued to said Barrett, as appears in evidence from their respective dates; yet that these circumstances alone would not constitute an obtainment of the patent surreptitiously, or on false suggestion, on the part of said Barrett, within the true intent and meaning of the statute; and that other evidence besides that, which should establish those facts and circumstances, would be necessary to support the charge of obtaining the patent surreptitiously, or by false suggestion. And in regard to the second point, * the [* 157] said Hon. Judge directed the jury, that the burden of proof lay upon the complainant to support his allegation, in order to maintain the issue joined; and that as to the question, who was the true inventor of the machines, it was incumbent on the complainant to satisfy the jury, beyond a reasonable doubt, that said Barrett was not the true inventor of said machine or improvement, or of some essential part of it, to maintain that alleged ground for vacating the respondent's patent. That the objection that this was requiring the complainant to prove a negative, was not applicable to this direction; for the complainant might prove the proposition contended for, by proving that another person, besides Barrett, was the inventor; and as there appeared no

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allegation nor evidence in the cause, nor was it contended by either party, that any other, besides Stearns and Barrett, was the inventor of said machine, it would follow, that unless Stearns should have satisfied the jury that he was the inventor of the machine, or some material part of it, they must find a verdict for the respondent; and with this direction, the said Hon. Judge left the cause to the jury."

The following points were now made by *G. Sullivan*, for the plaintiff in error.

1st. That by the finding of the jury, the fact was expressly established, that the respondent was not the sole inventor of any essential part of either of the machines, for which he obtained a patent; and the conclusion of the verdict in favor of the respondent was therefore repugnant to this finding, and contrary to law.

2dly. That the Hon. Judge ought to have amended and worked said verdict into form, and thereupon entered judgment for the complainant, or have rejected it, and awarded a *venire de novo*.

3dly. That the Hon. Judge directed and decided, that it was incumbent on the complainant to prove a negative [* 158] proposition, viz.: That the respondent was not the inventor of the essential parts of said machines, whereas the respondent ought to have been held to prove that he was the inventor.

4thly. That the Hon. Judge directed and decided, that the obtainment, by the respondent, of his said patent, was not surreptitious, although obtained in the manner apparent on the record, viz., after a patent, for the same invention, had been issued to another, upon the refusal of the respondent to submit to arbitration, as required by the ninth section of the Patent Law.

5thly. That the answer of said respondent, under oath, was read to the jury in evidence.

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Under the first point it was contended, that whenever a patentee had obtained a patent upon a specification broader than his invention, the patent was void. As when a patent was obtained for the whole of a machine, and the patentee had invented only an improvement.¹

So where the specification imperfectly discloses the mode of producing the effect; or specifies an effect which the means specified will not produce, the patent is void.²

And if the patent obtained really covers the invention of another, it is void.³

Under the second point it was contended, that it was within the power of a court to amend a verdict. And that this might be done by the plea-roll, issue, notes of the Judge, minutes of counsel, or affidavit of facts, proved at the trial.⁴

* As where the jury find a fact, of which there [* 159] was no evidence.⁵

Where the jury use technical terms, in an improper manner.⁶

Where the jury undertake to collect the contents of a deed, and find the deed *in hæc verba*, the Court will not regard the jury's finding of the contents, but will look to the deed.⁷

Where the jury undertake to find the costs for either party,

¹ Woodcock v. Parker, 1 Gall. R. 438. Ante 37.

² Turner v. Winter, 1 T. R. 602; Rowntree's case, Fessenden's Law of Patents, 151.

³ Tenant's case, Fessenden's Law of Patents, 152.

⁴ Goodlittle v. Otway, 8 East, R. 357; Doe v. Perkins, 3 T. R. 749; Petrie v. Hannay, 3 T. R. 659; Prest., Direct., and Co. of the Highland Turnpike v. M'Kean, 11 Johns. R. 100, 101; Grant v. Astle, Doug. R. 723.

⁵ Manners v. Postan, 3 Bos. & Pul. R. 343.

⁶ Chester v. Wellan, 2 Saund. R. 97.

⁷ Row v. Huntington, Vaug. R. 77.

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of which the law disposes, the Court will not regard the finding.¹

Where the jury find the plaintiff was disseised *nisi* the words contained in a will conveyed a good estate; the Court held, that the verdict was perfect without the *nisi*, and so entered for the plaintiff.²

Where the jury find, that the defendant did not promise, &c., nevertheless if two witnesses are to be believed, and they think they are, they find the verdict for the plaintiff; it was held a good verdict for the defendant.³

Where the jury find the facts at large, and further conclude against law, the conclusion is ill, and the verdict will be amended according to the facts found.⁴

Where the jury bring in a verdict, and there is surplusage, the Court will reject the surplusage.⁵

Where the jury find any thing out of the issue, such a verdict, for so much, is void, although it conclude [* 160] in general *for or against the plaintiff or defendant. And the rule, by which the Court shall amend verdicts, is the true legal intent and meaning of the jury, if such may be collected from the verdict.⁶

It was then contended, that the verdict in the case before the Court, was, in substance, a sufficient and distinct answer to the issue, and defective only in form; and that the Judge should, therefore, have amended it, or, since the verdict was

¹ Green v. Cole, 2 Saund. R. 257.

² West v. Tonson, Cro. Eliz. 480.

³ Sir Rowland Haywood's case, 3 Dy. 371.

⁴ Dy. 106, 20; Pl. Com. 114; 11 Rep. 10; Priddle's case.

⁵ 11 Mod. 64.

⁶ Foster v. Jackson, Hob. R. 54; Hawkes v. Crofton, 2 Burr. R. 699; Doe v. Perkins, 3 T. R. 749; Rees v. Morgan, Id. 349; Walker v. Gibbs, 2 Dall. R. 211, 212.

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no part of the record, have entered up judgment for the plaintiff without amending it.

Under the third point, it was contended that a *scire facias* was a summary remedy, in the nature of a *quo warranto*; and was sustained at common law, where the subjects were injured by a patent, in order to avoid a multiplicity of suits. That in a *quo warranto*, the respondent must set out his whole title at length, and that the affirmation necessarily devolved upon the respondent, by the whole course of the pleading; that this process was in the nature of a *quo warranto*, and the whole course of proceedings was the same.

Under the fourth point, it was contended, that by the ninth section of the patent law, the legislature had prescribed a mode for the adjustment of interfering applications by a reference; and that if an applicant, refusing to submit to such reference, was permitted still to obtain a patent, all the advantages to be derived from a patent, which was that of an exclusive privilege, would be lost to the other patentee.

Under the fifth point, it was contended, that to permit the answer of the respondent on oath to be read to the jury in evidence, was contrary to the course of proceedings in a *quo warranto*, and was not, therefore, allowable in this case.

* *Bigelow* and *Gorham*, for the defendants, con- [* 161] tended that a writ of error would not lie in this case, because the process was not according to the course of the common law.¹

That if it were according to the course of the common law, it would be necessary for the complainant to allege himself to be the first patentee, and to set out his right at length, which the complainant, in this case, had not done.

¹ *Hunt v. Coffin*, Dyer R. 197; *Melvin v. Bridge*, 3 Mass. R. 305; *Pratt v. Hall*, 4 Mass. R. 241; *Edgar v. Dodge*, 4 Mass. R. 671.

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That the burden of proof was on the complainant, and he must show, that the patent of the defendant was obtained surreptitiously, and upon false suggestion ; the patent obtained by the defendant being, in itself, *primâ facie* evidence of his right.

That the writ of *scire facias* was a judicial writ founded upon a record ; but that, in this case, there was no record to found the process upon, the District Court not being the repository of the records of patents ; and no process of this kind could have issued from that Court, had not a special power been given to it by the patent law.

That the proper mode of procedure would have been by a *certiorari*, which being a writ of favor, the truth of the facts and the merits of the case would have been examined under it.

It was further contended, that the finding of the jury in this case was not that this was a joint invention of the plaintiff and defendant, but only that both of them were concerned in it ; similar to the case of the invention of a machine by two men, without either's knowing of the invention of the other ; in which case it would not by any means be said, that the patent of the last inventor was obtained surreptitiously. If, therefore, the finding of the jury [* 162] could by *any means be made consistent, the Court would make it so.

STORY, J. The first question is, whether this Court has appellate jurisdiction from a judgment, rendered by the District Court in proceedings under the tenth section of the Patent Act.

Before considering this question, it will be necessary to settle the true nature and character of the proceeding itself. It is not easy to give a construction to the tenth section of the Act, that is entirely free from difficulties. It provides, in

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substance, that upon oath or affirmation being made before the Judge of the District Court, that any patent was obtained surreptitiously, or upon false suggestion, and motion made to the said Court within three years after issuing the patent, it shall be lawful for the said Judge, if the matter alleged shall appear to him sufficient, to grant *a rule* that the patentee, or the executor, &c., *show cause* why process should not issue against him to repeal such patent; and if sufficient cause should not be shown to the contrary, the rule shall be made absolute; and thereupon the said Judge shall order process to be issued against such patentee, or his executors, &c., with costs of suit. And in case no sufficient cause shall be shown to the contrary; or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such Court for the repeal of such patent. And if the party, at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed against him by the Court, and recovered in the due course of law.

'The proceeding is evidently of a peculiar nature. It begins by a rule to show cause, which is commonly called a rule *nisi*, and if no sufficient cause be shown to the
* contrary, the rule is to be made absolute. For [* 163] what purpose is it to be made absolute? Clearly, as the Act declares, that process may issue against the patentee to repeal the patent; and the section proceeds to direct, that such process shall be issued against the patentee, with costs of suit. If the section had stopped here, there could have been little room for doubt; and it would, probably, have been judicially held, that the hearing upon the rule was decisive, and final between the parties; and that if the rule was made absolute, the patent would be in effect repealed; and the issuing of process would be in the nature of an execution

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to enforce, or make known, the judgment of the Court. The proceedings would, in this view, bear a strong analogy to the summary proceedings under the statute of 17 Geo. 3, ch. 25, to set aside an annuity, and cancel the bond, or other assurance granting the same.¹ In aid of this construction of the tenth section of the Patent Act, it is material to observe, that, by its terms, the process is to be issued to repeal the patent, and not to show cause why it should not be repealed; and the process is also to enforce a payment of the "costs of suit," which seems to suppose that the suit is then concluded.

But it has been supposed that the subsequent clauses of the tenth section contemplate the process to be issued as merely interlocutory process, to bring the party into Court to show cause why the patent should not be repealed; and that, upon the pleadings upon such process, the merits of the application are to be discussed and decided. And the clause, that "in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such Court for the repeal of such patent," is supposed particularly to apply to those ulterior proceedings. In fact, [* 164] * the process is thus deemed, to all intents and purposes, a *scire facias* at the common law to repeal a patent.

There is certainly great force in the argument in support of this view of the process, although some differences must be admitted to exist between it and a *scire facias* at the common law to repeal a patent. In the first place, a *scire facias* is a judicial process, issuing upon some record already enrolled in the Court. It either issues out of Chancery, where the patent itself is recorded, or from some other Court,

¹ 1 Tidd's Pr. 436, (4th edit.)

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where a forfeiture or other cause of repeal appears by office, or other matter upon record in the same Court.¹ And the patent itself, or an inquisition, which finds a patent and a cause of forfeiture, is a sufficient record to authorize the issuing of the *scire facias*.² In this respect, the process from the District Court is different. That Court is not the depository of the records of patents; but they are recorded in the office of the Secretary of State; and, if the present argument be right, the process is not founded upon any judgment of the Court, ascertaining a forfeiture or ground of repeal. In the next place, a *scire facias* is a process altogether confined to the Crown, with the exception of the single case, where two patents have issued for the same thing; in which case the prior patentee may maintain a *scire facias* to repeal the second patent.³ But, under our Patent Act, any person, whether a patentee or not, may apply for the repeal. There are other differences, which it is not now necessary to enumerate.

* After considerable hesitation, I have come to [* 165] the conclusion that the proceedings upon the rule *nisi* are not conclusive; and that the process, to be awarded upon making the rule absolute, is not a final process, but a judicial writ in the nature of a *scire facias* at the common law. In this view, the preliminary proceedings are analogous to those on a rule for an information in the nature of a *quo warranto* under the English statutes.⁴ Upon this construction, all the words of the statute have a natural connection

¹ The King *v.* Butler, 3 Lev. 220; S. C. 2 Vent. 344; 4 Inst. 72;
² Saund. R. 72, p. 9, in note; 1 Tidd's Pr. 966, (4th edit.)

² Lev. 220; Com. Dig., *Patent*, F, 7; Dy. 197, &c.

³ Dy. 198, 6; 2 Saund. 72, 8, note; Com. Dig., *Patent*, F, 2 F, 3.
 But see 6 Mod. 229.

⁴ See Rex *v.* Dawes, 4 Burr. R. 2022; Ibid. 2120; Rex *v.* Peacock, 4 T. R. 684.

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and distinct meaning, referring to the progressive order of the proceedings. The process is called in the statute a process to repeal the patent, merely as a description of its nature and use, and not because it necessarily and absolutely, *per se*, repeals the patent; in the same manner as a *scire facias* at common law, though, in fact, always a process to show cause, is generally denominated a *scire facias* to repeal a patent.¹ Nor does the addition of the words in the statute, "with the costs of suit," at all impugn this construction; for the process is then to show cause why the patent should not be repealed, with costs of suit. In confirmation of this construction, it may be remarked, that in the correspondent section of the Patent Act of 10th of April, 1790, ch. 7, the clause as to the costs of suit is omitted, which clearly shows that these words ought not to change the ordinary construction of the context. The subsequent language of the section, that "in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such Court for the repeal of such patent," manifestly contemplates some proceedings after the process is [* 166] issued, by * which certain facts may be judicially determined, which are to be the proper foundation of a judgment. It is also of very considerable weight, that this has been, as far as we can obtain information, the practical exposition of the statute. It is consonant to the rules of the common law, which have generally been consulted and followed in all our laws and proceedings, to which they bear any relation; and it preserves the trial by jury, which the judicial act² declares shall be the mode of trial of all issues of fact in the District Court, in all causes except civil causes of admiralty and maritime jurisdiction. Whether a more convenient, as well as a more effectual remedy, might not

¹ Dyer, R. 179 b, 198 a; Lilly's Entr. 411; 2 Saund. R. 72 p, note.

² Act 24th Sept. 1789, ch. 20, § 9.

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have been obtained by a bill in equity, to set aside a patent for fraud or imposition, it is not the province of a judicial tribunal to consider or decide.¹

It being then ascertained that this is a proceeding in the nature of a *scire facias* at the common law, the next inquiry is, whether this Court has appellate jurisdiction from the judgment rendered therein by the District Court.

If this point were to be decided by a mere reference to the common law, no difficulty could arise ; for, upon a judgment on a *scire facias*, it is very clear that error lies.² But the appellate jurisdiction of the Circuit Court depends altogether upon the positive provisions of our own statutes. It is not a Court originating in the common law, whose jurisdiction is to be ascertained by immemorial usage. The Judicial Act of 1789, ch. 20, § 22, gives appellate jurisdiction to this Court from all final decrees of the District Court in causes of admiralty and maritime jurisdiction, where the matter in dispute exceeds 300 dollars ; and from all final decrees and judgments “in civil actions,” where the matter in dispute exceeds 50 dollars. The Act * of 3d [* 167] March, 1803, ch. 93, § 2, allows an appeal to this Court from all final judgments or decrees of the District Court, where the matter in dispute exceeds 50 dollars. Whether this last statute applies to any but causes of admiralty and maritime jurisdiction, is questionable,³ and need not now be considered ; for this process comes completely within the description of a “civil action.” A *scire facias* is a judicial writ ; and yet it is held to be an action, because the defendant may appear and plead thereto.⁴ And for precisely the

¹ See *Attorney-General v. Vernon, &c.*, 1 Vern. R. 277, 870.

² 2 Tidd's Pr. 966, 1028 ; Com. Dig., *Pleader*, 3, B, 7.

³ *United States v. Wonson*, 1 Gall. R. 5, 11.

⁴ Co. Lit. 290, 6, 291 a ; *Pultney v. Tonson*, 2 W. Bl. 1227 ; *Guy v. Jones*, 2 Wils. 251 ; *Fenner v. Evans*, 1 T. R. 267 ; *Winter v. Kretchman*, 2 T. R. 45 ; 2 Tidd's Pr. 966, (4th edit.)

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same reason this process must be deemed an action ; and it is clearly a civil, as contradistinguished from a criminal action. A writ of error, therefore, well lies, if the matter in dispute exceeds the stipulated value. It is conceded, by the counsel on both sides, that the patent-right is of a far greater value ; and, as judicially appears upon the record, that each of the parties claims the invention as his own, each has a matter in controversy sufficient in value to sustain the jurisdiction. It is not necessary to decide, whether, if the plaintiff had been a mere stranger, claiming no title to the invention, he could have brought a writ of error from the judgment of the District Court. The difficulty in such a case would have been, how to estimate the value which the plaintiff could have in the controversy. On this point no opinion is intended to be given.

The appellate jurisdiction in this Court being established, we may now pass to the consideration of the other questions arising in the cause.

It is deeply to be regretted, that the proceedings were, from accidental causes, conducted in so inartificial and irregular a manner by the parties in the Court below.

[* 168] * The *scire facias* does not express, in the pointed and distinct terms of the statute, the causes for which the patent is sought to be repealed. It ought to have contained a direct allegation or suggestion, that the patent was obtained surreptitiously, or upon false suggestion, and have called upon the defendant for that cause, and for that cause only, to show cause why the patent should not be repealed. Whereas, the *scire facias*, after reciting (and, in my judgment, very unnecessarily) the whole proceedings prior to the making of the rule absolute, proceeds to state at large, in a new allegation, a specification of the particulars, in which the plaintiff denied the machine in controversy to be the invention of the defendant, and claimed it to be the invention of

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another (meaning, as the context shows, of the plaintiff himself); and then calls upon the defendant to show cause why the letters-patent for the cause aforesaid, should not be repealed. From the manner, therefore, in which this new allegation is inserted in the *scire facias*, it is uncertain whether the defendant is to answer to that only, (and it does not contain a syllable as to the patent's having been obtained surreptitiously, or upon false suggestion,) or whether the statements in the original affidavit are now included in the charge.

This specification was very properly ordered by the Court; but it was in the nature of a bill of particulars, to assist the defendant at the trial, and by no means a regular part of the *scire facias*. It is very probable, that this informality occasioned the embarrassment of the subsequent pleadings, in which it is not very easy to discern at once, what was the precise point which the parties meant to put in issue; whether that the patent was obtained surreptitiously, or upon false suggestion; or that the improvement, for which the patent issued, was the invention of the defendant. And this again, probably, misled the jury in shaping their verdict.

* In my judgment, the plea must be considered, [* 169] substantially, as putting in issue the only point, that, on the *scire facias*, could be material, namely, whether the patent was obtained surreptitiously, or upon false suggestion; and, of course, that the residue of the plea is mere surplusage. The material inquiry then is, whether the jury have, in direct terms, or by necessary legal intendment, returned a verdict upon this issue.

Many authorities have been cited to show the power of Courts of law to amend verdicts which are defective, so as to conform to the real intentions of the jury. It is unnecessary to examine the nature or limits of this doctrine; for no amendment was made in this verdict by the District Judge; and a refusal to amend a verdict is not the subject of a writ

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of error. It is a mere exercise of discretion by the Court below ; and it does not even appear upon this record, that any application was made to the Court for that purpose.

The verdict is, therefore, to be taken as it stands upon the record, with all its imperfections on its head. It is clear, that, in terms, it does not find the issue joined by the parties ; if, however, the Court can collect the point in issue out of the verdict, it will be sufficient.¹ The plaintiff contends, that the fact found by the jury, that the machine was the joint invention of the plaintiff and the defendant, is decisive in his favor ; and, by inference, includes the point in issue ; and that the subsequent finding for the defendant is repugnant to this fact, and therefore ought to be rejected. On the other hand, the defendant contends, that the general finding is for the defendant ; and the special fact found is not repugnant to it, and may, therefore, be rejected as surplusage.

[* 170] If there be a material repugnancy *in the verdict, it is not competent for the Court to reject either part of the finding ; for it is utterly impossible for the Court to decide which is the truth of the case. And if it were otherwise, there is no authority to substitute its own opinion for that of the jury. In such case, the repugnancy will be fatal. A verdict, which finds two inconsistent material facts, is void, and cannot be a foundation for a legal judgment.² On the other hand, a general verdict, (as this must be deemed to be,) which finds the point in issue by way of argument or inference, is void, even, as it is said, though the argument or inference be necessary.³ It follows, therefore, that in no event can the verdict be adjudged in favor of the plaintiff. It is either a verdict, which finds the

¹ Hob. 54 ; Com. Dig., *Pleader*, S, 18, S, 26 ; *Hawks v. Crofton*, 2 Burr. R. 698.

² Com. Dig., *Pleader*, S, 23.

³ *Rowe v. Huntington*, (Vaug. R. 66, 75 ; Com. Dig., *Pleader*, S, 22.

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substance of the issue for the defendant, or it is void for repugnancy, uncertainty, or insufficiency.

There are many authorities in the books respecting this subject, some of which are not easily reconcilable with sound sense, or with legal principles. From the mass of cases, however, some rules may be extracted, which commend themselves to the judgment of all of us. If, for instance, the jury find the point in issue, and also another matter out of the issue, the latter finding is void, and may be rejected as surplusage.¹ But it is otherwise, if the matter so found be contained in the issue; for then, if it be material and contradictory, it cannot be rejected as surplusage. So if the point, on which the verdict is given, be so uncertain that it cannot be clearly ascertained whether the jury meant to find the issue or not, it cannot be helped by intendment; and, *à fortiori*, if it be repugnant to other facts expressly found.²

* Let us now apply these principles to the present [* 171] verdict. From the terms in which the verdict is expressed, it seems to be an argumentative finding for the defendant. The jury find, that the plaintiff has not supported his allegations, and therefore find for the defendant. What were those allegations? That the patent was obtained surreptitiously, and upon false suggestion, as stated in the original affidavit? Or, that the machine in controversy was the sole invention of the plaintiff, as stated in his amended allegation? The terms of the verdict more correctly apply to the latter than to the former; and there is this additional reason for this construction, that the fact specially found is, in this view, consistent with the general finding. For, as the jury find that the plaintiff and defendant were both concerned in the invention, then the allegation of the plaintiff, that it was his sole invention, was not supported. In this view of the verdict, it is void,

¹ Com. Dig., *Pleader*, S, 18, S, 28.

² Id., *Pleader*, S, 2, S, 23.

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either because it is merely argumentative and uncertain, or, more properly, because it does not find the real point in issue between the parties.

On the other hand, if the verdict be supposed to refer to the real issue between the parties, it is to be considered if it be not necessarily repugnant. By the Patent Act, no person could entitle himself to a patent for any machine, unless he was the true inventor of it, and would make oath to that fact before some competent authority. By the expression in the statute, "true inventor," is undoubtedly meant the sole and exclusive inventor; for if the machine were the joint invention of several persons, neither of them could claim to be the true inventor, having an exclusive title to the patent; but the interest would be a joint or common interest in the whole. In such a case, therefore, if a party were to obtain a patent for the invention, having sworn that he was the true inventor, he would, in the language of the Act, obtain [* 172] it "upon false suggestion"; *and as such false suggestion would be a surprise and fraud upon the government, it might well also be declared to be obtained "surreptitiously." In the present case, the defendant obtained his patent, claiming it to be his own exclusive invention, and asserting the fact upon his oath. The jury have found, "that the plaintiff and defendant were both concerned in the invention." It is said, by the defendant's counsel, that this is not a finding; that the plaintiff and defendant were jointly concerned in the invention. I confess, that this seems to me an over-refinement, and an exercise of legal astuteness too ingenious, and too subtle to be applied to the language of verdicts. When the jury declare that both were concerned in the invention, the natural meaning of the words is, that the invention was the result of their joint, and not of their several and independent labors. However complicated the machine may be, the invention itself is not susceptible of division. If the plain-

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tiff and defendant separately and independently invented several parts of the machine, capable of a distinct use, then those parts might be considered as separate inventions, for which each inventor might, perhaps, be entitled to a separate patent. But the present patent claims the invention, as a whole; and the jury find, that in this invention they were both concerned; which I cannot understand in any other sense, than as verifying the invention to be a joint, simultaneous production of the genius and labor of both parties. The special fact, so found, is necessarily repugnant to any general verdict in favor of the defendant, upon the real issue between the parties. It is a fact, consistently with which no such verdict could be given. It is also a direct contradiction of the allegation in the plea of the defendant, that the improvement was invented by him; and if that allegation be considered as part of the issue, the finding is so far against the defendant. In either view, the verdict is repugnant in a material point, and consequently void.

*In any way, therefore, of considering the ver- [* 173] dict, it cannot, in my judgment, be supported. And I will add, that where a verdict is not expressed substantially in the terms of the issue, the case ought to be extremely clear that, should induce a Court to make it the ground of a final judgment. For this defect in the verdict, the judgment of the District Court must be reversed, and a new trial had at the bar of this Court.

There are several points, however, made upon the bill of exceptions, which have been fully argued, and as they may be important in the future trial of this cause, I am willing to declare my present opinion respecting them. Before entering into the merits of them, I cannot forbear to remark upon the inaccuracy with which the bill of exceptions has been framed. It contains, not a statement of the facts, but of the testimony introduced to prove the facts, on each side, *in hæc*

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verba; and the counsel for the plaintiff then insisted, that the matters so produced and given in evidence, on the part of the plaintiff, were sufficient, and ought to be admitted and allowed as decisive evidence, that the defendant surreptitiously obtained his patent, and that he was not the inventor of all the essential parts of the machine in controversy. There is no rule of law which would have authorized the Court to give such direction to the jury; for the matters so produced are not distinctly stated, but are mere questions of fact to be ascertained by the jury.¹ The bill of exceptions should either have stated the facts, and not merely the evidence of the facts, and prayed the opinion of the Court thereon; or, if the evidence was doubtful, it might have stated that evidence was given to prove certain facts, and then have prayed the opinion of the Court thereon, if the jury should so find the facts. In England, when [* 174] the facts are doubtful, I believe * it is more usual in practice to insert those facts in the bill of exceptions as settled by the jury, and then to allege the opinion of the Court, as an absolute one, upon the trial.

Waiving, however, all objections to the terms and form of the bill of exceptions, let us now proceed to examine the points, stated at the argument. The first objection taken to the opinion of the Court below, is, in substance, that the Court ought to have directed the jury, that the refusal of the defendant to submit his claim to arbitration, under the circumstances detailed in the evidence, (which brought it within the 9th section of the Patent Act,) and subsequently obtaining a patent after the plaintiff had obtained his, was conclusive evidence that the patent of the defendant was obtained surreptitiously, or upon false suggestion; whereas the Court held, that these facts were not, *per se*, conclusive to establish

1 Smith v. Carrington, 4 Cranch, 62.

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this point. In my judgment, there was no error in this opinion of the Court. If an arbitration had been actually perfected between the parties under the 9th section, the award or decision of the arbitrators would have been final between the parties only so far as respected the granting of the patent. It would not have concluded the parties from showing in the present suit, that it was obtained upon false suggestions. It would not have concluded them, in an action for an infringement of the patent, from asserting any defence allowed by the 6th section of the Patent Act. The sole object of such an award is, to ascertain who is *primâ facie* entitled to the patent. But when once obtained, the patent is liable to be repealed or destroyed by precisely the same process as if it had issued without objection. If the award itself would not have been conclusive, *à fortiori*, a refusal to join in an arbitration under the statute cannot be so.

Another objection is, that the Court held, that the burden of proof to maintain the issue lay upon the plaintiff; *and that it was incumbent on him to prove [*175] that the defendant was not the true inventor of the machine in controversy; whereas, it is contended that the burden of proof lay on the defendant, and the plaintiff was not bound to prove a negative. In my judgment, there was no error in the opinion of the Court upon this point. By the very form of the pleadings the affirmative rested on the plaintiff. He was bound to prove that the patent was obtained surreptitiously, or upon false suggestion. This is an affirmative proposition; and to have called upon the defendant to prove the contrary, would have thrown upon him the burden of the proof of a negative proposition. In respect to the point, who was the inventor, the possession of the patent was *primâ facie* evidence for the defendant at least upon this process; and the proof, that another was the inventor, was not the proof of a negative

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proposition. And, at all events, the trial being in substance upon the general issue, the plaintiff could entitle himself to a verdict only by the strength of his own proof, and not by the weakness of that of his adversary.

Upon the whole, these exceptions must be overruled; but for the defect of the verdict a *venire facias de novo* must be awarded.

Judgment reversed.

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[1 Peters, C. C. 394.]

Action for the violation of a patent-right.

Where two machines are *substantially* the same, and operate in the same manner to produce the same kind of result, they must be in principle the same. If an invention for which a patent has been obtained, is improved by any person other than the patentee, the inventor of the original machine has no right to use the improvements; and the inventor of the improvements has no right to use the original machine without the license of the patentee.

A patent "for an improvement in the art of making nails, by means of a machine which cuts and heads the nail at one operation," is not a grant of an abstract principle, nor is it the grant of the different parts of any machine; but of an improvement applied to a practical use, effected by a combination of various mechanical powers to produce a new result.

It is not sufficient to invalidate a patent that the specification is materially defective, unless the patentee intended, by concealment of parts of the machine, to deceive; and where practical mechanics are enabled to supply any omissions in the specification, such an intention will not be presumed.

Quære. If, in an action for the violation of a patent-right, where the general issue has been pleaded, it is competent to the defendant to give in evidence that the machine is useless, and has been abandoned.

After a patent is granted for an invention or discovery, the disuse of it by the patentee is not an abandonment of the rights of the patentee to the same, but they continue for fourteen years from the date of the patent.

It is the duty of the jury, should their verdict be in favor of the plaintiff, in an action for the violation of a patent-right, to find the actual damages sustained by the plaintiff, which the Court will treble.

THIS was an action for a violation of the plaintiff's patent-

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right, for an improvement in the art of cutting and heading nails by one operation.

The specification, which is part of the patent, describes the machine to consist in an upright and permanent jaw, and a movable jaw, united by a pivot at the top, representing a vice ; in each jaw there is a cutter fixed, to nip the bar of iron to the size of the nail, a gripping die to hold the iron, until the head is made, by what is called a set or heading die, which is placed below. The power which effects and completes this * operation, is generated by a lever of [* 395] the first order, passing through a mortice made in the standing jaw, which acts upon a toggle or double joint connected with the moving jaw of the vice, which in its first movement compresses the jaws so as to cut the iron, and then, as it is further depressed, forces up the set and completes the nail by heading it.

This invention was made by Jacob Perkins, some time in the year 1798, who, on the 24th of July of that year, assigned his right to the same to Guppy and Armstrong, to whom a patent was granted the 14th of February, 1799, and on the 14th of December, 1801, Guppy and Armstrong assigned the patent to the plaintiffs.

The machine, which it was proved had been used by the defendants prior to the expiration of the patent to Guppy and Armstrong, was invented by Jesse Read, who obtained a patent for the same in February, 1807. It consisted of the two jaws of a vice, the one fixed and the other movable, with cutters inserted in each for cutting off the iron intended for the nail, and gripping and heading dies for holding and heading it. These jaws are united by a pivot below, in consequence of which a lever, of the second order, is used to generate the power, being forked and embracing the two jaws, which are compressed together by a friction roller, fixed between the

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forks of the lever, which acts on an inclined surface of the movable jaw.

It was proved by witnesses that more than 200 pounds of iron were made into nails by Perkins's machine which was erected by Guppy and Armstrong at their works at Amesbury ; that for the want of machinery to force the piece of iron down into the gripping die, the machine would clog if an attempt were made to work it with rapidity, and on this account it would not make more than thirty or forty nails in a minute ; in consequence of this defect, it was altogether abandoned by Guppy and Armstrong, and it did not appear that Perkins's machine had been ever used afterwards by any person.

All the defects in this machine were cured in [*396] Read's. In the *latter there was a forcing slide, which instantly removed the piece of cut iron into the gripping die, and thus enabled the machine to operate with all the rapidity that it was capable of, insomuch that it has made in one working day to the amount of 1,500 pounds of nails, and upwards of 200 nails in a minute.

From the models of the two machines exhibited in Court, it appeared that independent of the difference in the position of the two machines, of the levers, the friction roller on the inclined plane instead of the toggle joint and the forcing slide, there were others which gave to Read's a preference over Perkins's. For instance, in the former the dies were in contact nearly with each other and with the cutters ; they are visible, can be easily taken out and sharpened or otherwise repaired without taking the machine to pieces ; whereas in Perkins's the dies were at such a distance from the cutters, that the witnesses supposed the piece of iron might not always fall regularly into the dies ; and the cutters and dies being concealed in the jaws, they could not be taken out and sharpened and adjusted, but by taking the machine to pieces and wasting much time.

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It was proved, by many witnesses examined on the part of the plaintiffs, that the two machines were precisely the same in principle, and that from an inspection of the specification and drawing, they, or any artist skilled in nail machinery, might make the machine.

The defendants examined a number of witnesses, who stated that they considered the two machines to be different in principle from each other, and that, from the specification and drawings, they should not know the form of the cutters and dies, or where or how to fix them, as nothing in relation to their form or situation, positive or relative, is stated in the specification or appears in the drawings.

The defendants produced a number of patents, for cutting and heading nails at one operation, all prior to Perkins's discovery, with the specifications and drawings ; but not a single witness was examined to explain them, so as to show the * principle on which they operated, nor [* 397] did it appear in evidence that any machines for cutting and heading nails, at one operation, had ever been erected or used prior to Perkins's, except that one witness said he had seen, in the year 1797, a machine like Perkins's, invented by Rodgers, which cut and headed nails at one operation, but no particular description of it was given.

It was contended, by the defendants' counsel, First, That Perkins is proved not to have been the original inventor of this machine.

Second. That the two machines are entirely different in principle from each other.

Third. That the patent is for the whole machine, which comprehends the lever, and the other parts of the machine, of which it is agreed Perkins was not the inventor. That the patent, therefore, is broader than the invention, and is, therefore, void.

Fourth. That Perkins's machine was altogether useless, and was abandoned.

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Fifth. That the specification is not sufficiently precise within the words of the law.¹

WASHINGTON, J., charged the jury. Many defences have been set up to this action, each of which will require a distinct consideration. I shall derange somewhat the order in which the points have been argued, and present first to the consideration of the jury that which is involved in the general issue. First, it is denied that the defendants have at any time used the machine for which a patent was granted to Guppy and Armstrong. It is not denied that the defendants have used a machine for cutting and heading nails at one operation, but it is contended that that machine is different, not only in form, but in principle from the plaintiffs' machine.

What constitutes a difference in principle between two machines, is frequently a question of difficulty, more especially if the difference in form is considerable, and the [* 398] machinery * complicated. But we think it may safely be laid down as a general rule, that where the machines are substantially the same, and operate in the same manner to produce the same result, they must be in principle the same. I say *substantially*, in order to exclude all formal difference ; and when I speak of the same result, I must be understood as meaning the same kind of result though it may differ in extent. So that the result is the same according to this definition, whether the one produce more nails, for instance, in a given space of time than the other, if the operation is to make nails.

The application of this rule will be more obvious and better understood, by dissecting the machine invented by Perkins, and afterwards the machine which the defendants have used.

In the former we find the two jaws of a vice, the one fixed

¹ Bull. Nisi Prius, 77 ; 2 H. Blac. 470, 463.

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and the other movable on a pivot at the top, which connects them together. In each of these jaws is fixed a cutter, the use of which is to cut off from the bar of iron as much as will be necessary to form the nail, which, being separated, falls by its own gravity into a die, which holds it by a firm gripe until the head is formed, by what is called the set or heading die. The power which produces this double operation is a lever of the first order, acting upon a toggle joint which compresses the two jaws, and consequently the cutters together and also raises the set, in such a manner as to head the nail. But the whole is performed by the same movement of the lever.

It is impossible to describe the parts of the defendants' machine, and its operation, without using the same expressions, except that his is inverted, the pivot of the vice being below, and a lever of the second order, embracing the jaws with a friction roller, acting on an inclined plane made on the moving jaw of the vice, instead of the lever of the first order, and the toggle joint. But it is in full proof that these differences, as to the lever and the friction roller, are the necessary consequences of the machine being inverted. After having made this comparison, and ascertained the mode of operation by each machine, * connected [* 399] with the result of each, the jury can find little difficulty in deciding whether they are the same in principle or not.

The witnesses have differed in opinion, as to the comparative merit of the toggle joint in Perkins's machine, and the friction roller in Read's. If their operation is precisely the same, the difference in form does not amount to an invention of any kind.

If the friction roller is better than the toggle joint, which seems to be the opinion of some of the defendants' witnesses, then Read has the merit of having discovered an improvement on Perkins's machine, and no more.

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If the jury should be of opinion that the parts of the two machines which I have noticed are the same in principle, and that each will by the same operation cut and head nails ; then it will follow that the forcing slide, the proximity of the cutters and dies to each other, the balance wheel, and some other additional parts in Read's machine, which give it a great and acknowledged preference over Perkins's, are merely improvements, but do not change the principle of the machine. If improvements only, what is the legal consequence ? Most clearly this and no more : that Perkins, and those claiming under his patent, have no right to use those improvements without a license from the inventor. But, on the other hand, neither Read nor any other person, can lawfully use the discovery of Perkins of the principal machine without a license from him. The law, wisely and with justice, discriminates between, and rewards the merit of each, by granting an exclusive property to each in his discovery, but prevents either from invading the rights of the other.

If, then, the jury should be of opinion that the two machines are the same in principle, it is no defence for the defendants for using Perkins's discovery that they have improved it, no matter to what extent.

The next objection made to the plaintiffs' right of recovery is, that the plaintiffs' patent is void, for the following reasons:

First. Because Perkins was not the original [* 400] inventor. It is insisted that the patents which have been read, show that machines for cutting and heading nails at one operation, had been discovered prior to the discovery by Perkins.

Whether this be so or not, this Court feels itself incompetent to decide. No explanation of those machines has been given, and we cannot, from the specifications and drawings which accompany these patents, form the slightest idea of their structure, operation, or result. It will be for the jury to

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examine these papers and decide for themselves. It is, however, not unworthy of remark, that in addition to the circumstance that no explanation of those machines has been given to the jury, it does not appear that any one of them was ever put into operation.

As to Rodgers's machine, there is but one witness who gives evidence respecting it, and that in a very imperfect manner. It is not mentioned in the notice of special matter to be given in evidence, and although this affords no sufficient ground for rejecting the evidence, it furnishes a reason why the defendants should be expected to lay before the jury a satisfactory explanation of the principles of that machine, and the manner in which it operated. Upon the whole, the jury, after examining carefully the evidence given in support of this objection, will apply to it the same rule which the Court has laid down under the former head, for testing the similarity between Perkins's and Read's machines, and will be governed by it.

Second. The next reason assigned against the validity of the plaintiff's patent, is, that it is too broad ; or if not so that the patent is for a principle merely.

The Court is of opinion that there is not the slightest foundation for this objection. The patent is supposed to be for the machine itself, which is composed of parts which have long become public property. This is not the fact. The patent is for an improvement in the art of making nails, by means of a machine which cuts and heads the nails at one operation. It is, therefore, not the grant of an abstract principle, nor is it the grant * of the differ- [* 401] ent parts of any machine, but of an improvement applied to a practical use, effected by a combination of various mechanical powers to produce a new result. The lever, the vice, the cutters, the dies, &c., may be used by any person

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without a violation of the plaintiffs' patent. But they cannot be used in their combined state, to produce, by the same operation the same result, which is the distinguishing characteristic of the plaintiffs' machine, without a license from the owners.

If, indeed, Perkins was not the original inventor, then the plaintiffs' patent is void, without inquiring whether it is too broad or not. But if the jury should be of opinion that he is the original inventor, then there is nothing in this objection.

The third objection made to the validity of the patent is, that the specification is defective.

The law declares that it must be full, clear, and explicit, so as to distinguish it from all other machines of the same kind, and to enable any person skilled in the art, of which it is a branch, to make and use the same. These expressions are very strong, and seem intended to accommodate the description which the patentee is required to give, to the comprehension of any practical mechanic skilled in the art of which the machine is a branch, without taxing his genius or his inventive powers.

Whether the specification in this case be defective, within this interpretation of the law, must depend upon the evidence of the practical mechanics who have testified on each side of the question, as well as upon the judgment of the jury.

Those examined, on the part of the plaintiffs, have stated that the position of the cutters and dies would necessarily be understood by any practical mechanic acquainted with nail machines, upon examining the specifications and drawings. This is denied by some of the defendants' witnesses.

But if the jury should be of opinion that the specification is materially defective, the objection will not be sufficient to invalidate the plaintiffs' patent, unless they should also be satisfied that the concealment of the circumstances not

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described was *intended to deceive the public.¹ [* 402]
What degree of evidence ought to be required to prove such fraudulent intention, must rest with the jury to decide. Positive evidence can seldom be expected, nor is it necessary. The law, it is true, requires that such intention should fully appear ; but still it may be presumed from circumstances entirely to the satisfaction of the jury, which would be sufficient to authorize them to find the fact. As if the parts concealed are so essential and so obviously necessary to be disclosed, that no mechanic skilled in the art could reasonably be expected to understand the subject, so as, from the description given, to make the machine ; it would be difficult to impute the omission of the patentee to a fair motive. But this presumption would seem to be much weakened in a case like the present, where so many practical mechanics have testified that they could not hesitate in supplying the omissions in this specification.

With these observations, this objection is submitted to the jury.

The last objection to the plaintiffs' patent is, that the machine is not a useful one, and that it was abandoned both by the inventor and his assignees.

Whether this objection can, in an action for a violation of a patent-right, upon the general issue, be made to the validity of the patent, may well be doubted. If true, it might afford a good reason against granting the patent as well as for repealing it on a *scire facias*, on the ground of the patent having

¹ If the invention be specifically described in the patent, so as to distinguish it from what was before known, the patent is good, although the specification does not describe the invention in such full, exact, and clear terms, that a person skilled in the art or science, of which it is a branch, could construct or make the thing invented ; unless such defective description or concealment was made with intention to deceive the public. Mason's Rep. 189.

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issued upon a false suggestion. But the defence is by no means involved in the general issue, which merely denies that the defendants have used the plaintiffs' machine ; [* 403] nor does the 6th * section of the law authorize the defendants to give it in evidence, on the general issue. They are, therefore, not bound to give notice of such a defence under that section, and the consequence would be, that the plaintiffs could not fail to be surprised at the trial, with a defence which they could not, from the general issue, anticipate. As to this, however, no positive opinion is given. But is not such a defence, in the mouth of these defendants, totally irreconcilable with the act which forms the basis of the action ? If the machine be useless, it may fairly be asked why do they use it ? If they give the answer which has been given in this case by their counsel, that it was used with improvements which make it valuable, may it not be replied that this proves that the original invention was useful ? For if that had not been made by some person, it is most obvious that the improvements could not have been made. If Perkins, or some other person, had not made the discovery which he did, can any person doubt that the present improved and valuable nail-machinery would be unknown in the world ? How then, can it be said with truth, that the original discovery was useless ?

It is contended that this discovery was abandoned. But after it was patented no disuser of it could amount to abandonment, so as to deprive Perkins or his assignees of their exclusive right to it for fourteen years. There is no doubt but that it went into disuse in consequence of the subsequent improvements ; but this does not prove it to be useless, any more than it impairs the plaintiffs' right to the original discovery.

If the jury should be in favor of the plaintiffs upon these points, they will find for the plaintiffs the actual damages sus-

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tained by them, by reason of the use by the defendants of the discovery to which they are entitled; which the Court will treble.

Verdict for 750 dollars single damages; judgment for the treble damages.

FRANCIS C. LOWELL v. WINSLOW LEWIS.

[1 Mason, 182.]

The law entitles a party to a patent for a new and useful invention; and by "useful" is meant, not an invention in all cases superior to the modes now in use for the same purpose, but "useful" in contradistinction to frivolous and mischievous inventions.

The patentee must describe in his patent, in what his invention consists, with reasonable certainty, otherwise it is void for ambiguity. If it be for an improvement in an existing machine, he must, in his patent, distinguish the new from the old, and confine his patent to such parts only as are new; for if both are mixed up together, and a patent is taken for the whole, it is void.

But if the invention be definitely described in the patent, so as to distinguish it from what is before known, the patent is good, although the specification does not describe the invention in such full, exact, and clear terms, that a person skilled in the art or science, of which it is a branch, could construct or make the thing *invented; unless such defective de- [* 183] scription or concealment were with intent to deceive the public.

As among inventors, he who is first in time, has a prior exclusive right to the patent for the invention.

THIS was an action on the case for the infringement of a patent-right. In the year 1813, Mr. Jacob Perkins obtained a patent for a new and useful invention in the construction of pumps, and afterwards assigned his interest therein to the plaintiff. The defendant became the assignee of a similar patent, taken out in 1817, by a Mr. James Baker; and it was for the constructing and vending pumps under this second patent, that the action was brought. The principal object of both the inventions, was, by dispensing with the box used

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in the common pumps, to obtain a larger water-way. To effect this, Perkins so constructed the valves of his pump, that they completely filled the area of the shaft, and fell upon its sides in the same manner, as by the old construction they did upon the box; thus leaving the whole of the area, excepting that occupied by the valves themselves, for a water-way. The valves were of a triangular shape, and adapted only to a pump of a square form. This pump seemed to be principally useful, when it was desirable to throw up large quantities of water in a short space of time, and a number of hands could be put to the working of it.

The valves of Baker's pump were fitted to a round shaft, and occupied, like the other, the whole of its area; but instead of resting upon the sides of the shaft, were supported by a brass rim, which prevented the friction against the sides of the shaft consequent upon the other construction, and to obviate which, Perkins, since obtaining his patent, had adopted a check bolt. It appeared, that Baker's invention required fewer hands to work it, and could be applied to the common house pump.

[* 184] * *Webster and G. Sullivan*, for the defendant, contended that the invention of Perkins was neither new nor useful, and, therefore, not entitled to a patent. That the specification was so loose and insufficient, as not to answer the requisites of the law in this particular, and the patent, therefore, void on that account; and further, that the invention of the defendant was substantially different from that of the plaintiff.

Gorham, for the plaintiff, endeavored to show, that the improvement invented by Perkins was entirely new, and highly useful; and the specification sufficient to answer the requisites of the law, which only required, that it should be

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so particular, as that persons, acquainted with the construction of the same kind of machines, might be able to follow the description of it. And that, although differing in shape and some other unimportant particulars, it was, in principle, the same as that made and recorded by the defendant, under the patent of Baker.

A great number of witnesses were produced on both sides to sustain these positions.

STORY, J., in summing up the cause to the jury, stated as follows: The present action is brought by the plaintiff for a supposed infringement of a patent-right, granted in 1813 to Mr. Jacob Perkins (from whom the plaintiff claims by assignment) for a new and useful improvement in the construction of pumps. The defendant asserts, in the first place, that the invention is neither new nor useful; and, in the next place, that the pumps used by him are not of the same construction as those of Mr. Perkins, but are of a new invention of a Mr. Baker, under whom the defendant claims by assignment. If the plaintiff is entitled to recover, the patent act gives him treble the actual damages sustained by him; and the rule for damages * is, in this case, to allow the plaintiff treble the [* 185] amount of the profits actually received by the defendant, in consequence of his using the plaintiff's invention. The jury are to find the single damages, and it is the proper duty of the Court to treble them, in awarding judgment. And let the damages be estimated as high as they can be, consistently with the rule of law on this subject, if the plaintiff's patent has been violated; that wrongdoers may not reap the fruits of the labor and genius of other men.

To entitle the plaintiff to a verdict, he must establish that his machine is a new and useful invention; and of these facts, his patent is to be considered merely *prima facie* evidence of a very slight nature. He must, in the first place,

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establish it to be a useful invention ; for the law will not allow the plaintiff to recover, if the invention be of a mischievous or injurious tendency. The defendant, however, has asserted a much more broad and sweeping doctrine ; and one which I feel myself called upon to negative in the most explicit manner. He contends, that it is necessary for the plaintiff to prove that his invention is of general utility ; so that, in fact, for the ordinary purposes of life, it must supersede the pumps in common use ; in short, that it must be, for the public, a better pump than the common pump ; and that unless the plaintiff can establish this position, the law will not give him the benefit of a patent, even though in some peculiar cases his invention might be applied with advantage. I do not so understand the law. The patent¹ uses the phrase “ *useful invention* ” merely incidentally ; it occurs only in the first section, and there it seems merely descriptive of the subject-matter of the application, or of the conviction of the applicant. The language is, “ when any person or persons shall allege, that he or they have invented any new and useful art, [* 186] * machine,” &c., he or they may, on pursuing the directions of the act, obtain a patent. Neither the oath required by the second section, nor the special matter of defence allowed to be given in evidence by the sixth section of the act, contains any such qualification or reference to general utility, to establish the validity of the patent. Nor is it alluded to in the tenth section as a cause, for which the patent may be vacated. To be sure, all the matters of defence or of objection to the patent are not enumerated in these sections ;² but if such an one as that now contended for, had been intended, it is scarcely possible to account for its omission. In my judgment the argument is utterly without foundation. All that the law

¹ Act of the 21st of February, 1793, ch. 11.

² *Whittemore v. Cutter*, 1 Gallis. 429, 435. *Ante*, 28, 33.

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requires is, that the invention should not be frivolous, or injurious to the well-being, good policy, or sound morals of society. The word "*useful*," therefore, is incorporated into the act in contradistinction to mischievous or immoral. For instance a new invention to poison people, or to promote debauchery, or to facilitate private assassination, is not a patentable invention. But if the invention steers wide of these objections, whether it be more or less useful is a circumstance very material to the interest of the patentee, but of no importance to the public. If it be not extensively useful, it will silently sink into contempt and disregard. There is no pretence that Mr. Perkins's pump is a mischievous invention; and if it has been used injuriously to the patentee by the defendant, it certainly does not lie in his mouth to contest its general utility. Indeed the defendant asserts, that Baker's pump is useful in a very eminent degree, and if it be substantially the same as Perkins's, there is an end of the objection; if it be not substantially the same, then the plaintiff must fail in his action. So that in either view the abstract question seems hardly of any importance in this cause.

*The next question is whether Mr. Perkins's pump be [* 187] a *new* invention. In the present improved state of mechanics, this is often a point of intrinsic difficulty. It has been often decided, that a patent cannot be legally obtained for a mere philosophical or abstract theory; it can only be for such a theory reduced to practice in a particular structure or combination of parts. In short, the patent must be for a specific machine, substantially new in its structure and mode of operation, and not merely changed in form, or in the proportion of its parts. Mr. Perkins's pump is square, and it is agreed that a piston exactly fitted, and used as in his pump, cannot be found described in any scientific treatise, and has never been seen in operation. The butterfly valve, which approaches very near to it, has certainly been in use, and a triangular

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shape was well known in the perimeter valves. But the exact structure and position of a valve in a square pump, uniting the triangular and butterfly forms, is not known to have been used at any time previous to his invention, in the precise manner in which Mr. Perkins uses them. In short, the combination of structure which he uses, is alleged by the plaintiff's witnesses to be new; and if the jury are satisfied that it is substantially different from any thing before known, in its mode of operation, then the plaintiff has surmounted this objection to his title to a recovery.

An objection of a more general cast (and which might more properly have been considered at the outset of the cause, as it is levelled against the sufficiency of the patent itself) is, that the specification is expressed in such obscure and inaccurate terms, that it does not either definitely state, in what the invention consists, or describe the mode of constructing the machine, so as to enable skilful persons to make one. I accede at once to the

doctrine of the authority, which has been cited,¹

[* 188] that the patentee is bound to * describe, in full and exact terms, in what his invention consists; and, if it be an improvement only upon an existing machine, he should distinguish what is new and what is old in his specification, so that it may clearly appear for what the patent is granted. The reason of this principle of law will be manifest upon the slightest examination. A patent is grantable only for a new and useful invention; and unless it be distinctly stated in what that invention specifically consists, it is impossible to say whether it ought to be patented or not; and it is equally difficult to know whether the public infringe upon or violate the exclusive right secured by the patent. The patentee is clearly not entitled to include in his patent the exclusive use of any machinery already known; and if he

¹ M'Farlane v. Price, 1 Starkie's R. 192.

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does, his patent will be broader than his invention, and consequently void. If, therefore, the description in the patent mixes up the old and the new, and does not distinctly ascertain for which, in particular, the patent is claimed, it must be void ; since if it covers the whole, it covers too much, and if not intended to cover the whole, it is impossible for the Court to say what, in particular, is covered as the new invention. The language of the patent act itself is decisive on this point. It requires (§ 3) that the inventor shall deliver a written description of his invention "in such full, clear, and exact terms, as to distinguish the same from all other things before known ; and in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions."

It is, however, sufficient, if what is claimed as new appear with reasonable certainty on the face of the patent, either expressly or by necessary implication. But it ought to appear with reasonable certainty, for it is not to be left to minute references and conjectures, from what was previously * known or unknown ; since the question is [* 189] not, what was before known, but what the patentee claims *as new* ; and he may, in fact, claim as new and patentable, what has been long used by the public. Whether the invention itself be thus specifically described with reasonable certainty, is a question of law upon the construction of the terms of the patent, of which the specification is a part ; and on examining this patent, I at present incline to the opinion, that it is sufficiently described in what the patented invention consists.

A question nearly allied to the foregoing, is, whether (supposing the invention itself be truly and definitely described in the patent) the specification is in such full, clear, and exact

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terms, as not only to distinguish the same from all things before known, but "to enable any person skilled in the art or science, of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same." This is another requisite of the statute (§ 3) and it is founded upon the best reasons. The law confers an exclusive patent-right on the inventor of any thing new and useful, as an encouragement and reward for his ingenuity, and for the expense and labor attending the invention. But this monopoly is granted for a limited term only, at the expiration of which the invention becomes the property of the public. Unless, therefore, such a specification was made, as would at all events enable other persons, of competent skill, to construct similar machines, the advantage to the public, which the act contemplates, would be entirely lost, and its principal object would be defeated. It is not necessary, however, that the specification should contain an explanation, level with the capacities of every person (which would, perhaps, be impossible); but, in the language of the act, it should be expressed in such full, clear, and exact terms, that a person skilled in the art or science, of which it is a branch, would be enabled to construct the patented invention. By the common law, [* 190] if * any thing material to the construction of the thing invented be omitted or concealed in the specification, or more be inserted or added than is necessary to produce the required effect, the patent is void. This doctrine of the common law our patent act has (whether wisely, admits of very serious doubts) materially altered; for it does not avoid the patent in such case, unless the "concealment or addition shall fully appear to have been made for the purpose of deceiving the public." (§ 6.) Yet certainly the public may be as seriously injured by a materially defective specification resulting from mere accident, as if it resulted from a fraudulent design. Our law, however, is as I have stated;

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and the question here is, and it is a question of fact, whether the specification be so clear and full, that a pump-maker, of ordinary skill, could, from the terms of the specification, be able to construct one upon the plan of Mr. Perkins. The principal objection to the specification in this case is, that it does not describe the check bolt, or the form, or use, or size of the leather, or the mode of forming its edge and fixing it upon the valve, or the exact position and elevation of the valve. [Here the Judge read the specification, and commented on the evidence applicable to these objections; and left it to the jury to say, upon the facts, whether the specification was materially defective, and, if so, whether it was by design to deceive the public.]

Another (and, under the circumstances of this case, probably, the most material) inquiry is, whether the defendant has violated the patent-right of the plaintiff; and that depends upon the fact, whether the pumps of Mr. Perkins and of Mr. Baker are substantially the same invention. I say substantially the same invention, because a mere change of the form or proportions of any machine cannot *per se* be deemed a new invention. If they are the same invention, then Mr. Perkins, being clearly the first inventor, is entitled exclusively to the patent-right, although Mr. Baker may * have [* 191] been also an original inventor, for the law gives the right, as among inventors, to him who is first in time.

The manner in which Mr. Perkins's invention is, in his specification, proposed to be used, is in a square pump, with triangular valves, connected in the centre, and resting without any box on the sides of the pump, at such an angle as exactly to fit the four sides. The pump of Mr. Baker, on the other hand, is fitted only for a circular tube, with butterfly valves of an oval shape, connected in the centre, and resting, not on the sides of the pump, but on a metal rim, at a given angle, so that the rim may not be exactly in contact

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with the sides, but the valves may be. If, from the whole evidence, the jury is satisfied that these differences are mere changes of form, without any material alteration in real structure, then the plaintiff is entitled to recover; if they are substantially different combinations of mechanical parts to effect the same purposes, then the defendant is entitled to a verdict. This is a question of fact, which I leave entirely to the sound judgment of the jury.

Verdict for the defendant.

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[1 Peters, C. C. 476.]

If a machine, in the state in which it was first made, was so far inferior to other machines used for the same purpose, as that it was of no intrinsic value, yet if another person superadd to the invention, and remove its defects, the inventor of the improvements derives no right to the original machine from having made it of value by addition to it.

The declaration ought always to show a title in the plaintiff, and that with sufficient certainty, and to set forth all the matters which are the essence of the action; without these, the plaintiff fails to show a right in point of law to ask the Court for judgment in his favor.

If the plaintiff's title depends upon the performance of certain acts, he must affirm the performance of those acts.

What defects are cured by verdict?

Where the declaration describes the plaintiff's improvement in the words of the patent, it is not necessary that the description of the machine, as stated in the specification, should be set forth. If the defendant require the specification in his defence, he may have it placed on the record by asking oyer of it.

Two rules were obtained, at the last term, to show cause why a new trial should not be awarded, and why the judgment should not be arrested.

WASHINGTON, J., delivered the opinion of the Court. In

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support of the first rule, the following reasons were assigned: First. That the verdict is against evidence and against the charge of the Court, inasmuch as it was proved to the jury that Perkins was not the original inventor of the machine, for the use of which by the defendants, this action was brought; and, secondly, because the damages were excessive.

First. It is contended, that the priority of invention claimed by Perkins was disproved at the trial by the patents to Chandler, Garretson, Bigelow, Spence, and Read, all granted prior to the alleged discovery of Perkins, for machines, which it is insisted are in principle substantially the same as Perkins's.

* As Chandler's machine has been selected by the [* 477] defendants' counsel, as bearing the strongest resemblance to that which was the subject of this action, the observations of the Court will be principally directed to that machine.

This machine consists of a solid piece of iron, into which the under steel cutter is fixed. An iron lever, working in a steel socket at one end, in which lever the upper cutter is fixed, and a spring fastened to it to throw it up after it is forced down. The upper lever has also a side cutter screwed to it, for cutting off the rods at the same time that the die cuts and shapes the nail. The heading is formed by concave dies fixed in two side or horizontal levers, in the ends of which are mortices to receive a tenon fitted on the centre bolt, held firm by a pin; — springs to each of these levers, to throw them back after heading the nail. The lever containing the upper cutter, is forced down by an axis in a shaft, cutting the nails lengthwise of the rod, *whilst hot*, on the under cutter which holds them fast, while the side levers force up the heading dies, which action is by means of secondary levers, or by the axis of a wheel, during the revolution of which the cutting and heading levers are disengaged, at the same period the nails

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are pushed out by springs, and the rods are pushed forward by hand in constant succession.

Let us now compare this machine, as to its competent parts and mode of operating, with Perkins's machine. The parts of the former are, as has been stated, cutters fixed in a lever and a fixed piece of iron. Concave dies fixed in side levers for forming the head of the nail, with springs in both sets of levers to open them after they have performed their parts, and other springs to extricate the nails. Secondary levers, or a wheel which, in its revolutions, disengages at the same moment the cutting and heading levers.

The manner in which it operates, is by forcing down the upper lever so as to bring the cutters into contact, and thus to cut and shape the nail. By the pressure of the [*478] horizontal levers * containing the concave dies, against the sides of the cutters when closed, the head is formed, which action is performed by means of secondary levers, or by the axis of a wheel during its revolutions; and the nails, when thus completed, are forced out by springs.

The parts of Perkins's machine are the jaws of a vice, the one fixed and the other movable, with cutters fixed in them, and a heading die in the movable jaw; a lever, with a toggle joint at the end of it, to force the cutters together, and also to force up the heading die at the same pressure of the lever.

The manner in which it operates is by the toggle joint, which, by the pressure of the lever, forces the cutters together, so as to cut off the nail, whilst the lever, by an instantaneous, but successive motion, forces up the heading die to complete the nail; the whole operation being carried on during the same pressure of the lever.

The two machines agree in the following particulars: Each of them have cutters for separating the nail from the rod, and dies for forming the heads by pressure. Here the similitude

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ceases. The one has one lever, which is the great agent, by the power of which, and at the same motion, the whole operation is performed. The other has a lever for cutting, and levers for heading, which are put into operation by another set of levers, or by the axes of a wheel.

The latter requires, as appears by the specification, the aid of a machine which the other does not, that is, a blacksmith's furnace to heat the iron. This is certainly a very material difference, and we must suppose it to be indispensable, and without which the operation could not proceed.

But the important difference is in the mode of operating. Perkins's machine makes the nail by one and the same pressure of the lever; Chandler's, so far as the Court can perceive, effects nothing more by the pressure of the lever than the cutting of the nail rod; but by what power the side or horizontal levers, which form the head, are moved, does not appear, otherwise * than as it is stated in the [* 479] specification, to be by the action of what is called secondary levers, or the axes of a wheel during its revolutions. But by what power are these secondary levers or wheel worked? This is not stated; and it is most obvious that it cannot be by the downward pressure of the first lever; and therefore, it is reasonable to conclude that some other power is used to act upon the secondary levers or on the wheel. In short, the Court finds it impossible to discover in what manner the complicated parts of this machine are worked, beyond the pressure of the lever which cuts the nail. If they act by means of some other power, it certainly cannot be pretended that the two machines are substantially the same, and operate in the same manner to produce the same result. They are materially unlike in their parts, in their structure, and in their operation. The one operates upon cold iron, and the other, as stated in the specification, requires the aid of a furnace as an appendage. The one operates by means of a single power;

the other by the aid of more than one power. Or, if this be not so, it behooves the defendants clearly to show the contrary before the Court can listen to a motion to set aside the verdict, on the ground that the two machines are substantially alike in principle.

From the view which the Court has taken of the other machines, and so far as we have found it possible to comprehend the numerous and complicated parts of which they are composed, more especially Garretson's and Read's, we are of opinion that the least exceptionable of them are open to the objections stated to Chandler's. The parts are different, the powers are either different, or they are differently applied, and the modes of operating are dissimilar. In some, perhaps in all, the cutting and heading are distinct operations. In two of them, the head of the nail is formed by concussion instead of pressure. In one of them, for want of the toggle joint, or something equivalent to it, the principle of gravitation is resorted to, and the vices are opened by weights.

As to Rodgers's machine it need only be observed [* 480] that the *jury were left to decide as to the existence, the form, and principles of it, upon the imperfect account given of it by Howard, the only witness. No model, and no particular specification, was given descriptive of the parts of that machine, their combination, and the mode of operating. It appears, from the verdict, that the jury were not satisfied with the evidence, either as to the existence of such a machine, or as to its resemblance to Perkins's. It would ill become the Court to say that the jury decided this point improperly, even if the inclination of our minds had been different, which it certainly was not.

The next reason assigned for a new trial is, that the damages given by the jury are excessive. I do not understand the objection to be to the amount, provided the plaintiff was entitled to any thing beyond nominal damages. The argument

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is, that Perkins's machine was acknowledged by himself to be worthless, and that it was, in fact, thrown away as a useless thing, and was so considered by those who knew any thing of it; consequently, his assignees sustained no damage by the use which the defendant made of it.

Now the premises may all be admitted, and yet the argument terminate in what is called a *non sequitur*. Ore in the bowels of the earth would be of no value to the owner of the land, were it not that other persons can make it valuable by the employment of skill, labor, and money, to render it so. It is not the intrinsic value of the thing itself, but its capacity to be converted into something which may be useful, that gives it value. Admit, for the sake of the argument, that Perkins's machine, in the form in which it came from his hands, was so far inferior to the common nail machines, then in use, as to deprive it of all intrinsic value; still, if another person can superadd to that invention something which will remove all its defects, and render it useful, it immediately becomes valuable, not on account of its own qualities, but because of its capacity to receive the improvement, and with its aid to become useful. The original discovery and the improvement, became articles of traffic between the
* two discoverers, as soon as the improvement was [* 481]
made which it was their mutual interest to give value to. Is the defendants' improved machine valuable? This is admitted. But why is it so? Because he has availed himself of Perkins's original discovery on which to ingraft his own, and without which his own would have been useless to himself and to the world. But how did he possess himself of Perkins's discovery? By an unlawful invasion of property to which Perkins was exclusively entitled. Had he, as he was bound to do, sought to acquire a title to this property by contract, is it to be believed that it would have been treated by the parties as of no value? It is obvious that it would not.

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This course of reasoning is intended to show that when it was stated by the Court to the jury that the charge of worthlessness against Perkins's machine came with a bad grace from the defendant, who was making so profitable a use of it, it was no answer to say that it is useful merely on account of the improvement which others had made to it; because, if it was useful in that respect, and without the original discovery the improvement could not have been made, it followed that the original discovery was useful and valuable.

But the fact is, that Perkins's machine was proved at the trial to possess intrinsic value on the single ground of a saving of labor. Whether the value so proved justified the jury in finding the damages which they did, is a question of which that body were the proper judges upon the evidence laid before them, and the Court see no reason to find fault with their decision.

The motion in arrest of judgment is grounded upon certain alleged defects in the declaration.

The declaration states that Jacob Perkins having invented a new and useful improvement in the manner of manufacturing nails, &c., which had not been known or used before his application, &c., (and so averring a compliance with all the requisitions of the law previous to obtaining the [* 482] patent, and stating the *assignment of his right to Guppy and Armstrong, granting to them the full and exclusive right and liberty of making, &c., the said improvement, &c.,) then sets forth the assignment of Guppy and Armstrong to the plaintiffs; and the breach is that the defendants, without the consent of the plaintiffs first had in writing, on a certain day and for a long time before and continually since, had used in numerous machines the improvement aforesaid.

It is contended that the *et cetera* in the description of the discovery renders the patent too vague, and that the material

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parts of the specification ought to have been set out in the declaration, so as to leave no doubt as to the particular discovery for which the patent was granted, and for the violation of which this suit is brought. It is further objected that the breach is too generally stated.

It may be laid down as a general rule, that a declaration ought always to show a title in the plaintiff, and that with convenient certainty. It ought to state all matters that are of the essence of the action, without which the plaintiff fails to show a right in point of law to ask for the judgment of the Court in his favor. If his title depends upon the performance of certain acts, he must affirm the performance of those acts. If enough is stated to show title in the plaintiff, and with sufficient certainty to enable the Court to give judgment, but with less certainty than the case admitted of, and which for the purpose of notice to the adverse party or otherwise, ought to have been stated, the defect is cured by the verdict. The Court will presume that all such omissions were supplied, and obscurities explained, at the trial, by the evidence given to the jury.

In this case, the plaintiffs' title is founded on a patent to Guppy and Armstrong, granting them an exclusive right to Perkins's invention of a new and useful improvement in the manner of manufacturing nails, &c., *in the words of the declaration*. The declaration contains all the necessary allegations to show that the patent was regularly granted, and the patent is designated by the terms which itself uses. It is true, that the * specification is referred [* 483] to in the patent as part thereof, but that is merely descriptive of the invention, and not of the patent. It is a matter of evidence to be used at the trial, and if a sight of it be necessary to the defence, the defendant may have it placed on the record by asking oyer of it.

The Court are of opinion, that the patent is described with

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sufficient certainty even upon a *demurrer*, and that the breach, if it be too general in not stating the number of machines used by the defendants, (a point not necessary to be decided,) is cured by the verdict, since it is fairly to be presumed that proof of that fact was given to the jury.

Both rules therefore must be discharged.

JOHN BEDFORD v. WILLIAM HUNT ET AL.

[1 Mason, 302.]

By useful invention, in the Patent Act of the United States, is meant, an invention which may be applied to a beneficial use in society, in contradistinction to an invention injurious to the moral health or good order of society. It is of no consequence, whether its utility be general, or limited to a few cases; and it is not necessary to establish that the invention is of such general utility as to supersede all other inventions now in practice to accomplish the same purpose.

The first inventor who has put the invention in practice, and he only, is entitled to a patent. Every subsequent patentee, although an original inventor, may be defeated of his patent-right, upon proof of such prior invention put in actual use. The law in such case adopts the rule, *qui prior est in tempore, potior est in jure*. In order to defeat a subsequent patent, it is not necessary to prove, that the invention has been previously in general use, and generally known. It is sufficient, if the same invention has been previously known and put in actual use, however limited the use, or the knowledge of the invention, might have been.

THIS was an action on the case for the infringement of a patent-right. Bedford, in the year 1806, obtained a patent for a new and useful improvement in the making of boots, bootees, and shoes. He afterwards sold out to different individuals the right to use this patent in particular towns. The real plaintiff in this case was William Chadwick, [* 303] to *whom such a right had been sold by Bedford; and within whose limits the defendant had manufactured boots, &c., after the manner described in the pa-

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tent, and vended the same, without having purchased, either of the plaintiff or of Chadwick, the right so to do. The general issue was pleaded, and under it the defendant endeavored to prove, that the improvement, for which the patent was obtained, was not new; and produced evidence to show, that shoes of the same description had been made many years before.

It was also contended that the invention was not useful; but upon experience had been found not to answer the purpose expected, and that this mode of making boots and shoes had been of late much laid aside.

The case was argued by *Webster* and *Thurston* for the plaintiff, and by *Blake* and *Orne* for the defendants.

In the course of the argument, the following questions of law were made to the Court. 1st. What degree of usefulness in an invention or improvement the law required, in order to support a patent? 2dly. Into how general use a prior inventor must have introduced an invention or improvement, in order to render void the privileges of a subsequent patentee? On these points the jury were instructed, in the charge, as follows:

STORY, J. (after stating the facts.) No person is entitled to a patent under the Act of Congress, unless he has invented some new and useful art, machine, manufacture, or composition of matter, not known or used before.

By useful invention, in the statute, is meant such a one as may be applied to some beneficial use in society, in contradistinction to an invention, which is injurious to the morals, the health, or the good order of society. It is not necessary to establish, that the invention is of such general utility, as to supersede all other inventions now in practice to accomplish the same purpose. It is sufficient, * [* 304] that it has no noxious or mischievous tendency;

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that it may be applied to practical uses, and that so far as it is applied, it is salutary. If its practical utility be very limited, it will follow that it will be of little or no profit to the inventor; and if it be trifling, it will sink into utter neglect. The law, however, does not look to the degree of utility; it simply requires that it shall be capable of use, and that the use be such as sound morals and policy do not discountenance or prohibit. In the present case, there cannot be the slightest doubt, upon the evidence, that the patent is for a useful invention, in a very large sense.

It is not sufficient, however, that the invention is useful; it must also be new. The statute declares it a good defence to an action for the infringement of the patent-right that the thing secured by the patent was not originally discovered by the patentee, but had been in use, or had been described in some public work anterior to the supposed discovery of the patentee. The first inventor, who has put the invention in practice, and he only, is entitled to a patent. Every subsequent patentee, although an original inventor, may be defeated of his patent-right upon proof of such prior invention being put into use. The law in such case cannot give the whole patent-right to each inventor, even if each be equally entitled to the merit of being an original and independent inventor; and it therefore adopts the maxim, *qui prior est in tempore, potior est in jure*. And, to the present defendant, it is perfectly indifferent, whether the first inventor has taken out a patent, or has dedicated the invention to the public, or not; for he may stand upon the defence, that the plaintiff is not the first inventor who put the invention in use.

It has been argued by the plaintiff, that the defence set up by the statute does not apply, except in cases where the invention, or (as the statute expresses it) the thing originally discovered, has been before generally known, and
[* 305] in general use, among persons engaged in the art *

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or profession, to which it properly belongs. But I do not so understand the language of the statute. To entitle a person to a patent as a first inventor, it is certainly not necessary for him to establish that he has put his invention into general use, or that he has made it generally known to artisans engaged in the same business. And yet, upon the argument we are considering, unless it were so generally known and in use, he would be defeated by a patentee, who was a subsequent independent inventor.

The intent of the statute was to guard against defeating patents by the setting up of a prior invention, which had never been reduced to practice. If it were the mere speculation of a philosopher or a mechanic, which had never been tried by the test of experience, and never put into actual operation by him, the law would not deprive a subsequent inventor, who had employed his labor and his talents in putting it into practice, of the reward due to his ingenuity and enterprise. But if the first inventor reduced his theory to practice, and put his machine or other invention into use, the law never could intend, that the greater or less use, in which it might be, or the more or less widely the knowledge of its existence might circulate, should constitute the criterion by which to decide upon the validity of any subsequent patent for the same invention. I hold it, therefore, to be the true interpretation of this part of the statute, that any patent may be defeated by showing, that the thing secured by the patent had been discovered and put in actual use prior to the discovery of the patentee, however limited the use or the knowledge of the prior discovery might have been. And in the present case, I have little difficulty in holding, that the prior use is sufficiently established, if the testimony is believed; and that the only point of doubt is, as to the identity or diversity of the inventions.

Verdict for the defendants.

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PETTIBONE v. DERRINGER.

[4 Wash. 215.]

An ambiguity in a patent and specification may be explained by the affidavit annexed to the specification.

Where a deposition taken *de bene esse*, is offered in evidence, the party who offers it must prove that he has used due diligence to procure the attendance of the witness.

It is no objection to reading the deposition of a witness taken under a rule of court, who lives in another State more than one hundred miles from the place of trial, that he had been in the city during the session of the court, the fact not being known to the party.

The letters of the plaintiff to the Secretary of State, containing applications for a patent, and specifications, certified under the seal of that department as papers remaining in that office, were properly admissible in evidence.

Depositions taken without a commissioner or rule of court, in the State of New York, more than one hundred miles from Philadelphia, but conforming in all respects to the thirtieth section of the Judiciary Act of 1789, may be read in evidence.

A deposition taken under the thirtieth section of the Judiciary Act of 1789, cannot be read in evidence, unless the judge certifies that it was reduced to writing, either by himself, or by the witness in *his* presence.

THIS was an action on the case for an infringement of the plaintiff's patent for "a new and useful improvement in boring muskets, pistols, and rifles, by an auger called the spiral groove, or twisted screw auger."

The specification states that this auger consists in the manner of making it, or the particular form or construction of the same, as also the mode of application. It then proceeds to state the way in which the auger is made, and that the difference in the form of this improved auger from the common screw auger used for wood is, that the point or cutter is next to the shank, and the auger is less twisted. That the shank is long enough to put through the barrel and fasten to the socket, and the machine that moves or turns the auger. The auger revolves about once per second, and the points or

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cutters are pressed against the iron that is to be bored from the inside of the barrel, by the force or application of one or more endless screws that revolve in a rack of cogs attached to the carriage, on which the barrels are fastened.

The affidavit annexed to the specification states, that the patentee verily believes himself to be the first inventor of the improved method of making augers or bits, for boring muskets, pistols, and rifle barrels, as above specified and described.

The defendant's plea was the general issue, and he gave notice to the plaintiff, that "he should give in evidence the following matter to prove that the thing secured by patent was not originally discovered *by the [*216] plaintiff, but had been in use anterior to the supposed discovery, or that he had surreptitiously obtained a patent for the discovery of another person." The notice then proceeds to state the persons by whom the screw auger and the mode of application had been discovered, and the places where they had been used anterior to the plaintiff's discovery.

The plaintiff gave in evidence a letter from himself to the Secretary of State, dated the 21st of January, 1799, and annexed a specification of an improvement in boring muskets, &c., agreeing in every material circumstance with that annexed to his present patent, except that he states the auger used to be one called the nut bit, invented by M'Cormick. In this letter he claims to be the inventor of the improvement, and claims a patent for the same.

He also gave in evidence a similar application to the Secretary of State, dated the 12th of August, 1799, accompanied by a similar specification, except that he speaks of and describes the twisted auger as his invention.

Both specifications were accompanied by the usual affidavits.

The tendency of the plaintiff's testimony was to prove that

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he was the first inventor of the twisted auger for boring musket, pistol, and rifle barrels; that he was also the inventor of the mode of *drawing*, instead of *pushing* the auger through the barrel; and of the application of the endless screws to produce that effect; and also of the superiority of the plaintiff's invention to former modes of boring gun-barrels.

The defendant examined a number of witnesses to prove that the plaintiff was not the inventor of the twisted screw auger, nor of the mode of *drawing* the auger through the barrel, but that both had been invented and used before the plaintiff pretended to have invented either; also, that the difference between M'Cormick's auger, which the plaintiff acknowledged to have been in use before January, 1799, and the screw auger of which he claimed to be the inventor in August, 1799, was not in principle, but in form only. Also, that M'Cormick's auger was preferable to the plaintiff's, and was more generally in use in the public gun manufactories.

CHARGE. WASHINGTON, J. The first question is, what is the discovery for which the plaintiff has obtained a patent? He contends that it is for the twisted auger, *made, formed, and used, in the manner set forth in the specification*. The defendant insists that it is confined to the *twisted auger*, and to no more. These cases are always embarrassing, because the originality of the patentee's discovery is almost always in issue, which involves not only the construction of the patent, taken in connection with the specification, which forms a part of it, but also a comparison between the invention for which the patent is granted, and that which is asserted to have been made prior to it. Both of these difficulties occur in the present case.

[* 217] * The patent recites, that the applicant had repre-

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sented himself to be the inventor of a new and useful improvement in boring muskets, &c., by an auger called the spiral groove, or twisted screw auger. These expressions are perfectly equivocal, and may apply as well to an auger constructed for boring muskets, confining the improvement to the auger alone, or to that instrument, and the particular manner of using it, afterwards pointed out in the specification.

This latter instrument describes the manner of making the auger, its form, and how it may be used. But taken in connection with the patent, it does not necessarily follow that the manner of using the machine forms a part of the discovery; because, if the plaintiff was in fact the inventor of the auger only, and meant to claim no more, it was still proper that he should, under the requisitions of the third section of the law, describe in his specification the manner of using the auger, with the principle and several modes in which the application of that principle was contemplated by the inventor. Whether the want of an affidavit will avoid the patent, or will in all cases confine the patent to the invention stated in it, as the defendant's counsel have contended, are questions which need not be decided in this cause. But there can be no doubt, that where the construction of the patent and specification, as to the subject of the grant, is doubtful; the affidavit, if more precise, may be resorted to to explain the ambiguity. It would seem to be particularly proper to do so for restraining general expressions in the specification; as the oath required to be taken by the Act of Congress is, that the inventor does verily believe that he is the true inventor of the art, machine, or improvement for which he solicits a patent.

These observations are strikingly applicable to this patent, which, as explained by the specification, contains no specific assertion that the plaintiff was the inventor of the peculiar manner of using the auger as described in the latter instrument, and the affidavit confines the invention to the improved

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method of *making augers* or bits, for boring musket barrels, &c., "*as above specified and described.*"

These latter expressions obviously refer to *the method of making augers* for boring muskets, which is distinctly described in the specification, and not "*to the manner of using the auger,*" which, though described, has nothing to do with the method of making it.

In the case of *Evans v. Eaton*, the Supreme Court construed the patent to amount to a grant to Evans, not only of an exclusive right to the entire improvement in the manufacture of flour, but to the improvement in the separate instruments employed in producing the general result. But this construction was formed upon the supposed intention of the parties to the patent, drawn not only from certain expressions in the specification, and also in the affidavit, but from the private Act of Congress, passed for the relief of Oliver Evans. In the specification, the patentee, after describing the hopper-boy, the particular machine in controversy, and the other four machines employed in the manufacture of flour, [* 218] adds, that "he *claims, as his invention, the peculiar properties or principles which this machine (the hopper-boy) possesses, of spreading, turning, and gathering the meal at one operation ; and the affidavit states, " that he verily believes he is the true and original inventor of the *improvements* herein above specified, for which he solicits a patent."

Upon the whole, we are of opinion that the plaintiff's patent extends only to the auger described in the specification, and not to the method of using it.

2. The next question is, was the plaintiff the inventor of this instrument, as described in the specification ?

We have the authority of the plaintiff himself for saying that he made the discovery of that instrument in August, 1799 ; because, in his application to the State department on

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the 12th of that month, he so alleges the fact. It appears by a letter from Mr. Ames, the manager of the Springfield works, dated in September, 1799, that he had just received from the plaintiff one of these augers, and in that letter he gives to the plaintiff the merit of the discovery. Three witnesses, one of whom is this Mr. Ames, have sworn, that this auger was introduced at the Springfield works by a Mr. Holmes, about six months prior to the period when a similar one was sent there by the plaintiff. That it was much approved of, and that Holmes not only claimed but was considered at that place to be the inventor. If this evidence is believed by the jury, it is conclusive against the plaintiff. But if the jury should be of a different opinion, then, the next question will be, was the plaintiff entitled to a patent for his improvement? or, in other words, is the twisted auger, of which he claims to be the inventor, an improvement in the principle, or merely a change in the form and proportions of the auger used for boring gunbarrels prior to August, 1799?

That the auger, styled the nut bit, called M'Cormick's, was in use previous to the year 1799, was acknowledged by the plaintiff in his application to the State department in January, 1799, and was the auger which the plaintiff then contemplated using. This fact is corroborated by the testimony of three witnesses, who state that M'Cormick's auger was used at the Springfield works in 1797 and 1798, and was *drawn*, not *pushed*, through the barrel. Two other witnesses have stated that it was so used at M'Cormick's works, in the summer or autumn of 1798, and a sixth witness declares that it was so used at a still earlier period at Brian's works.

On the other side, there are two witnesses who state that the method of drawing the auger through the barrel was not known or practised until the discovery was made by the plaintiff. If the defendant's witnesses are believed, then the plaintiff is deprived, not only of the merit of having invented

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the twisted screw auger, but the manner of using it, by drawing instead of forcing it through the barrel; and then nothing will remain to the plaintiff, of all that he has stated in his specification, but the application of the endless screw to move the carriage on which the barrel is placed, instead [* 219] of *the long screw, or the lever, or weights, which were used by M'Cormick.

M'Cormick's auger or nut bit, as it is called, is made by filing out the grooves from a round solid piece of steel, having the cutters towards the shaft, and is drawn through the barrel. The twisted auger claimed by the plaintiff is made by twisting a plate of steel, so as to form the grooves, having the cutters next the shaft, and it is drawn through the barrel. That the twisted auger is a great improvement on the *old method* of boring gunbarrels is undoubted; but whether it is so of M'Comick's auger, you will judge from the evidence. The question for your determination is, whether it is an improvement on the principle of M'Cormick's auger, or whether it is merely a change in the form or proportions of that auger. If only the latter, then it was not such an improvement as the plaintiff was entitled to secure to himself by a patent.

The last question is, whether the defendant has invaded the plaintiff's patent? This you must decide upon the evidence.

[The following questions upon evidence were decided upon the trial.

1. That where a deposition taken *de bene esse* is offered in evidence, the party offering it must prove that he had used due diligence to procure the attendance of the witness, and particularly that he had made inquiries at the last place of abode of the witness, in order to have him served with a subpoena.

2. That it is no objection to reading the deposition of a

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witness who lives in another State, more than one hundred miles from the city, taken under a rule of this court, that he had been in Philadelphia during the sitting of this court, where it appeared that the fact of the witness being in the city was unknown to the party at whose instance the deposition was taken. Whether, if the party had known that the witness was in the city, the case would have been altered, was not decided.

3. That the letters of the plaintiff to the Secretary of State of the 31st January and 12th August, 1799, containing applications for a patent, and specifications certified under the seal of that department, as papers remaining in that office, were properly admissible in evidence. See 2 Bioren, 52.

4. That depositions taken without a commission, or rule of court, in the State of New York, more than one hundred miles from Philadelphia, but conforming in all respects to the thirtieth section of the Judicial Act of the 24th September, 1789, might be read in evidence.

5. That a deposition taken under the thirtieth section of the judicial act cannot be read, unless the judge certifies that it was reduced to writing, either by himself, or by the witness *in his presence.*]

CUTTING AND OTHERS, EXECUTORS OF FULTON, v. MYERS.

[4 Wash. 220.]

The declaration in a patent cause need not state that the stages preliminary to the issuing of a patent were observed.

What is required to be stated in such a declaration.

The declaration must set forth the attestation of the President of the United States, and that the patent was delivered; and the want of a statement of either is a cause for general demurrer.

It is no cause of demurrer to such a declaration that neither the patent, nor the declaration states in what the improvement consists. If the defendant wants the specification inserted on the record, he must crave oyer of it.

In what manner and form the breach in actions on patents must be laid.

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WASHINGTON, J. This is an action for the infringement of a patent-right. The declaration contains four counts, to two of which, namely, the second and fourth, the defendant has filed special demurrers. The decision upon either of the counts will decide the fate of the other. The second count states, that by certain letters-patent, made out in due form of law, under the seal and in the name of the United States, dated, &c., which said letters-patent the plaintiffs bring into court, whose date, &c., there was granted to the said Robert Fulton, his heirs, &c., for the term of fourteen years from the said date, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, a new and useful improvement in steamboats; he, the said Robert, being a citizen of the United States, and the true and original inventor of the said improvement, &c. The demurrer states for cause, that it is not stated, nor alleged, nor does it appear by the said count, in what the said new and useful improvement in steamboats consisted, and that the said count is altogether vague, &c.

The objections made by the defendant's counsel to this count, are, 1. That it does not sufficiently state that all the steps which the inventor is required by the act of congress to take to entitle him to a patent were observed; that is to say, that a petition was presented to the Secretary of State; that the attorney-general's certificate as to the form of the patent was obtained; that the patent was signed by the President; or that the conditions prescribed in the third section of the law were complied with.

In support of this objection it is contended, that the declaration ought to show a title in the plaintiff, and that every thing which is of the essence of the action, was performed by the patentee. That a performance of all the acts required by the first and third sections of the law, are of the essence of the plaintiff's title, and therefore ought to have been precisely averred.

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* The validity of this argument will be best [* 221] tested by an attention to the first and third sections of the Act of Congress of the 21st of February, 1793.

These sections describe, 1. Who is entitled to the exclusive property in any new and useful art, machine, manufacture, or composition of matter. 2. They prescribe what shall be the essential parts of the instrument granting such property. And lastly, what the petitioner must do before he can receive a patent.

As to the first, to entitle any person to this exclusive right, he must be the inventor of the thing in which he claims an exclusive property, and must allege himself to be such.

As to the second, the letters-patent must be made out in the name, and under the seal of the United States, and bear *teste* by the President of the United States, reciting the allegations and suggestions of the petition, giving a short description of the invention, and granting to the petitioner, for a certain term, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention.

Lastly, to entitle the inventor to receive this patent, he is required to present a petition to the Secretary of State, signifying his desire to obtain an exclusive property in his invention, and praying that a patent may be granted therefor. He is also required to swear or affirm that he is the true inventor or discoverer of the art, machine, or improvement, for which he solicits a patent, and further, to make a full disclosure of his invention in the manner prescribed in the third section of the act.

The principle contended for by the defendant's counsel, that the declaration must show a title in the plaintiff, is incontrovertible. But on what does the title of the plaintiff to the exclusive property of an invention rest? The answer is, on a grant of such exclusive property by the United States; and

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if the declaration avers that such grant, in the form prescribed by law, was issued, it shows the very title on which the action is founded, and on which, *prima facie*, the plaintiff is entitled to recover. It is not necessary for him to aver that those preliminary steps were taken, without which a valid grant could not issue, because the Court will presume in favor of the grant, that every thing was rightly and solemnly done which the law required, in order to authorize the issuing of the grant. If the pre-requisites to the issuing of the grant were not observed, then the allegation in the declaration, that the patent granted to R. F. the full and exclusive right and liberty of making, &c., his improvement, is not true.

As well might it be contended, that in pleading a grant of land, it is necessary to aver the entry, survey, and all the other steps required by law to be taken before a valid grant can issue. They are *prima facie* implied in the allegation that the grant was duly made in the manner prescribed by law.

But the Court is of opinion, that within these [* 222] principles there are * two objections to these counts which are fatal, and which the defendant is entitled to the benefit of, upon a general demurrer.

The first is, that they contain no allegation that a patent did issue to R. F.; or secondly, that it was tested by the President.

As to the first, the allegation is, that a patent was *made out* in due form of law under the seal, and in the name of the United States, by which there was granted to the said R. F., &c. But the law proceeds to declare that the patent so made out shall be *delivered* to the petitioner, and that *no person can receive it* until he has taken the oath, and made the disclosure prescribed in the third section of the act.

Now there is no allegation in these counts that the patent was more than made out, or that it was ever delivered to R.

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F., and consequently, there is nothing averred from which the Court can imply that those conditions were performed, without which R. F. was incapable of receiving a patent. The principle laid down and relied upon by the plaintiff's counsel, that necessary circumstances implied by law from what is expressed need not be expressed, does by no means impugn this argument; because nothing is expressed to authorize a presumption that the requisite conditions were complied with.

It has been contended that delivery is implied in the allegation that the patent was made out, containing a grant of the exclusive right; and the case of *Churchill v. Gardner*, 7 T. R. 596, is relied upon. But that was a case at common law, and the implication that the bill of exchange was *delivered*, arising out of the allegation that it was *made*, was perfectly natural and reasonable. But it is believed to be a clear principle of law, that if a statute requires certain acts to be performed before a statutory instrument can be delivered or take effect, the plaintiff must aver in his declaration, either the performance of those acts, or the fact of delivery from which such performance may be implied.

2. The plaintiff's title resting upon a patent from the United States, the form of which is prescribed by the Act of Congress, it certainly should be shown, by the declaration, that the patent in question was such as the law requires. Now the attestation of the President is rendered as necessary to the form and validity of this patent, as the affixing of the seal of the United States to it; and the signature of the President can no more be implied from the allegation that the patent was made out containing a grant of the privilege, than the seal could be implied from the allegation that a patent was made out containing the grant.

The certificate of the attorney-general forms no part of the patent, and may reasonably be implied from the allegations contained in the counts.

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The second objection made to the counts under consideration is, that the improvement for which the patent is alleged to have been granted is too loosely described in [*223] the patent itself, as set forth, to * entitle the plaintiff to a judgment. It is contended that it ought to have stated in what particulars the improvement consists.

An objection similar to the present, in all respects, was made to the declaration in the case of *Pray v. James*, and after the most mature consideration by the Court it was overruled. With that opinion the Court finds no reason to be dissatisfied.

The declaration in that case stated, that Jacob Perkins, having invented a new and useful improvement in the manner of manufacturing nails, &c., which had not been known or used before his application, &c. (and so averring a compliance with all the requisitions of the Act of Congress previous to obtaining a patent, and an assignment of his right to Guppy and Armstrong,) letters-patent were duly made out in the name of the United States, bearing *teste* by the President of the United States, reciting, &c., and giving a short description of the said invention, and granting to the said G. and A., &c., the full and exclusive right and liberty of making, &c., the said improvement, &c. The objection made to this declaration was, that the "et cætera" in the description of the discovery rendered the patent too vague, and ought to have been cured by stating in the declaration the material parts of the specification, so as to leave no doubt as to the particular discovery for which the patent was granted.

The Court laid down the general rule, that a declaration ought to show a title in the plaintiff, and that with convenient certainty; and should also state those matters that are of the essence of the action, without which the plaintiff shows no right in point of law to ask for a judgment: but that in that case, the plaintiff's right was founded on a patent which was

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accurately stated in the declaration, the *et cætera* forming a part of the former, which was designated in the declaration by the terms which itself uses. That though the specification was referred to in the patent as a part thereof, it was still merely descriptive of the invention — a matter of evidence to be used at the trial, and might have been spread upon the record by over if it was important for the defendant to see it. The Court was therefore of opinion, that the patent was described with sufficient certainty, even upon a demurrer.

In this case, and upon these pleadings, the Court must presume that the description of the thing granted is as broad as the patent itself, and in all respects corresponds with it; and upon the principle decided in the above case, we are of opinion that the plaintiffs were not bound to go farther, and to set out the specification, either verbatim, or substantially.

3. The last objection to this declaration is, that the breaches are laid too generally. The breach in substance is, that the defendants, without the leave or license, &c., did use the said improvement so invented by the said R. F., contrary to the form of the Acts of Congress, &c., and against the privileges so granted, &c.

The answers given by the plaintiff's counsel to this objection are entirely satisfactory to the Court. 1. The objection is to the form of the declaration, and no such cause is assigned by the demurrer. 2. The breach assigned is as broad as the right set forth in the declaration, and granted by the patent; and this the Court considers to be not only sufficient, but that it is the most correct manner of pleading in this case.

But for the reasons mentioned under the first head, the demurrer must be sustained.

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EVANS v. HETTICK.

[3 Wash. 408.]

Action for an infringement of the plaintiff's right to the *hopper-boy*, described in his patent.

Evidence was allowed, on the part of the plaintiff, of his declarations in a particular year, that he had discovered and constructed the machine patented, all the parts of which he described. This evidence was admitted to prove, not that the plaintiff was the discoverer, but that he then asserted such a right, and described the machine.

A witness who had in use such a machine as that used by the defendant, and who, with other persons sued in similar actions with the present, had contributed a common fund to defray the expenses of their witnesses in attending to the suits, was allowed to testify on the part of the defendant in this case. Between the contributors there was no agreement to participate in paying the damages or costs, which might be recovered against either of them in the actions. A verdict in this case, would not avoid the plaintiff's patent; and therefore, the witness had no interest in this case.

The counsel for the plaintiff cannot ask the witness if Jacob Stouffer had applied to the plaintiff for a license to use his *improved hopper-boy*, and had offered to pay for it; it not being proved that Jacob Stouffer had a *hopper-boy* of any kind, or had ever used one.

[*409] * The Court would not allow a witness to despose what he had heard said in the family of Stouffer, as to the *Stouffer hopper-boy*, being so called; it being merely hearsay evidence.

A deposition of a witness residing in this State, above one hundred miles from the place of holding the Court, taken under a rule entered by the plaintiff in the Clerk's Office, but not in conformity with the requisitions of the 30th section of the Judicial Act, cannot be read in evidence.

An examination of the law in relation to the taking of the depositions of witnesses, residing above one hundred miles from the place of holding the Court.

A deposition having been read without objection, cannot be afterwards rejected and withdrawn, because the Court, subsequently, refused to allow a deposition to be read, on account of an exception which would also have excluded the deposition which had been read, had it been objected to.

What questions can not be put to a witness called as rebutting evidence.

Interest in a witness, short of that which would exclude him on the ground of incompetency, how far it should weigh.

If the patent and specification do not state in what the improvement consists, in full, clear, and exact terms, where the patent has been granted

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for an improvement, the plaintiff cannot recover for an alleged violation of it.

Oliver Evans's patent for the improved hopper-boy, is not an exception from the general rule, either by force of the private Act, under which the patent was granted, or the decision of the Supreme Court, in the case of *Evans v. Eaton*.

Oliver Evans's patent is not for the whole hopper-boy,—whether he was the original inventor of it or not; nor does the opinion of the Supreme Court, in *Evans v. Eaton*, sanction such a claim.

Unless Oliver Evans shows himself to be the original inventor of the hopper-boy, he can claim no right in virtue of the grant made to him by the Act of Assembly of Pennsylvania, passed in 1787.

The plaintiff cannot object to the originality or priority and use of another machine, alleged to have been similar to his own, on the ground that it had gone into disuse, or was not *notoriously* in use; since it is essential to his case, to prove he was the original inventor of the machine for which he has a patent.

ACTION for an infringement of the plaintiff's right to the hopper-boy, described in his patent. Plea, not guilty, and notice *of special matter, under the sixth section [*410] of the Act of Congress relative to patents. The evidence was the same as in the case of *Evans v. Eaton*, (1 Peters's Rep. 322,) save that David Aby, one of the defendant's witnesses, said the hopper-boy used by the defendant was the *Stouffer hopper-boy*.

The following exceptions were taken to the evidence:—

1. By the counsel for the defendant, who objected to those parts of the deposition of Enoch Anderson, in which he states, "what the plaintiff told him in the year 1783, relative to a discovery, which he contemplated, and was bringing to perfection, for an improvement in the manufacture of flour; in which conversation, he described the different machines for effecting that purpose, and amongst others the hopper-boy."

BY THE COURT. Although the information respecting this discovery came from the plaintiff, it is nevertheless *a fact*, that the disclosure was made at a particular period, and the evi-

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dence to prove that fact is unexceptionable. The question is, when was the discovery made? If the plaintiff told the witness, in 1783, that he had made it, and described it, which the witness says he did, then it is clear that he made it at that time, or at least supposed he had done so. This is all that it proves. It does not prove that he was the discoverer, but that he said he was so, *at that time*.

2. David Aby was called as a witness by the defendant, who, it was admitted, used a hopper-boy similar to that for the use of which, by the defendant, this suit was brought. Upon his examination, on his *voir dire*, he stated, that he, together with six other persons, defendants in suits now depending in this Court for infringements of the patent on which this action was brought, agreed to contribute a fund, to defray the expenses of this witness in coming to Philadelphia, remaining here, attending to the business of these suits, and returning; and that the agreement extended no further. That all the counsel fees had been paid; and there was no engagement to pay more; and the agreement did not extend to a [* 411] contribution to damages or costs, * either in the Circuit Court, or in the Supreme Court of the United States. If he should, while attending on the trial, advance money for any purpose besides his own personal expenses, the contributors were not bound by the agreement to reimburse him.

The witness was objected to by the counsel for the plaintiff, on the ground of incompetency. 1st. Because the tendency of his testimony was to disprove the originality of the plaintiff's invention of the hopper-boy, for which he has a patent; and consequently, to induce its avoidance by the judgment of the Court, of which the witness could avail himself when the trial of his own case should come on. 2d. Because the witness was a contributor to a general fund, for the expenses of this, as well as of his own suit; and stood in the

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condition of the insured, under a consolidation rule, or of a commoner.

The following cases were cited : — 1 Phil. Ev. 34, 43 – 4, 49, 50, 95 note, 53, 51 n. 45 – 6. n. 42 ; 5 Johns. 258 ; 1 Mass. Rep. 239 ; 1 Caines's Rep. 378 ; 2 Day, 472.

WASHINGTON, J., delivered the opinion of the Court. The plaintiff's claim is to an *improved* hopper-boy. If that which the defendant and the witness uses, be not that machine, there is no reason, in point of law, why the witness and the defendant may not each use the machine, which they have, without offence to the plaintiff. It is sufficient for the defendant, on the general issue, to prove that he is not guilty of using the plaintiff's improved hopper-boy ; although he should use some other machine called by that name, and possessing similar properties with those of the improved hopper-boy ; and a verdict in his favor, upon that issue, can in no respect produce the destruction of the patent ; because the originality of the invention is not in issue on the plea of not guilty ; consequently, the witness, who owns a hopper-boy similar to the defendant's, may have his wishes, but he has no interest dependent upon the event of this cause.

* 2. The agreement, which is the foundation of [* 412] this objection, is for a contribution to a general fund to be used in defraying the expenses of this witness, as an agent to attend to the causes in which the contributors are defendants, and as a witness in these causes ; but the witness has distinctly stated, that the fund is not pledged, or intended to answer for damages, or costs, in this or in a superior Court ; and that the agreement in no respects binds the parties to it, to participate in any loss, which either or all of them may sustain ; or in any gain, which may result from a successful termination of the suit. Where then is the interest which can disqualify him as a witness ? It must be an interest in the

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event of the cause; so much money has already been contributed, and placed in the witness's hands, to defray his expenses. If it should exceed his wants, he will have to refund the overplus to the other contributors, retaining his own seventh part; and if, it should fall short of supplying his wants, his associates may be bound in honor, at least, to make up the deficiency; but the fund already raised, must be applied to the objects contemplated by the parties, whatever may be the event of this suit, not dependent on that event, *but in virtue of the agreement*. If the parties are bound by that agreement, to contribute a larger sum in order to defray the expenses of this witness, they must in like manner do so; not as a consequence of the event of this suit, one way or the other, but because the agreement has bound them to do so; and even if the witness had a power, under that agreement, to increase the fees of counsel, and to incur any other expense, on account of these suits, the legal result would be the same; because the creation of these charges upon the fund raised, or to be raised, and their discharge, would be precisely the same, whether the plaintiff or defendant should gain the cause. If the former should happen, the defendant would have to pay the plaintiff his costs; but for which, neither the fund raised, nor the other contracting parties, are bound to contribute one cent. If the latter should take place, [* 413] the defendant would recover his costs * of the plaintiff; in which the other parties to the contract, are not entitled, by the terms of it, to participate. So that it is plain that the witness has not a shadow of an interest *dependent on the event of the suit*; and he is therefore competent to give testimony.

The counsel for the plaintiff, tendered a bill of exceptions to this opinion.

3. The witness, David Aby, was asked, upon his examination in chief, by the defendant's counsel, if the hopper-boy

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used by the defendant, was like the model of the plaintiff's hopper-boy, then in Court? This was objected to; but the Court decided that the question was proper; and the counsel for the plaintiff took an exception to the opinion of the Court.

4. Philip Frederick, was examined on his *voir dire*; and stated that he has in his mill what is called a Stouffer, or S hopper-boy, which he described. He was also asked by the defendant's counsel, where was the first hopper-boy he had seen — both of these questions were objected to by the plaintiff's counsel; and the same objections to the competency of the witness was made, on a similar ground, as to Aby's; all of which objections were overruled, and the opinions of the Court were excepted to.

5. Joseph Evans was asked by the plaintiff's counsel, if Peter Stouffer and Jacob Stouffer, offered to take from him licenses to use the plaintiff's hopper-boy, and to pay for the same? This was objected to; and the Court was of opinion that the question was improper, as it had not been proved that Peter Stouffer and Jacob Stouffer used, or had in their mills, a hopper-boy of any kind; and the opinion of the Supreme Court, in the case of Evans v. Eaton, is confined to the case of an offer made by a person having a hopper-boy.

WASHINGTON, J., stated that he was not willing to go a step further than the Supreme Court had gone, in admitting such evidence. Upon the authority of Evans v. Eaton, we have admitted evidence of Daniel Huston's offer to purchase a license *from the plaintiff; because it ap- [*414] pears that he uses a hopper-boy, and did so when the offer was made. This being the opinion of the Court, an exception was taken to it by the plaintiff's counsel.

6. Christian Markle, was asked, by the plaintiff's counsel, to state what he had heard from the different members of the

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Stouffer family, as to the S hopper-boy being called the Stouffer hopper-boy.

The Court decided that this question was improper. The persons from whom the witness received information on this subject, ought to have been called on to give it on oath, and in a regular way. The attempt now is to introduce mere hearsay evidence, of what others told the witness as to the reputation of the name and invention of the machine.

7. Michael Former's deposition, taken under a rule entered by the plaintiff in the Clerk's Office, was offered by the plaintiff, and objected to, on the ground that the place of residence of the witness is in the District, and more than one hundred miles from Philadelphia; and the requisites of the 30th section of the Act of Congress, passed September 24th, 1789, not having been observed, neither did the case come within the provisions of any of the rules of the Court.

The counsel for the plaintiff, insisted, that the practice of the Court had always been contrary to what is contended for on the other side.

WASHINGTON, J. What has been the practice in relation to this matter, is unknown to the Court; it certainly has not received our sanction, by any one decision. If the practice be contrary to the Act of Congress, it ought to be, at once, put an end to. Even a positive written rule of this Court, repugnant to that law, would be void.

The question is, whether, under the Act of Congress, and the rules of this Court consistent therewith, this deposition can be read; and this may be as fair an occasion as any that can occur, to examine and to decide this subject, [* 415] that the practice of taking * depositions in and without the District, may be laid down and pursued, so as to prevent future mistakes.

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By the Act of Congress of the 24th of September, 1789, section 30th, it is enacted, that "when the testimony of any person shall be necessary, in any civil cause depending in any district in any Court of the United States, who shall live at a greater distance from the place of trial than one hundred miles, or is bound on a voyage to sea, or is about to go out of the United States, or out of such district, and to a greater distance from the place of trial than as aforesaid, before the time of trial, or is ancient or very infirm, the deposition of such person may be taken, *de bene esse*, before any Justice or Judge of the Courts of the United States, or before any Chancellor, Justice, or Judge of a supreme or superior Court, mayor, or chief magistrate of a city, or Judge of a county Court, or Court of Common Pleas, of any of the United States, not being of counsel, or attorney to either of the parties, or interested in the event of the cause; provided that a notification from the magistrate before whom the deposition is to be taken, to the adverse party, to be present at the taking of the same, and to put interrogatories, if he think fit, be first made out and served on the adverse party or his attorney, as either may be nearest, if he is within one hundred miles of the place of such caption, allowing time for their attendance, after notification, not less than at the rate of one day, Sundays exclusive, for every twenty miles' travel. And in causes of admiralty and maritime jurisdiction, or other cases of seizure, when a libel shall be filed, in which an adverse party is not named, and depositions of persons circumstanced as aforesaid, shall be taken before the claim be put in, the like notification as aforesaid, shall be given to the person having the agency or possession of the property libelled, at the time of the capture or seizure of the same, if known to the libellant. And every person deposing as aforesaid, shall be carefully examined and cautioned, and sworn or affirmed to testify the whole truth; and shall subscribe the testimony, by him or her

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[*416] given, * after the same shall be reduced to writing, which shall be done only by the magistrate taking the deposition, or by the deponent, in his presence. And the depositions, so taken, shall be retained by such magistrate, until he deliver the same, with his own hand, to the Court for which they are taken, or shall, together with the certificate of the reasons, as aforesaid, of their being taken, and of the notice, if any given, to the adverse party, be by him, the said magistrate, sealed up and directed to such Court, and remain under his seal until opened in Court.”

The rules of Court applicable to the matter, were framed at different times by this Court, for the purpose of regulating its practice. The first bears date on the 23d of May, 1805, and provides that a party may take depositions of witnesses, being within one hundred miles of the place of holding the Court, by entering a rule in the Clerk’s Office, giving a reasonable notice, which in no case need exceed ten days, to the adverse party, if living within one hundred miles; otherwise to him or to his attorney, of the time and place of taking such depositions; and the deposition is to be forthwith filed, and is to be considered as taken *de bene esse*.¹

The next rule, relating to this subject, was made on the 13th of May, 1814; and declares, “that a rule to take depositions on notice given, shall be confined to taking them within

April Session, 1805, May 23d.

¹ ORDERED — That a rule for a commission to any of the United States, or to foreign parts, shall be, of course, and may be, entered by either party in the Clerk’s Office; but the interrogatories must be filed in the Clerk’s Office at the time; a copy thereof, and written notice of the rule and of the names of the commissioners, must be served on the adverse party, at least fifteen days before the commission issues, in order that he may file cross interrogatories, or nominate commissioners on his own part, if he shall deem it eligible.

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the district, unless otherwise agreed ; and if taken by agreement, out of the district, the description of judicial character, before whom it is agreed to be taken, shall be designated in the rule ; and all depositions are to be considered as taken *de bene esse*, *if the place of caption [* 417] be within the reach of the process of the Court.¹

The Act of Congress must necessarily be so construed, as to confine its operation to depositions taken *within the district* where the witness lives, *more than one hundred miles* from the place of trial ; because the process, to compel the attendance of witnesses, could run to any greater distance *within the district* ; and on that account, the deposition is to be *de bene esse*. But a subpoena could not, at that time, run into another district. The Act which declared that such process for witnesses to attend in one district, might run into any other district, provided, that in civil cases, the witnesses do not live more than one hundred miles from the place of holding the Court, did not pass into a law, until the 2d of March, 1792.

But this Act, it is conceived, could not affect the construction of that of September, 1789, before mentioned ; because, otherwise, this absurdity would follow, that a deposition, *taken de bene esse*, might be taken of a witness living in another State, at any distance from the Court, or even beyond seas ; because, they would live, within the words of the law, more than one hundred miles from the place of trial. Besides,

April Session, 1814, May 13th.

¹ ORDERED — That a rule to take depositions in any cause, or notice given, be confined to taking such depositions within the District, unless otherwise specially agreed. And if taken by agreement, out of the District, the description of the judicial character, before such depositions shall be agreed to be taken, shall be designated in such rule. All depositions to be considered as taken *de bene esse*, if the place of caption be within the reach of the process of this Court.

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it would have been something like a legal solecism in the Act of 1789, to declare a deposition taken out of the district, to be *de bene esse*, when the party had no means to compel the attendance of the witness.

The Act of 1789, being confined to depositions of witnesses living within the district, but beyond one hundred [* 418] miles from * the place of trial, the rules above noticed were framed in order to provide for cases not within the law ; that is, where the witness lives within the distance of one hundred miles from the place of trial ; and whether *within* or *without* the district, or in the words of the rule, " within the reach of the process of the Court."

These depositions may be taken on rules entered during the session of the Court, or in the Clerk's Office, in vacation. But in either case, unless the rule specify that the deposition is to be taken without the district, it is to be confined to witnesses living within it ; and such special rule, to extend to witnesses out of the district, must be made by agreement of the parties ; and the character of the person taking it must be designated in the rule ; and all such depositions are to be *de bene esse*. This opinion is not to be construed to exclude cases of depositions taken differently from what the law or rules prescribe, under the agreement of the parties, or any special rule of the Court, in any particular case.

Under either rule, reasonable notice of the time and place of taking the depositions, must be served on the adverse party, if living within one hundred miles ; otherwise, upon him or his attorney ; not only because this is reasonable and consistent with the spirit of the law, but because it is required by the rule of the 23d May, 1805.

Where witnesses live *out* of the district, and more than one hundred miles from the place of trial, their depositions, if taken, must be under a commission, and will, of course, be

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absolute. Although the point now in controversy relates only to depositions taken without commissions, it may not be improper, in this place, to record two other rules of the Court upon the subject, in order that the whole may be brought into one view.

The rule of the 23d May, 1805, provides, that "a rule for a commission to any of the United States, or foreign parts, shall be of course, and may be entered, by either party, in the Clerk's Office. But the interrogatories must be filed in the office at * the time; a copy thereof, and [* 419] written notice of the rule, and of the names of the commissioners, to be served on the adverse party, fifteen days, at least, before the commission issues, in order that he may file cross interrogatories, and name commissioners on his part, if he pleases."

The rule of the 27th April, 1811, declares, "that a copy of the interrogatories, and written notice of the rule to issue a commission, and of the names of the commissioners, may be served either on the adverse party, or his attorney."

8. As soon as the opinion on the last point was delivered, the plaintiff's counsel moved the Court to reject the deposition which had been read in evidence by the defendant's counsel, in the course of the trial, on the ground that this witness resided in Pennsylvania, more than one hundred miles from this city.

BY THE COURT. The deposition was read in evidence, without objection; and it is now too late to make an objection to it. To this opinion an exception was taken, by the counsel for the plaintiff.

9. Philip Frederick, who was called by the defendant, to rebut what Joseph Evans, one of the plaintiff's witnesses, who had been examined to rebut the defendant's testimony, relative to an application, deposed by Joseph Evans to have been made to him by Frederick, to purchase a license from the plaintiff,

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was asked by the plaintiff's counsel, on his cross-examination, "if Daniel Stouffer (one of the defendant's witnesses) was subject to fits of mental derangement?"

This was objected to and overruled by the Court, as improper to be asked in this stage of the cause. If allowed, the whole case might be opened to a new examination of the witnesses, to draw forth testimony which might have been obtained on the primary examination of the witnesses. The question, the Court observed, is not warranted by any thing which has fallen from the witnesses since the defendant closed his testimony, a part of which was Daniel Stouffer's deposition.

[* 420] * Ingersoll, Rawle, and C. J. Ingersoll, for the plaintiff, continued, —

1st. That the plaintiff's rights under his patent, are to the machine called the hopper-boy, and also to his improvements on that machine; and that these rights have received the sanction of the Supreme Court, in the case of *Evans v. Eaton*. 3 Wheaton, 517. Consequently, that if the jury should be of opinion that the plaintiff's improvement on the hopper-boy has not been used by the defendant, still the plaintiff is entitled to a verdict, if the jury should be of opinion that the defendant has used the plaintiff's hopper-boy, without his improvement.

2d. That, upon the evidence, it does not appear that what is called the *Stouffer hopper-boy* was discovered and used before the plaintiff's discovery in 1783; and that, in fact, it is only an humble imitation of the plaintiff's invention, though the same in principle; and although the jury should, upon the evidence, be of opinion that the *Stouffer hopper-boy* was invented, and even in use in one or two mills, still this would not be such a use as the law intends, not being public, and generally known to be in use, so as to charge the plaintiff with notice of it; and that this was the kind of notoriety which

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attended this hopper-boy, is evident, from the circumstance that it was never heard of by the many witnesses produced by the plaintiff, some of whom had travelled through the State before and since 1783.

3d. That the effect of the Act of the Assembly of Pennsylvania, granting to the plaintiff an exclusive right to his hopper-boy, amounted to a grant of the hopper-boy then in existence, (should the jury believe, that the Stouffer hopper-boy was in existence and use prior to the plaintiff's discovery,) the same being then the property of the public; it being competent to the legislature to make such a grant.

4th. That the Stouffer hopper-boy, if invented and used prior to the plaintiff's discovery, fell into disuse; and if the jury should be of that opinion, then a prior discovery and use of that *hopper-boy will present no [* 421] objection to the plaintiff's patent, as an original discoverer.

5th. That though the jury should be of opinion that the plaintiff is not the original inventor of the hopper-boy, still the defendant would not be entitled to a verdict. The defendant's counsel relied upon the opinion of the Supreme Court in *Evans v. Eaton*, 3 Wheaton, 519, which states that there is error in the charge of this Court in saying, "that the said Oliver Evans was not entitled to recover for the hopper-boy in his declaration."

Binney, Sergeant, and Joseph R. Ingersoll, for the defendant, contended: —

1. That the patent does not grant to the plaintiff any thing more than the general result of the combined power of the different machines, and the several improved machines, or, in other words, his improvements on these several machines; the Supreme Court having decided that these expressions import substantially the same thing. This construction has received

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the sanction of the Supreme Court, as appears from the whole course of the reasoning of the Chief Justice, in the case of *Evans v. Eaton*. This right to the improved hopper-boy is asserted by Mr. Harper, the plaintiff's counsel in that cause; and the claim to the hopper-boy itself is distinctly disavowed by him. A patent to the same person for an original invention, and also for an improvement on it, would be a legal absurdity, altogether inconsistent with the provisions of the Patent Laws. The petition and affirmation of Oliver Evans, confine his discovery and patent to his improved hopper-boy; and he could not obtain a patent broader than his petition and affirmation, filed in the Patent-Office.

2. If the rights of the plaintiff be those which his counsel contend for, still, in relation to his claim for a violation of his improved hopper-boy, he cannot have a verdict; because the nature of his improvement is not stated in his specification. No evidence has been given to the jury to prove what these improvements are, nor have the counsel pretended to [* 422] point them out. But it is essential to the validity of the patent that they should appear in the specification, as required by the 3d section of the Patent Law. The Supreme Court, in *Evans v. Eaton*, page 518, Wheaton's Rep. vol. 3, confirms this doctrine.

But even if the plaintiff had shown in what his improvements consist, he cannot recover against this defendant, since it is in evidence that he uses only the original Stouffer hopper-boy.

3. The plaintiff cannot recover as an original inventor of the Stouffer hopper-boy; the evidence proving, incontestably, that the Stouffer hopper-boy was discovered, and in use, — *in public use*, — though this is not required by the law, — in many mills, long prior to the year 1783, the earliest period of the plaintiff's invention contended for, even by himself.

4. There is no evidence that the Stouffer hopper-boy ever

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sunk into disuse ; but if that were proved, still it could not be patented by the plaintiff, as he could not swear that he was the first inventor.

WASHINGTON, J., charged the jury. After stating the evidence on both sides, the facts intended to be proved by the evidence given in this cause, may be arranged under the following heads : —

1. Such as respect the value of the plaintiff's hopper-boy.
2. The time of its discovery.
3. The kind of machine used by the defendant.
4. The time of its discovery and use.

First. As to the first, the Court has no observations to make, except that if you should find a verdict for the plaintiff, you will give the actual damages which the plaintiff has sustained, by reason of the defendant's use of his invention, which the Court will treble.

Second. The evidence applicable to this head, if believed by the jury, proves that, in 1783, Oliver Evans communicated his investigation of the subject of an improvement in the manufactory of flour ; and, in the summer of the same year, declared * he had accomplished it. In [*423] 1784, he made a model of his hopper-boy, which had no cords, weights, or pulley ; and, consequently, the lower arm was, for the sake of experiment, turned by the hand. In 1785, it was in operation in a mill, in as perfect a state as it now is.

Third. If the witness, who has been called to prove the kind of instrument used by the defendant, is believed by the jury, it consists of an upright square shaft, with a cog-wheel that turns it ; and which is moved by the water-power of the mill. This shaft is inserted into a square mortice in an arm or board, somewhat resembling an S, with strips of wood fixed on its under side ; and so arranged, as to turn

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the meal below it, cool, dry, and conduct it to the bolting chest. This arm slips with ease up and down the shaft, and must be raised by hand, and kept suspended, until the meal is put under it. It has no upper arm, pulley, weight, or leading lines; and the strips below the arm, are like the rake, as it is called, in the plaintiff's hopper-boy. The machine has acquired the name of the S, or Stouffer hopper-boy.

Fourth. The witnesses examined to prove the originality and the use of the defendant's hopper-boy, if believed by the jury, date them as early as the year 1765; and its erection and actual use, in many mills, in 1775-78, and progressively to later periods.

Objections have been made on each side, to the credit of some of the witnesses who have been examined on the other side; not on the ground of want of veracity, or character, but of interest short of that which can affect their competency. These objections have been pressed so far beyond their just limits, as to require from the Court an explanation of their real value. Where the evidence of witnesses, opposed by other witnesses, is relied upon by either side to prove a particular fact, the jury must necessarily weigh their credit, in order to satisfy their own minds, on which side the truth is most likely to be; and, in making this inquiry, every [* 424] circumstance, which can affect * the veracity of the witnesses, whether it concern their moral character or arise from some interest which they may have in the question; or from feelings and wishes favorable to one or other of the parties, should be taken into the calculation. But, if the fact in controversy may exist, without a violation of probability, and the proof is by witnesses exclusively on that side; there is nothing to put into the opposite scale, against which to weigh the credit of these witnesses; and, if the objection to their credit be worth any thing, it must be to the full extent

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of rejecting their testimony altogether, or else it is worth nothing. The jury cannot compromise the matter, or halt between two opinions. They must decide that the fact is so, or is not so; and if the latter, because of objections to the credit of the witnesses, it would amount to a confounding of the question of a competency and credibility; for the effect would be the same, whether the Court refused to permit the witness to testify, on the ground of incompetency, or the jury should reject the testimony when given on that of want of credibility. We have thought it proper to submit these general observations to the consideration of the jury.

We come now to the question of law which arises out of these facts, which is:—

What are *the things*, in which the plaintiff alleges, and has proved, an exclusive property, which he asserts the defendant has used, and which he denies?

The first claim is for an improved hopper-boy, which the plaintiff insists is granted by his patent, which has received the sanction of the Supreme Court, and which the defendant acknowledges. This, then, being conceded ground, the Court will proceed to examine it; and the inquiry in point of law will be, whether the plaintiff is entitled to a verdict, for an infringement of his patent, for an improved hopper-boy?

The objection stated by the defendant is, that the plaintiff has not set forth, in his specification, what are the improvements, of which he claims to be the inventor; so that a person * skilled in the art, may comprehend [* 425] distinctly in what they consist.

This objection is, in point of fact, fully supported; neither the specification, nor any other document connected with the patent, states, or even alludes to any specific improvement in the hopper-boy. Taking this as true, how stands the law?

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The 3d section of the Patent Law declares, "that before an inventor can receive a patent, he shall deliver a written description of his invention, in such full, clear, and exact terms, as to distinguish the same from all other things before known; and to enable a person skilled in the art, &c., of which it is a branch, to make and use the same."

What then is the plaintiff's invention, as asserted by the plaintiff, conceded by the defendant, and sanctioned by the Supreme Court, in the case of *Evans v. Eaton*? The answer is, an improvement on the hopper-boy, or an improved hopper-boy, which that Court have declared to be substantially the same. If this be so, then the section of the law, before-mentioned, has declared that he must specify this improvement, in full, clear, and exact terms. If he has not done so, he has no valid patent on which he can recover.

The English decisions correspond with the injunctions of our law. The American decisions, so far as we have any report of them, maintain the same doctrine. Mr. Justice Story, in the case of *Lovel v. Lewis*, lays it down, that "if the patent be for an *improvement* in an existing machine, the patentee must, in his specification, distinguish the new from the old, and confine his patent to such parts only as are new; for, if both are mixed together, and a patent is taken for the whole, it is void."

What is the reason for all this?

In the first place, it is to enable the public to enjoy the full benefit of the discovery, when the patentee's monopoly is expired, by having it so described upon record, that any person, skilled in the art of which the invention is a branch, may be able to construct it.

[* 426 * The next reason is, to put every citizen upon his guard, that he may not through ignorance violate the law, by infringing the rights of the patentee, and subjecting himself to the consequences of litigation. The inventor

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of the original machine, if he has obtained a patent for it, and all persons claiming under him, may lawfully enjoy the full benefit of that discovery, notwithstanding the improvement made upon it by a subsequent discoverer. If he has not chosen to ask for a monopoly, but abandons it to the public, then it becomes public property, and any person has a right to use it. The inventor of the improvement may also obtain a patent for his discovery, which cannot legally be invaded by the inventor of the original machine, or by any other person. The rights of each are secured by law, and there is no incompatibility between them.

But if a man, wishing to use the original invention, and honestly disposed to avoid an infraction of the improver's right, is unable to ascertain from any certain and known standard, where the original invention ends, and where the improvement commences, how is it possible for him to exercise his own acknowledged right, freed from the danger of invading that of another? — and to what acts of oppression might not this lead? Might not the patentee of his mysterious improvement, obtain from the ignorant, the timid, and even the prudent members of society, who wish to use the original discovery, the price he chooses to ask for a license to use his improvement; and in this way compel them to purchase it, rather than incur expenses and inconveniences far greater than the sum demanded would pay for or compensate? If this may happen, then the improver enjoys in a degree the benefit of a discoverer, both of the original machine, and also of the improvement. In short, the patentee of the improvement may, to a certain extent, keep all others at arm's length as to the original invention, or make them pay him for it in derogation of the rights of the inventor of the original machine.

If this be the law applicable to cases in general,
is this an * excepted case? The plaintiff's coun- [* 427]

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sel have not directly asserted it to be so; but they have referred, with some emphasis, to what is said by the Supreme Court, in the case of *Evans v. Eaton*, 3 Wheaton's Reports, 518. The expressions are, "in all cases where the plaintiff's claim is for an improvement, it will be incumbent on him to show the extent of his improvement, so that a person understanding the subject, may comprehend distinctly in what it consists."

This decision does not state in what way the extent of the plaintiff's improvement is to be proved, nor did the case require that the Supreme Court should be more explicit. The obvious conclusion is, that the Court left that matter undecided, and meant that the extent of the plaintiff's improvement should be shown, *according to the rules of law*; a contrary construction would be most unfair, and unwarranted.

Is it possible to believe, that if the Supreme Court intended to decide contrary to the 3d section of the Patent Law, and to the English and American decisions, that this was a case without the influence of that law and those decisions, such intention would have been expressed in such guarded terms? This cannot be admitted. Neither can the private Act, for the relief of Oliver Evans, warrant the argument, that this case is freed from the restrictions contained in the 3d section of the Patent Law; because, except as to the extent of the grant it refers to; and the Supreme Court, in the case cited, considers it as within the provisions of that law, is it likely that the Supreme Court could have meant that the plaintiff might cure the defect of his specification, by proving to the jury in what his improvements consisted? If so, then, as to the present defendant, such an explanation would be unavailing, to save him from the consequences of an error, against which the sagacious wit of man could not have guarded him. He has sinned already, if he has invaded the plaintiff's right; and it is now too late to convince him of his error, if he must

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be a victim of it, for the want of that light which is now shed upon the act, long after his supposed transgression.

* But of what avail would this explanation be, [* 428] after the expiration of the plaintiff's monopoly? The parol evidence given in a court of justice, is evanescent, and affords the most unsafe notice of facts, particularly when they respect matters of art, that can be supposed.

What man, who wishes not to invade the plaintiff's patent, would venture to erect a hopper-boy, merely from the information which he could gather from this trial? He could obtain none upon which he could safely rely; nor could any artist, after the expiration of the plaintiff's right, be enabled from such a source to know how to construct this improvement.

But even if the extent of the improvement could be traced in this way, the plaintiff has not attempted to prove it; and what is more, his counsel, although repeatedly called on to point it out, have not attempted to do it.

Can the jury, without evidence, and without the aid of the plaintiff or his counsel, say in what these improvements consist? If they had never seen another hopper-boy, supposed to be the original, this would be impossible. If, having seen the Stouffer hopper-boy, they can do so, by comparing with it the plaintiff's improved hopper-boy, then the consequence seems to be almost inevitable, that the Stouffer hopper-boy is the original one, the point which, under the next head, is denied by the plaintiff. But if the specification had stated in what the plaintiff's improvement consisted, still he is not entitled to a verdict for a violation of that right, unless he has proved, to your satisfaction, that the plaintiff has infringed that right.

Upon the whole, this patent, so far as it is for an improvement, cannot be supported; and as to any claim founded on that right, the plaintiff is not entitled to your verdict.

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2d. The plaintiff contends, that he is the original inventor, not only of the improved hopper-boy, but of the whole machine; that his patent grants him the exclusive right to both, and that this claim has received the sanction of the Supreme Court.

Whether, in point of fact, he is the original inventor of the hopper-boy, will be attended to hereafter; neither [* 429] shall we stop * to inquire whether the plaintiff's patent grants him the right; because, if the Supreme Court has sanctioned the claim, that is law for this Court.

The part of the decision of that Court relied upon by the plaintiff's counsel, is to be found in page 517, 3 Wheaton's Reports, where the Chief Justice says, — "The opinion of the Court, then, is, that Oliver Evans may claim, under his patent, the exclusive use of his inventions and improvements in the art of manufacturing flour and meal, and in the several machines which he has invented, and in his improvements on machines previously discovered."

It would seem almost impossible to misunderstand this positive declaration of the Court. It appears to be the result of the previous reasoning. It states that the plaintiff may claim, 1. The exclusive use of his improvements and inventions in the art of manufacturing flour. 2. In the several machines which he has invented. 3. In his improvements on machines previously discovered. As to *the first*, there is no dispute in this cause. *The third* has been already disposed of. *The second* is now to be examined.

It is contended, by the defendant's counsel, that this is not the correct construction of this sentence in the decision of the Court, because it is inconsistent with the pretensions of the plaintiff's counsel, (see Mr. Harper's argument, 3 Wheaton's Rep. page 499,) and with the course of argument of the Chief Justice, throughout the opinion which led to the foregoing conclusion.

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This supposed inconsistency may, in the opinion of this Court, be explained by the following observations: The exceptions taken to the charge of this Court, in the case of *Evans v. Eaton*, were — 1st. He stating, that the patent of Oliver Evans was only for the combined effect of all the machines mentioned in his patent; and 2d. In directing the jury to find for the defendant, if they should be of opinion that the hopper-boy was in use prior to the improvement alleged to have been made by Oliver Evans.

* These were the only questions presented to the [*430] view of the Supreme Court, upon which it was deemed proper by that Court to give an opinion. The reasoning of the Chief Justice, therefore, is intended to prove and to correct these errors in the charge, by showing that Oliver Evans was entitled by his patent, and the accompanying documents, not only to the general result, but to an improvement on the hopper-boy, one of the machines used in combination to produce that result. If he had regard to an improvement on the hopper-boy, this Court was clearly wrong, in directing the jury to find a verdict for the defendant, if they should be of opinion, that the hopper-boy was in use prior to the plaintiff's improvement; because, it was unimportant who was the original discoverer of the hopper-boy, provided the plaintiff had a patent for an improved hopper-boy, and the defendant used that improvement; and the charge precluded that inquiry. But whilst the Judge aims to prove that Oliver Evans was entitled to this double claim, he does not exclude any other claim. There is one expression relied upon by the defendant's counsel as having this appearance; but it is more likely that the word relied on is a typographical error, than that the Court should both deny and affirm the plaintiff's right, as an original inventor of the hopper-boy.

When the Court came to state, definitively, what were the

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plaintiff's claims, under his patent, the whole are distinctly stated. The Act "for the relief of Oliver Evans," authorizes a grant to him of his improvement in the art of manufacturing flour, and in the several machines which he has invented, and in his improvements, &c.

The Court says, 3 Wheaton's Reports, page 508, that the application "is coextensive with the Act."

If, then, in this enumeration of the plaintiff's rights under the patent, that to the machines had been omitted, it might have been supposed that it was not recognized by that Court; and it was consequently introduced in order to prevent a conclusion against its validity, although it had not been [*431] brought *into view in the previous argument, because a matter not in dispute.

This course of reasoning is, we think, strongly fortified by what the Court says, 3 Wheaton's Rep. 518. "In all cases where his claim is for an improvement on a machine, it will be incumbent on him to show the extent of his improvement, so that a person understanding the subject, may comprehend distinctly in what it consists." Now, if his claim was confined to an improvement, produced by the combined operation of all the machines, and to an improvement in the separate machines, why should the Court have stated hypothetically what was to be proved, in case the plaintiff claimed for an improvement? This sentence, following immediately that which has been relied upon by the defendant's counsel, seems to explain it, and to fortify the construction which we have given to it.

Upon the whole, we are of opinion, that the question, who is the original inventor of the hopper-boy, is left open by the Supreme Court, and is now to be decided by this jury.

If, then, the jury should be of opinion, upon the evidence, that the hopper-boy which the defendant uses, was invented and in use prior to the discovery of Oliver Evans, then your verdict ought to be for the defendant.

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But to this instruction, there are objections which it is proper to notice. It is contended, that the judgment of the Supreme Court, in *Evans v. Eaton*, 3 Wheaton, page 119, where it is said that there is error in the proceedings below, in that, in the charge, the opinion is expressed that Oliver Evans is not entitled to recover, if the hopper-boy *in his declaration mentioned*, had been in use previous to his alleged discovery, entitles the plaintiff to a verdict; although the jury should be of opinion that he is not the original inventor of the hopper-boy.

That the Court did not mean this, is most obvious, from what is said in page 517, that "Oliver Evans may claim the exclusive use of the several machines, *which he has invented*;" could the Supreme Court intend to say, immediately after, that *he is entitled to a verdict for a machine [* 432] which he has not invented? Can it be supposed, that the Court meant to ride over the third section of the Patent Law, and set up a different rule to govern this case, without having stated the reasons for so extraordinary a distinction? This is altogether inadmissible.

Another reason may be urged against the conclusion drawn by the plaintiff's counsel, from the judgment, which is this: The error to be corrected by that part of the judgment relied on, that "the Court instructed the jury to find for the defendant, if they should be of opinion that the hopper-boy was in use prior to the invention of Oliver Evans's improvement." Now, the words "*in the declaration mentioned*," are not in the charge of the Circuit Court, as stated by the Chief Justice, which the Supreme Court proposes to condemn; and it is the insertion of these words into the judgment, which produces all the difficulty. Leave them out, and then the judgment is consistent with the whole reasoning of the Chief Justice, which condemned the charge of the Circuit Court; because it precluded Oliver Evans from obtaining a verdict

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for his *improvement*, if he was not the inventor of the elementary parts of the machine. Retain them, and it follows, that if Oliver Evans was proved not to be the inventor of the hopper-boy, in *his declaration mentioned*, still the defendant was not entitled to a verdict. This would be in such direct opposition to the 6th section of the Patent Law, that we cannot suppose this was the meaning of the Supreme Court.

2. The next objection to this instruction is, that the Act of the legislature of Pennsylvania conveyed to Oliver Evans the original hopper-boy ; and consequently, its existence and use, at a period prior to the plaintiff's discovery, cannot now be urged to invalidate his patent.

There are two conclusive answers to this argument — 1. That it is by no means to be admitted, that the Act operates to make such a transfer ; but 2. If it did, still the [* 433] plaintiff * cannot recover, if he appears not to be the first, or original inventor of the hopper-boy. This claim in this action is not derived either from the State, or from an individual. His suit is founded on his patent, and unless he was himself the original inventor of the hopper-boy, he cannot recover.

3. Another objection stated by the plaintiff's counsel is, that the Stouffer hopper-boy, although the jury should believe that it was in use in many mills, before the plaintiff's discovery had fallen into disuse ; and, therefore, it cannot be used to invalidate the plaintiff's right to recover.

The answer to this is, that whether it fell into disuse, or not, if it was used before the plaintiff's discovery, the plaintiff could not obtain a patent for it, so as to exclude the defendant from using it, if he chose to do so.

4. The last objection is, that the use of the Stouffer machine, cannot affect the plaintiff's patent, unless it was public, so as to affect the plaintiff, or other inventors with notice.

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Whether that hopper-boy was in public use, or not, the jury will judge, from the testimony of the witnesses. It was erected, and used in four or five mills, if the witnesses are believed, who have testified for the defendant on that point. But this argument has no foundation in the Act of Congress, which does not speak of public use, of the nature represented by the counsel. It is immaterial whether the patentee had notice of the prior invention, or not. If it was in use, in any part of the world, however unlikely or impossible that the fact should come to the knowledge of the patentee, his patent for the same machine cannot be supported.

Verdict for the defendant.

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[3 Wash. 443.]

Where the record of a judgment in the Circuit Court has been sent to the Supreme Court, and an appearance entered there, by the defendant in error, and a decision by the Supreme Court, reversing the judgment, and remanding the cause for a new trial, the defendant in error cannot object that the judgment, in this cause, is in force and unreversed, upon the ground that no writ of error had been sued out.

A witness, who uses a machine resembling that of the plaintiff's is not an incompetent witness for the defendant; because the patent of the plaintiff may be defective, as the Court cannot, in the case in which he is offered as a witness, declare the patent void, so as to benefit the witness; although in the case a verdict should be given for the defendant, on the ground that the plaintiff was not the original inventor of the machine.

If two machines be substantially the same, and operate in the same manner, to produce the same result, though they differ in form, proportions, and utility, they are the same in principle; and the one last discovered, can have no other merit than to be an improvement of the other; but for which the inventor can obtain no patent. If the improvement be in the principle, a patent may be obtained for the improvement.

To the validity of a patent for an improvement, it is necessary to state, in the specification, in what the improvement consists.

THIS cause came on to be retried, under the mandate of

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the Supreme Court of the United States, to award a *ven. fac. de novo*. See 3 Wheaton.

When the cause was called for trial, the defendant objected that the judgment of this Court, upon the former trial, was still in force and unreversed, as no writ of error had been sued out to remove the record of that judgment into the Supreme Court; without which that Court would not take jurisdiction of the cause.

By THE COURT. After an appearance of the defendant in error in the Supreme Court, and pleading, as it [* 444] must be presumed *he did, to entitle him to appear by counsel, and argue the cause, it is too late to take this objection. We must presume that all formal objections, and particularly one to the want of the writ, were waived by consent of parties. •

The jury being sworn, the competency of Philip Frederick, to give evidence for the defendant, was objected to by the plaintiff, on the ground that he uses a Stouffer hopper-boy; and that if the defendant should obtain a verdict, upon the ground of the use of the Stouffer hopper-boy by others, prior to the plaintiff's discovery, the Court must declare the patent void, and thus incapacitate the plaintiff to recover against the witness.

By THE COURT. This patent, according to the plaintiff's claim, covers eleven distinct things, and may be perfectly good for a part, though not so as to this particular machine. If, therefore, the jury should find for the defendant, on the ground that the hopper-boy was known and in use prior to the plaintiff's discovery, the Court could not declare the *whole patent* void, on account of the unsoundness of a part of it, in relation to a distinct machine; and we can find no authority for the judgment which has been hinted at — that is, to avoid the patent, *quoad* the hopper-boy.

It is only in this most extraordinary case, of one patent for

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a great number of different inventions, that this difficulty could occur. But we must say that, on that account, it must be exempt from that provision of the 6th section, as to the judgment, where the objection goes only to the prior use of one of the patented machines.

The deposition of Michael Former was offered, and objected to, for the reasons urged against it in the case of *Evans v. Hettick*. *Ante*, page 408.

The plaintiff's counsel examined the Clerk of the Court, to prove what the practice had been ; who states, that rules to take depositions generally, have frequently been entered in the office ; and depositions of witnesses living within the State, and * above one hundred miles from Phila- [* 445] delphia, have been taken ; that it has been rare, for twenty years past, to take depositions under the Act of Congress.

The Court rejected the evidence, for the reason assigned in *Hettick's* case.

The counsel for the plaintiff contended that, under his patent, he was entitled to claim, 1. The entire hopper-boy, which is protected by the judgment of the Supreme Court, in this very case, (3 Wheaton, 519) ; although it should appear that he was not the original inventor of it, which, however, they contended he was ; and that the defendant's witnesses, who had testified as to the prior use of the Stouffer hopper-boy, must be mistaken in their recollection of dates.

2. An improvement on a hopper-boy. That it is not necessary to the validity of such a patent, to describe in the specification in what the improvement consists, the 3d section of the law being, in this respect, merely directory to the Secretary of State, authorizing him to refuse a patent, if such a specification be not filed. But, however this may be in common cases, they insisted that the Supreme Court having decided that one of the plaintiff's claims, under his patent, is to

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an improvement on the hopper-boy, (3 Wheaton, 517,) the requisition, (p. 518,) that he should show the extent of his improvement, must necessarily mean that he should show it by parol evidence; since the Chief Justice having noticed, in the opinion, (p. 515,) that the specification does not distinguish the improvement from the original machine, the Court would never have sent the cause to another trial, upon the plaintiff's claim to an improvement, if the specification was deemed too defective to authorize his recovery.

WASHINGTON, J., charged the jury. This is an action for an infringement of the plaintiff's patent, which the plaintiff alleges to be, —

[* 446] 1. * For the whole of the machine employed in the manufacture of flour, called the hopper-boy.

2. For an improvement on the hopper-boy.

The question is, is the plaintiff entitled to recover upon either of these claims? The question is stated thus singly, because the defendant admits that he uses the very hopper-boy for which the patent is in part granted, and justifies himself by insisting, —

1. That the plaintiff was not the original inventor of the hopper-boy, as patented, but that the same was in use prior to the plaintiff's patent.

2. That his patent for an improvement is bad; because the nature and extent of the improvement are not stated in his specification; and if they had been, still the patent comprehends the whole machine, and is, therefore, too broad.

1. The first is a mixed question of fact and law. In order to enable you to decide the first, it will be well to attend to the description which the plaintiff has given of this machine in his specification, of which a model is now before you. Its parts are —

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1. An upright round shaft, to revolve on a pivot in the floor.
2. A leader, or upper arm.
3. An arm set with small inclining boards, called flights and sweepers.
4. Cords from the leader to the arm, to turn it.
5. A weight passing over a pulley, to keep the arm light on the meal.
6. A cog at the top of the shaft, to turn it, which is operated upon by the water-power of the mill.

The flights are so arranged, as to track, the one between the other, and to operate like ploughs ; and at every revolution of the machine, to give the meal two turns towards the centre. The sweepers are to receive the meal from the elevator, and to trail it round the circle, for the flights to gather it to the centre, and also to sweep the meal into the bolt.

*The use of this machine is stated to be, to [* 447] spread any granulated substance over the floor ; to stir and expose it to the air, to dry and cool it, and to gather it to the bolt.

The next inquiry under this head is, when was this discovery made ? Joseph Evans has sworn that, in 1783, the plaintiff informed him he was engaged in contriving an improvement in the manufactory of flour, and had completed it in his mind some time in July of that year. In 1784, he constructed a rough model of the hopper-boy ; but having no cords from the extremities of the leader to those of the arm, it was necessary, in making his experiments, to turn around the arm by hand. In 1785, he set up a hopper-boy in his mill, resembling the model in Court, and the machine described in his specification.

The evidence of Mr. Anderson strongly supports this wit-

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ness; and indeed, the discovery, as early as 1784, or 1785, is scarcely controverted by the defendant.

The defendant insists that a hopper-boy, similar to the plaintiff's, was discovered and in use many years anterior even to the year 1783, and relies upon the testimony of the following witnesses —

Daniel Stouffer, who deposes that he first saw the Stouffer hopper-boy in his father's, Christian Stouffer's mill, in the year 1774. In 1775 or 1776, he erected a similar one in the mill of his brother Henry, and another in Jacob Stouffer's mill in 1778 or 1779.

Philip Frederick swears, that in the year 1778, he saw a Stouffer hopper-boy in operation in Christian Stouffer's mill, and in the year 1783 he saw one in Jacob Stouffer's mill and another in U. Charles's mill; and that it was always called Stouffer's machine.

George Roup states, that in 1784, he erected one of these hopper-boys in the mill of one Branneman, and that in 1782, Abraham Stouffer described to him a similar machine which his father used in his mill.

Christopher Stouffer, the son of Christian, has [* 448] sworn, that * his father having enlarged his mill in the year 1780, erected a new hopper-boy, of the description above mentioned, which is still in use in the same mill, now owned by Peter Stouffer.

If these witnesses are believed by the jury, they establish the fact asserted by the defendant, that the Stouffer hopper-boy was in use prior to the plaintiff's discovery.

The next inquiry is into the parts, operation, and use of the Stouffer hopper-boy. This consists of an upright square shaft, which passes lightly through a square mortise in an arm, underneath which are fixed slips of wood, called flights; and the arm is turned by a cog on the upper end of it, which is moved by the power which moves the mill.

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The arm, with the flights, operates as it turns upon the meal placed below it; and its use is, in a degree, to cool the meal, and to conduct it to the bolt.

It will now be proper to compare this machine with the plaintiff's. They agree in the following particulars: They each consist of a shaft, a cog to turn it by the power of the mill, and an arm with flights on the under side of it. They each operate on the meal, below the arm, to cool, dry, and conduct it to the bolt.

In what do they differ? The plaintiff's shaft is *round*, and consequently could not turn the arm, into which it is loosely inserted, if it were not for the cords, which connect the extremities of the arm to that of the leader. The shaft of the S hopper-boy is *square*, and therefore turns the arm without the aid of a leader or of cords. It has neither a weight nor pulley, nor are the flights arranged in the manner the plaintiff's are; and consequently, it does not, in the opinion of most of the witnesses, cool, or prepare the flour for packing, as well as the plaintiff's.

The question of law now arises, which is, Are the two machines, up to the point where the difference commences, the same in principle, so as to invalidate the plaintiff's claim to the hopper-boy, as the original inventor of it?

* We take the rule to be, and so it has been set- [* 449] tled in this and in other Courts, that, if the two machines be substantially the same, and operate in the same manner, to produce the same result — though they may differ in form, proportions, and utility — they are the same in principle; and the one last discovered has no other merit than that of being an improved imitation of the one before discovered, and in use, for which no valid patent can be granted to any one; because he cannot be considered as the original inventor of the machine. If the alleged inventor of a machine, which differs from another, previously patented, merely in

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form and proportions, but not in principle, is not entitled to a patent for an *improvement*, (which he cannot be, by the 2d section of the law,) he certainly cannot, in a like case, claim a patent for the *machine itself*.

The question for the jury, then, is, are the two hopper-boys substantially the same in principle? not, whether the plaintiff's hopper-boy is preferable to the other. Because if that superiority amounts to an *improvement*, he is entitled to a patent only for an improvement, and not for the whole machine. In the latter case, the patent would be too broad, and therefore void, where the patent is single.

If you are of opinion that the plaintiff is not the original inventor of the hopper-boy, he cannot obtain a verdict on that claim, unless his is an excepted case. The 1st, 3d, and 6th sections of the general Patent Law, conclusively support this opinion.

But the *judgment* of the Supreme Court in this case, (3 Wheaton, 519,) is relied upon by the plaintiff's counsel, to prove that this is an excepted case; insomuch that the plaintiff is entitled to a verdict, although you should be satisfied that he is not the original inventor of the hopper-boy. That declares, "on consideration whereof, this Court is of opinion that there is error in the proceedings of the said Circuit Court, in this, that the said Court rejected testimony which ought to have been admitted; and also in this, that in the [* 450] charge delivered to * the jury, the opinion is expressed, that the patent on which this suit is instituted, conveyed to Oliver Evans only an exclusive right in his improvement in manufacturing flour and meal, produced by the general combination of all his machinery; and not to his improvement in the several machines applied to that purpose; and also, that the said Oliver Evans was not entitled to recover, if the hopper-boy, in his declaration mentioned, had been in use previous to his discovery."

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But we are perfectly satisfied that the interpretation put upon this clause, by the plaintiff's counsel, is incorrect; and this for the following reasons. 1. The question of priority of invention, was not before the Supreme Court; and it is therefore incredible that any opinion, much less a judgment, would have been given upon that point. The error in the charge, which this part of the judgment was obviously intended to correct, is stated by the Chief Justice in the following words: —

“This part of the charge seems to be founded on the opinion, that if the patent is to be considered as a grant of the exclusive use of distinct improvements, it is a grant of the hopper-boy itself, and not for an improvement on the hopper-boy.”

2. It contradicts what is stated in p. 517, where it is said, that the plaintiff's claim is to the machines *which he has invented*. Now, if he did not invent the hopper-boy he has no claim to it; and if so, could the Court mean to say, that he was nevertheless entitled to recover under that claim?

Such a decision was certainly not called for, by the terms of “the Act for the relief of Oliver Evans,” but would seem to be in direct violation of it. The Act directs a patent to issue to Oliver Evans, not for his *hopper-boy, elevator, &c.*, but “for his invention, discovery, and improvements in the art, &c., and on the several machines which *he has discovered, invented, and improved*.” Now, if the hopper-boy was not *invented, &c.*, by Oliver Evans, this Act, (without which Oliver Evans could not have obtained a patent,) did not authorize the Secretary of State to grant him one for that machine; or if granted, it is *clear that it [*451] was improvidently done. If, indeed, the Supreme Court had been of opinion, that *the fact* of Oliver Evans's prior invention was decided, and could constitutionally have

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been decided by Congress, there might have been more difficulty in the case ; but the argument of counsel, which pressed that point upon the Court, was distinctly repudiated.

We conceive that the meaning of that part of the opinion is, that this Court erred in stating to the jury, that Oliver Evans was not entitled to recover, if *the hopper-boy*, that is, the original hopper-boy, had been in use prior to the plaintiff's alleged discovery of it ; because, if the plaintiff was entitled to claim an *improvement* on the hopper-boy, which this Court had denied, and which the Supreme Court affirmed, this Court was clearly wrong in saying to the jury, that the plaintiff could not recover for his improvement ; which, in effect, was said.

Upon the whole, then, the Court is of opinion that Oliver Evans is not entitled to a verdict in his favor, as the inventor of the hopper-boy, if you should be of opinion that another hopper-boy, substantially the same as his in principle, as before explained, up to the point where any alteration or improvement exists in his hopper-boy, was invented, and in use prior to the plaintiff's invention and discovery, however they may differ in mere form, proportions, and utility.

2d. The plaintiff's next claim is, to an improvement on a hopper-boy ; which claim, we were of opinion, in another case, has received the sanction of the Supreme Court. His counsel contended, that his improvement is — 1. On the original method of supplying the bolt by manual labor. 2. On his own hopper-boy ; and 3. On some hopper-boy invented by some other person.

Let this position be analyzed :—

1. It is said to be an improvement on the original method by manual labor. But it is obvious, that if this be the invention, it is of an original machine ; because, wherever the Patent Law speaks of an improvement, it is on
[* 452] some *art, machine, or * manufacturer, &c.* ; and

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not on manual labor, which was applied to the various arts, long before the invention of machinery to supply its place.

2. An improvement on his own discovery.

But where is the evidence of such invention? It is true, that Joseph Evans has stated that the plaintiff constructed, in 1784, a rude model of a hopper-boy; but it was no substitute for manual labor, because, without the cords or leading lines, the arm could not move; and it was, therefore, turned by hand. It was, in fact, in an incomplete state,—in progress to its completion, but not given out, or prepared to be given out, to the world as a machine, before 1785, when the cords to turn the arm were added.

3. An improvement on a former machine.

This is a fair subject for a patent; and the plaintiff has laid before you strong evidence to prove that his hopper-boy is a more useful machine than the one which is alleged to have been previously discovered and in use. If, then, you are satisfied of this fact, the point of law, which has been raised by the defendant's counsel, remains to be considered; which is, that the plaintiff's patent for an improvement is void, because the nature and extent of his improvement are not stated in his specification.

The patent is for an improved hopper-boy, as described in the specification which is referred to and made part of the patent. Now, does the specification express in what his improvement consists? It states all and each of the parts of the entire machine, its use and mode of operating; and claims, as his invention, the machine, the peculiar properties or principles of it, namely, the spreading, turning, and gathering the meal; and the raising and lowering of its arm, by its motion, to accommodate itself to the meal under it. But does this description designate the improvement, or in what it consists? Where shall we find the original hopper-boy

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described, either as to its construction, operation, or use ; or by reference to any thing by which a knowledge of it may be obtained ? Where are the improvements on [* 453] * such original stated ? The undoubted truth is, that the specification communicates no information whatever, upon any of these points.

This being so, the law, as to ordinary cases, is clear, that the plaintiff cannot recover for an improvement. The 1st section of the general Patent Law speaks of an improvement as an invention ; and directs the patent to issue for his said invention. The 3d section requires the applicant to swear, or affirm, that he believes himself to be the true inventor of the art, machine, or improvement, for which he asks a patent ; and further, that he shall deliver a written description of his invention, in such full, clear, and exact terms, that any person, acquainted with the art, may know how to construct and use the same, &c.

That it is necessary to the validity of a patent, that the specification should describe in what the improvement consists, is decided by Mr. Justice *Story*, in the cases referred to in the appendix to 3 Wheaton, and in the English case of *Boulton v. Bull*, *Boville v. Moor*, *M'Farlane v. Price*, *Harmar v. Playne*, and perhaps some others.

What are the reasons upon which this doctrine is founded ? They are to guard the public against unintentional infringements of the patent, during its continuance, and to enable an artist to make the improvement, by a reference to some known and certain authority, to be found amongst the records in the office of the Secretary of State, after the patent has run out.

But it is contended, by the plaintiff's counsel, that the law would be unreasonable to require, and, therefore, that it does not require this to be done, unless the improvement is upon a *patented* machine, a description of which can be obtained by

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a reference to the records of the office of the Secretary of State ; that it might often be impossible for the patentee to discover, and consequently to describe the parts of a machine, in use, perhaps, only in some obscure part of the world. The answer to this is, that an improvement necessarily implies an original ; and unless the patentee is acquainted with the original, which * he supposes he has improved, [* 454] he must talk idly, when he calls his invention an improvement. If he knows nothing of an original, then his invention is an original, or nothing ; and the subsequent appearance of an original, to defeat his patent, is one of the risks which every patentee is exposed to under our law.

As to the supposed distinction between an improvement on a machine patented, and one not so, there is nothing in it. In both cases, the improvement must be described ; but with this difference — that, in the former case, it may be sufficient to refer to the patent, and specification, for a description of the original machine, and then to state in what the improvements on such original machine consists ; whereas, in the latter case, it would be necessary to describe the original machine, and also the improvement. The reason for this distinction is too obvious to require explanation.

If the general law upon this subject has been correctly stated, the next question is, is this an excepted case ? It is contended by the plaintiff to be so ; 1st, in virtue of the Act for the relief of Oliver Evans ; and 2d, by the decision of the Supreme Court.

1. Under the private act ; that declares that the patent is to be granted, in the *manner and form* prescribed by the general Patent Law. What constitutes the manner and form in which a patent is granted by this law ? The obvious answer is, the petition, the patent, with the signature of the President and the seal of the United States affixed to it — the oath, or affirmation — the specification, or description of

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the invention, as required by the 3d section — the drawings and model, if required. Will it be contended that a patent would be granted, in the *manner and form* prescribed by this law, if there were no description whatever of the invention? And if it would not, which is taken for granted, where is the difference between the total absence of a specification and one which has no reference at all to the invention [* 455] for which the patent is granted? This * is not the case of an imperfect or obscure description, but of one which relates exclusively to the whole machine ; whereas the invention, for which the patent is granted, is for an improvement only.

2. The opinion of the Supreme Court, which states, “that it will be incumbent on the plaintiff, where he claims for an improvement, to show the extent of his improvement.”¹ But how is it to be shown? The Court has not pointed out the manner; and we, therefore, think the only fair implication is, that it must be shown as the statute of the United States, and the general principles of law require,—by the patent and specification. If it may be shown by parol evidence to the jury, as the plaintiff’s counsel contend it may, then it may be fairly asked, *cui bono*? What sort of a showing would this be, so far as it could be productive of any useful purpose? As to this defendant, the evidence comes too late to save him from the consequences of an error, however innocently committed. As to the public at large, with a view to caution during the continuance of the patent, and to information of the nature of the improvement, after its termination, the evidence given in this cause must be evanescent and totally useless.

We feel perfectly convinced that the meaning of the Supreme Court, as to this subject, is again misunderstood by the

¹ 3 Wheaton, page 518.

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plaintiff's counsel; not only for the reasons above mentioned, but because the *extent and construction* of the plaintiff's patent, and not the *validity* of it, in relation to any one of the machines, were the questions before that Court; and none others, (in reference to the charge,) were argued at the bar, or reasoned upon, by the Chief Justice, in delivering the opinion.

Upon the whole, we are of opinion that the plaintiff is not entitled to a verdict, for the alleged infringement of his patent for an improvement on the hopper-boy.

Verdict for defendant.

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[1 Mason, 447.]

A joint patent may well be for a joint invention, but not for a sole invention of one of the patentees. If each of the patentees obtain separate patents for the same invention, as his exclusive invention, and afterwards both obtain a joint patent for the same, as their joint invention, they are estopped by the joint patent to assert any title under the several patents.

A patent may well be for a new combination of machines, whether the machines be old or new. But one patent cannot, at the same time, include an exclusive right in the combination and in each of the machines; and it is no infringement of a patent for the combination, to use either of the machines separately.

There must be several patents for several improvements of distinct machines.

A patent for an improved machine must show in the specification, in what the improvement precisely consists; and the patent be limited to those improvements. If not specified, the patent is void for ambiguity; if broader than the improvements, it is void on other grounds.

Where a combination of machinery exists up to a certain point, and the patentee makes an improvement, he should not include in his patent the whole machinery; but only the improvement.

If a party make an improvement on an existing machine, or invent a new machine, his patent should not be for a method, but for this machine, or improved machine.

CASE for the infringement of a patent, granted for "a new

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and useful improvement, being a mode of dyeing and finishing all kinds of silk woven goods." Plea, the general issue, with a specification of special matter of defence.

The patent was granted on the 9th day of September, 1818; and after reciting that the plaintiffs had alleged that they had invented "a new and useful improvement, being a mode of dyeing and finishing all kinds of silk woven goods," granted to the plaintiff "the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Abner Stearns and the said William Barrett themselves, in the schedule hereto annexed, and is made a part of these presents," for the term of four years from the 12th day of May, 1818. The specification, annexed to the letters-patent, contained a description of two machines [* 448] chimes; one a reel, * on which spirally to wind and secure the silk, and put it into the dye; the other, a frame for the purpose of extending and finishing the silk after it is dyed.¹

¹ SPECIFICATION. The reel is designed to extend the silk, when immersed in the dye-stuff, so that this may pass freely and come in contact with the whole surface of the silk or material to be dyed, and yet the silk, or material, shall occupy the smallest possible or convenient space in the dye-tub.

This machine consists of two sets of arms, each resembling in form the hub and spokes of a wheel, without the rim or felloes. In the hub of one is formed a female screw; in the other, a smooth cylindrical hole, in which one end of the axle may freely turn. The axle consists of a male screw, except that one end thereof is turned smooth to adjust to the whole of the hub that is smooth, and the other end is for an inch or two square, to receive the eye of a winch or crank. It is about three or five feet long. The male screw of the axle is cut to fit the female screw in the hub, having the same therein. The two sets of arms are besides connected with each other by two square bars of wood or metallic substance like the axle. One end of each is securely fixed to the hub having the smooth hole, and

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* At the trial it was admitted that the infringe- [* 449]
ment of the plaintiff's patent, if any, was by the use

the other ends are adjusted to square holes made in the other hub, through which they slip or pass as the hubs or set of arms are made to approach each other, and thus prevent the hubs from turning, as the screw axle is turned round for the purpose of approximating or withdrawing the sets of arms, to or from each other. Thus it is easy to perceive that with one set of arms held on to the smooth cylindrical end of the axle, by a pin and washer or otherwise, so that the axle may freely turn therein, or in the hub thereof, the other set of arms, having the female screw, will be made to approximate to or recede from this, as the screw axle may be turned to or from, by a handle or winch affixed to the square end of the axle. The utility of this movement will presently appear.

The hub of the sets of arms may be made of any convenient size. The dimensions adopted in practice at present are as follows:— The material any metal or metallic composition. The last, however, has been adopted in practice. The hub is about five inches in diameter, and two inches through; is mortised to receive the arms, which are flat square about sixteen inches long, but tapering from the hub to the end; and upon the sides of these arms or spokes are secured small brass pins, which are so set in grooves, cut into the sides of these arms transversely and diagonally, that the pins point inward and upwards, and divergently from the axle. The distance between these pins is quite small, about three sixteenths of an inch. The mode of applying the silk and immersing the same, is as follows:— Both sets of arms, being placed on the axle as above represented, the machine is supported by the axle on two standards outside of the arms horizontally. The set with the female screw is then approximated by turning the winch to a distance from the other, a little less than the width of the material to be dyed. One end of the silk is then attached by the operator to opposite arms upon the pins therein nearest to the axle, and then the operator turning the machine a little for himself, the silk is further attached to the next arms by the pins nearest to the axle, and so on successively till the whole is attached and wound round upon the machine in a spiral form. Then turning the screw axle by the winch, the set of arms having the female screw therein, recedes by a regular motion susceptible of the most accurate adjustment to the width of the silk; and thus it is held perfectly extended between the arms and by the selvages, in such a manner as not to be in contact with itself, but to leave free pas-

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of the reel only ; and that the defendant did not use the silk frame, either in connection with, or separately from, the reel.

sage for the dye-stuff to apply itself equally to every part of the whole surface ; and in this state of tension it is immersed by operation of a tackle and fall attached to one end of the axle until it is properly saturated or dyed.

It is obvious that the silk by this means may be most conveniently rinsed, and most readily drained. Also it is apparent that the position of the pins on the arms, they inclining upwards and bending a little from the operator, as he applies the silk, must facilitate both the application of the material for dyeing, and the disengagement thereof after this operation is performed.

There has been, it is said, a reel heretofore in use for like purposes ; but this, if it ever were so used, consisted of four arms or two cross pieces, adjusted to a square axle, and the set of arms were kept separate or fixed upon the axle, not by a screw, but by pins passing through holes in said axle. Instead of pins affixed to the arms, there were common tenter hooks driven into the inner side of the arms, and the whole so constructed as to be utterly inapplicable to the purpose of dyeing silk or other goods, without great injury. The machine for which these applicants claim a patent is, in all material respects, an improvement upon this.

The design of the silk frame is to extend the silk for drying and finishing ; and it is contemplated to use it for all kinds of goods, which, in the operation of dyeing, require to be so extended.

It is a wooden frame consisting of fourteen posts, about four feet or more in height, connected by rails in such a manner as to be perfectly solid and firm. The opposite posts are connected by two strong rails of about eight feet in length, one at the bottom and one within a few inches of the top, well morticed and tenanted into the posts ; while two strong pieces of plank lying upon the bottom connecting rail, leaving a space of about two feet more or less between them, one firmly secured to these said bottom rails. A strong rail is fastened to the posts throughout the whole length of the frame, and thus gives it all the requisite solidity and firmness. Upon the upper rail connecting the opposite posts, which are placed at a distance of ten feet from post to post along the length of the frame, are lain two pieces of plank sixty feet long, and about eight or ten inches wide. These are made to move or slide in these upper rails, so that when the silk is attached to their inner edges, they may be withdrawn from each other till the requisite degree of tension is obtained.

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The plaintiffs stated their improvements to consist, 1st. In the spiral winding of the silk on more arms than four

The mode in which the silk is attached to the edges of these cheeks, and then the cheeks withdrawn, is as follows : — The inner edges of the cheeks are covered by a thin plate of copper, about half an inch wide, nicely attached thereto. Sixty pieces of wood, cut from board or plank, say from an inch to an inch and a half, or two inches thick, about a foot long on one side, and cut up in a triangular form, are adjusted to each cheek. The base being, as above, one foot in length, it is attached by hinges to the superior surface of the cheeks in such a manner that the edge of the base will coincide exactly with the inner edge of the cheek, when the piece rests on its base. On this too there is a copper edging, and thus, this copper edging, when these pieces are raised upon their basis, comes closely in contact with the copper edges along the line of the inner edges of the cheeks, and by firm pressure are made to hold the selvages of the silk, &c. To the outer side of these pieces, which are called lap-joints, are attached some iron stays, about six or eight inches long, being a little longer than the lap-joints are wide or high. These stays are attached by a staple, or eye, to the upper part of the lap-joints, and the foot of each is made to slide into a groove, cut in the superior surface of the cheek, and lined with copper, so that by forcing the foot of the stay into the groove, the lap-joint is made to press firmly upon the selvage of the silk, when lain upon the copper edge of the cheek. The silk is first secured by one selvage to one cheek; then the other cheek being approximated sufficiently, the operator in like manner applies the selvage to the other cheek edge, and secures it by successively raising up and securing the lap-joints. The former cheek is fastened to the upper rail by strong iron pins passing through this and the said connecting rails of opposite posts. The other cheek, which is called the front cheek, is then gradually withdrawn till the silk is perfectly extended. The mode of withdrawing the front cheek is thus: To this cheek, opposite to each post, all of which, on this side, rise two feet above the cheeks, are attached several pieces of iron, long enough to pass through the posts, on which pieces of iron are cut screw threads, so that nuts, being set in wheels and applied to said pieces of iron, by the turning of all the wheels simultaneously and with equal velocity, the whole front cheek is gradually withdrawn till the proper degree of tension in the silk is obtained. These wheels are put in motion by a chain band carefully adjusted, so that the links thereof embrace projections in the periphery, and the power is applied indifferently to either wheel, by

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[* 450] arms, so as to * assume the shape of a circular spiral, instead of a square spiral. 2ndly. In the use of small pins, obliquely placed on the arms of the reels, to hook the selvages of the cloth, and hold it in a spiral form. 3dly. In separating the opposite arms gradually, by the means of a screw, and thus gradually extending the silk.

[* 451] 4thly. In the use of side bars to sustain * the screw, and prevent it from turning with the machine, when it was not wished.

It appeared in evidence that reels with four arms had been used before the granting of the patent, with tenter-hooks (instead of pins) to wind the silk on in a square spiral. And the use of a screw, for the purpose of gradually separating the opposite arms, was described in a book printed in London, in

a pin six or eight inches long thereto attached, to serve as a handle or winch.

There may be other modes of withdrawing the front cheek, but the special subject of patent, for which letters are claimed, is the mode of securing the silk as above described by lap-joints, and the gradual and exact tension obtained by the withdrawing of the whole front cheek, simultaneously and equally at one operation as aforesaid. In these and in all material respects, this frame is an improvement upon the pin frame formerly in use, and also a frame, that was constructed to hold the selvages by pieces of board lain flat upon the cheeks, and pressed by wooden screws attaching them to the cheeks. The copper edges being a very considerable improvement on this last mentioned frame, which had become useless by reason of the absorption of the dye-stuffs in the wooden edges of the cheeks, and slabs or boards above mentioned.

The silk being thus extended, the ends thereof are secured by a cross bar set with pins, or by a piece of wood split so as to hold the ends, and the whole is ready for the operation of drying and finishing, which is done thus: Upon the pieces of plank, which are described as fastened upon the lower cross rails, that connect opposite posts, is placed a movable car running on four wheels, which is made to contain coals and move at pleasure beneath the silk, as the operator proceeds in the finishing. This being accomplished, the silk is delivered from the lap-joints by removing or sliding away the stays, and may be immediately folded for use.

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the year 1789, entitled the "Art of Dyeing Cotton and Linen Thread ; together with the Method of Stamping Silk, Cottons," &c., p. 501. — "Square vats are therefore constructed, about six feet deep, and three and a half wide, and about three feet in the ground, for the conveniency of the dyer. The cloth is then fixed by the selvages to two wooden frames, each composed of four bars, and of such a length as to be easily moved backward and forward in the vat. *These frames are held together by means of a screw, so as to be easily let out or taken in, according to the breadth of the cloth.* The cloth is *supported *by little iron hooks, [* 452]* passed through the selvage at the opposite sides, *to keep it as it were in folds* throughout the piece. "The whole thus arranged is suspended with a pulley over the vat, by means of cords fixed to each corner of the frame, and uniting in the middle, so that, by slackening the pulley, the linen is dipped without being rumped. When necessary to air and ungreen, by drawing the pulley the frame rises, and the cloth drains into the vat."

The witnesses at the trial gave different opinions as to the exact form of the machine, which was intended in this description ; and all seemed to think it somewhat ambiguous. But the fact that the screw was to be used, as in the plaintiffs' reel, was agreed on all sides. The reels, in fact, used by the plaintiffs had eight arms. The reels used by the defendants had ten arms. Instead of pins, the defendants used on their reels staples, with a short barb to catch the silk in the first instance ; and the silk was then secured on the reels by a rod running through the selvage, and through the holes in the staples. Instead of a screw, the defendants used a rack and pinion (which, it was admitted on all sides, was a different mechanical power) to separate the opposite arms after the silk was on the reel. In the spiral winding of the silk, the reels of the plaintiffs and the defendants were alike. Some of the

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witnesses were of opinion that the reels were alike in what they called principle ; others were of an opposite opinion. All of them, however, agreed as to the specific agreements and differences between them. It further appeared in evidence that in the year 1809, the plaintiffs severally obtained patents from the Department of State for the same invention, each of them then claiming and swearing that he was the sole inventor ; and neither of these patents had ever been repealed.¹

[* 453] * The jury found a verdict for the plaintiffs. And a motion for a new trial was made by *Gallison* and *Prescott*, for the defendants, upon the following grounds : —

1st. Because if the patent, which is declared upon in this action, be construed as a patent for the entire machine, called a reel, described in the specification, then the same includes parts, which at the trial were proved, and in the same specification are admitted to have existed, in combination in a machine for similar purposes, long before the supposed invention of the plaintiffs, to wit, in the reel composed of four arms, or two cross pieces, on which it was admitted that the cloth was wound in a square spiral, which reel is described in said specification as before in use ; and the judge, who charged the jury at the trial of said issue, did direct them that merely increasing the number of arms was not an invention that would in law entitle the plaintiffs to a patent, no certain number of arms being claimed in said specification ; and did also direct them, that, as it respected this patent, if the former square reel was believed to have been in use before the invention claimed in this patent, the defendants had a right to use the reel-head, resembling the hub and spokes of a wheel, and also the spiral form of winding the cloth ; and that the said patent, if it extended to the whole machine, and went to secure the exclu-

¹ *Stearns v. Barrett*, 1 Mason, 153, ante, 97.

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sive right to every part thereof, as the invention of the plaintiffs, was broader than their invention, and therefore void. And therefore the said jury, upon this construction of the patent, in returning their said verdict, must either have found that the said square reel did not so exist, which is against the admission of the specification, and the admissions and evidence of the plaintiffs at the trial ; or, admitting the above fact, they must have gone upon the supposition that, notwithstanding such prior use, the same might be secured by patent to the plaintiffs; and *that their said patent was [*454] not thereby rendered void ; in which case their said verdict is against the direction of the judge in the matter of law.

2dly. Because if the said patent be construed as a patent for an improved machine, or for a certain combination, consisting of the machine known and used before, as set forth in the specification, and of certain improvements added thereto by the plaintiffs, then the right of the plaintiffs under their said patent must be confined to that precise combination ; and it was necessary, in order to support the plaintiffs' case, and the judge, who tried the cause, did so direct the jury, that the machine used by the defendants should, in all material and essential respects, be like the machine described in the plaintiffs' specification ; otherwise the combinations would not be identically the same, and therefore there would be no infringement ; and that, if the rack and pinion was an essentially different mechanical power from the screw, then there appeared a substantial difference between the two machines, which destroyed their identity ; and, therefore, inasmuch as it was evident on inspection, that the rack and pinion was employed in the defendants' machine to produce the same effect, for which the screw is employed in the plaintiffs' machine, and it was also proved by divers witnesses on both sides, and was not contradicted, that the rack and pinion is a

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mechanical power essentially different from the screw, the said jury must have returned their verdict in this particular, either against the evidence or against the direction of the judge, in the matter of law.

3dly. Because, at the said trial, it was clearly proved by the testimony of Allan Pollock, by the admission of the plaintiffs, and by a public work, that hooks of different form and sizes, and of different degrees of finish and fineness, according to the nature of the cloth, had been used for the purpose of extending cloth upon frames, many years before [* 455] * the pretended invention of the plaintiffs ; and this evidence was not contradicted by any other evidence in the cause. And it was also proved by the said public work, and by witnesses produced, both by plaintiffs and defendants, to show the meaning of the description contained in the said public work, and was not contradicted by any other evidence in the cause, that many years before the said supposed invention of the plaintiffs, the screw axis was known, and had been used and applied for the purpose of moving one frame from or towards another, according to the width of cloth attached to said frames to be dyed. And it also appeared, and was admitted by the said plaintiffs in their specification, that before their said supposed discovery, a reel was in use for like purposes, consisting of four arms or two cross-pieces ; and it also appeared, and was admitted, that on such reel the cloth was wound in a square spiral ; by means of tenter-hooks set upon the arms ; and there were no other improvements claimed to have been made in any essential parts upon the said square reel, admitted by the said specification to have been before in use, excepting only the increasing of the number of arms, (which the said judge directed the jury was not an invention that would in law entitle the party to a patent, no certain number being set out in said specification ; and as to which, it appeared from inspection of the machine used by

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the defendants, that it consisted of eight arms only, while the machine produced by the plaintiffs consisted of ten,) the using of finished curved hooks, placed diagonally in the sides of the arms instead of tenter-hooks, formerly in use, and the aforesaid application of the screw. And the said judge directed the jury, upon these facts, that if any or all of these improvements had been used by the defendants, yet if none of the same was new in its principle or mode of application, the plaintiffs could not, in point of law, support their action for such use; and therefore the *said ver- [* 456] dict, in this respect, is either against the evidence, or against the direction of the judge in the matter of law.

4thly. Because it appeared in evidence as aforesaid, and was not contradicted by any testimony, that the screw had been applied for stretching cloth between two frames, in the same manner as in the plaintiffs' machine, long before the supposed discovery of the plaintiffs; and the said judge directed the jury, that, taking this fact to be true, if the said patent was construed as a patent for the improvements made in said square reel by the plaintiffs, then the said patent included what was not invented by the plaintiffs, to wit, the said application of the screw, and, therefore, upon this construction of the patent, the said verdict is against the evidence, or against the direction of the judge in the matter of law.

5thly. Because at the said trial it was proved, by an inspection of the machines, that the power which moved the movable frame or reel-head in one was a screw, and in the other a rack and pinion; and it also was testified, and was not contradicted, that these are essentially different mechanical powers. And it also appeared, by inspection of said machines, and from divers witnesses, whose testimony was not contradicted, that the cloth upon the defendants' machine is secured to the arms by rods passing through staples, and through the selvages of the cloth; and that the purpose and design of

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certain small barbs, cut upon said staples, is merely to hold the cloth until the rods are pushed through ; and it also appeared that said staples and barbs resembled more the tenter-hooks, admitted to have been long in common use, than the hooks or pinion of the plaintiffs' machine ; and it also appeared that in the plaintiffs' machine the cloth is attached and secured by means of curved hooks, or pins passing through the selvages, and holding the cloth through the whole operation of dyeing ; and it also appeared that these two parts of [* 457] the machine * were the only essential parts which had been improved by the plaintiffs, no other improvement being set out in their specification. Wherefore the said verdict is against the weight of evidence, and also against law, in finding the said defendants guilty of an infringement of the plaintiffs' rights.

6thly. Because the said judge, in charging the jury, did direct them, for the purposes of this trial, that the existence of two prior patents for the same thing, granted to the same patentees respectively, although both of said patents be still in force, did not affect the validity of the patent declared on. And did also direct them, for the purposes of this trial, that the oaths of said plaintiffs, respectively, made when they obtained the said prior patents, that they severally believed themselves to be true and original inventors of said machine, did not conclude them to show a joint invention of the same machine, and no claim as joint patentees therefor, both which directions the said defendants respectively submit are incorrect in point of law.

7thly. Because the said jury, upon the whole weight of evidence produced at the trial, and upon the matters of law, in which they were instructed by the judge, ought to have returned their verdict, that the defendants were not guilty ; yet, against the said weight of evidence, and against the said directions in matters of law, they have returned their said verdict, that the said defendants are guilty.

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G. Sullivan, for the plaintiffs, argued *contra*.

Our statute differs materially from the Statute of James. Under the Statute of James the inventor applies for, and obtains a patent, in which is contained a description, comprehending his whole invention. But a proviso is inserted in the patent, requiring the inventor to file in chancery a specific and minute statement of what he claims as his invention. This specification is matter of record in chancery; and whether this describes less than is contained in
* the patent, may well be considered, in many cases, [* 458]
as mere matter of law. Hence it happens that the question, whether the patent is broader than the invention, is sometimes in England decided by the Court. So, also, under the Statute of James, the Court determines what is principle, or that character which essentially constitutes the difference or identity of machines.

But in both these particulars, the Patent Law of the United States makes express provision. In respect to the principle of a machine, the statute expressly defines principle or character to be that thing, whatever it may be, whether it be found in structure or operation, or modes of operation, whereby the alleged invention may be distinguished from all others. Hence the Courts of the United States are not required to define principle. Nay, they have no power to direct the jury that this, or that, or other structure, constitutes the character of a machine, whereby it is distinguished from all other inventions. The judges, as I apprehend the law, must admit all evidence offered by either party, from witnesses acquainted with the particular art or machinery in question, whereby the true character or distinguishing principle of the machinery may be proved. And then they are to put it to the jury as a mere matter of fact, to determine upon evidence, what constitutes the distinguishing principle of the machines in question before them, and whether that distinguishing principle, be it in struc-

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ture, operation, or mode of operation, do or not exist in both machines, so as to constitute them essentially the same or different. If this were not so, the judges would draw to themselves the decision of matters of fact; for surely the question, what it is that constitutes the distinctive character of a machine, whereby it is distinguished from all others, is plainly matter of fact; and it cannot be disputed, that whether this same principle do or not exist in the plaintiffs' and defendants' machine, is also * mere matter of fact. So, whether the patentee have invented any thing that is new and useful, is merely a question of fact; for otherwise the Court must determine what has existed before; for what has existed before must be shown in evidence, or the Court must be presumed, nay required to know; and surely what has existed, is, beyond all controversy, matter of fact. Suppose the defendants insist that the patent is claimed for a bare philosophical principle. This, in like manner, must be referred to the jury, unless mechanical philosophy be law, and as such be presumed to exist in the breast of the Court. So if there be a question, whether the description specified be sufficient to enable artists to manufacture the machine, the sufficiency or insufficiency is matter of fact to be given in evidence by artists, or the Court must assume to itself a paramount knowledge of all arts and manufactures, and in doing so, assume the decision of mere matter of fact. Nay, as I apprehend the law, if there be evidence on both sides, the Court have not the power to determine on which side the weight of evidence appears, this being exclusively within the province of the jury; and the Court have no power in such a case to set aside a verdict, merely because they think the verdict is against the weight of evidence. So also if there be a patent for an improvement in a patented invention, and the question arise under the second section of the Patent Law, whether the alleged improvement be simply a

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change in the form or proportions of a machine, this is clearly a question of fact to the jury. In like manner, all the questions arising under the sixth section, whether the specification do or not contain the whole truth relative to the discovery; whether it contains more or less than is necessary to produce the described effect, and so made for the purpose of deceiving the public; whether the thing described in the patent was or not originally discovered by the patentee, or had been in use before; whether * the invention had [* 460] been described in some public work anterior to the supposed discovery of the patentee; all these are mere questions of fact, and such the statute expressly makes them, when it denominates the subject of these questions special matter, and provides that it may be given in evidence, if notice thereof be filed thirty days before the trial. Thus it appears that whatever may be the practice of the English Courts, under the Statute of James, in relation to the extent of the patent beyond the invention, it is clearly matter of fact here, whether the patent contain more than the invention, that is, in the English technical phraseology, whether the patent be or not broader than the invention. And this brings us to the other point of difference between our Act of Congress and the Statute of James, which respects the power of the Court to decide, if the patent is broader than the invention. And here it is only necessary to remark summarily, after what is said above, that if the decision of the question is drawn to the Court in England, it is merely a question of fact, in this country, and as such to be determined by a jury upon evidence.

In this place it may be pertinent to consider what evidence is to be received, touching the difference or identity of machines. Certainly it is not to be expected that the Court should be informed upon all the principles of mechanics, nor, if they were, is it to be allowed that their direction to the jury

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on these matters of fact can be regarded as more imperative than in other cases of fact. If there be a question of seaworthiness of a ship, the Court may well lay down the rule, that the vessel must be capable of performing the voyage insured. But after it is proved the vessel was defective in certain of her timbers, it surely is competent to both parties to adduce evidence to show that these defects do or not render the ship incapable of performing the voyage.

[* 461] And whatever may be the private * opinion of the Court, they must submit the question to the determination of the jury, upon the evidence produced. So in questions of deviation, and many others of the like kind.

Now, in the case before the Court, the question of the identity of the machines was a mere matter of fact. It was testified that they had the same character, and were in principle the same. There was evidence to this point on both sides, and the jury found their identity. They were in fact the same. The substitution of the rack and pinion, it will appear, when the nature of mechanical powers is considered, makes no difference. What are mechanical powers? They are only the means of augmenting the force applied, and this is uniformly done in the inverse ratio of the velocity of that force. These powers are common to the whole mechanical world, and no patent can be obtained for the application of them as powers. But the patent goes for that new and useful structure of constituent parts, whereby the powers being applied, certain new and useful effects are produced. Now what was this structure of essential constituent parts in the machines before the Court? It was the movable set of arms sliding on the two square bars, passing through the hub of said moving set of arms, whereon this was made to traverse by means of a mechanical power applied. It was obvious to any mechanical mind, and so Col. Baldwin testified, that the screw, or the rack and pinion might be indifferently applied

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to the same structure. Indeed, the lever, the pulley, and weight, and other powers, might also be applied to the same structure or constituent parts of the machinery. All these powers would subserve the same purpose, and by precisely the same means, that is, by augmenting the force in the inverse ratio of the velocity with which the force moved, and of course regulating the force by a gradual movement. Indeed there can be no better test on earth of the identity of machines, than that their structure is such that different

* powers may be indifferently applied to precisely [* 462] the same constituent parts, and the operations of those parts, and the effects produced by the application of one or other power be the same. At all events, whether the substitution of one power instead of another, do or not constitute a difference, must be a question for the jury, which they are to determine upon the evidence of intelligent mechanics. To test this yet farther, let it be supposed that the defendant had applied for and obtained a patent as for an improvement on the plaintiffs' machine, and had specified the substitution of the rack and pinion, it is clear, that in an action by the defendants against a party for an infringement, it would be competent for such party to raise the question, whether the application of the rack and pinion were any thing more than a simple change of form. From evidence disclosed in this case, it might be made to appear that there was no difference in the effect, and no difference in the structure of the constituent essential parts of the machine, whereby the operation of stretching the silk is obtained. It would also appear that the force applied to give motion to the moving set of arms is augmented and graduated in the same ratio, and *quoad* these machines, if Col. Baldwin and others are believed, is the same. At all events, whether it were so or not, would be a question of fact to the jury ; and if they were of opinion that the substitution of the rack and pinion was

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simply a change in form, the defendants in such case could not hold their patent, because the statute says simply changing the form shall not be deemed a discovery. Again, if on the contrary the application of a rack and pinion were not found to be simply a change in form, but an improvement, and this were the improvement specified, the defendants could not use the constituent parts of the machine, because the statute, second section, expressly enacts that the patentee of the improvement shall not be at liberty to use the [* 463] original * discovery ; and surely if the defendants could not use the discovery of the plaintiffs, if the defendants were patentees of the application of the rack as an improvement, *à fortiori* they could not use the plaintiffs' discovery now, that they are not patentees of an improvement. Here the defendants may contend that the plaintiffs have not specified their original discovery, so that the same may be distinguished from what was known before ; and whether they have or not, is next to be considered. Now the plaintiffs, in their specification, first describe the whole reel as used by them, and a machine in magnitude was produced. No objection was taken at the trial, as to the sufficiency of this description. It was fully admitted that the whole machine, such as it appeared, was clearly described. Then the plaintiffs describe another reel, consisting of four arms and a square axle, through which axle some holes being made at certain distances, the moving set of arms could be secured at the requisite distance, according to the width of the material wound upon the reel. This also was so clearly and distinctly described, that the defendants therefrom constructed in model a reel, conforming exactly to the description. Whereupon the plaintiffs, in their specifications, say that the new reel is, in all material respects, an improvement upon the old reel, and for these material improvements they claim their patent. Now whether there are any such material improvements was

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matter of fact to the jury, and what these improvements were, was also matter of fact. Nothing could be plainer than that a material difference existed, both in the effect produced, and in the mode of operation to produce that effect. The jury were satisfied, both as to the difference of the new from the old, and that this difference made the new better than the old; and what is improvement, but being different and better? But, said the defendants, the patentees ought to have designated, in precise terms, the particular parts which constituted the * difference. The answer to this [* 464] doctrine is found in the statute. The inventor, says the third section, shall fully explain the principles and character by which the machine may be distinguished from other inventions. Now the new machine was fully described, so that artists could make one from the specification. The old machine was described so that artists could make one like that from the description; and it was manifest on inspection, and from the evidence, that they were in character materially different. Certainty, to a common intent alone, is required. No precise or technical language is necessary. The public derive all the benefit that the patent law contemplated securing to the public, and the patentee has secured to him no more than his invention. The jury found it so; and surely the Court cannot otherwise decide, without assuming the determination of matters of fact. In the case of *Harmer v. Playne*,¹ it was held, that a description of the old and description of the new machine in the same patent, although the description of the old was merely by recital of the former patent, was description enough of the improvement for which the patent was obtained. In the case of *Watt and Boulton v. Bull*, it was held, that the description was sufficient, although no precise form or proportion of the condenser was described, nor

¹ 11 East's R. 101.

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its relative position to the cylinder named, nor the means of communication between the cylinder and condenser distinctly mentioned. It is enough, said the Court, if an artist can produce the designed effect from the description contained in the specification. It cannot be that inventors are required to describe pin for pin, screw for screw, and all the numerous unpatentable differences, that must exist in every machine, however new, in common with other machines. There are shades of difference in machines, which result from [* 465] their * original character, and like the shades of difference in the social and professional habits of men, which depend on their predominant passions or qualities, are seen and understood, but yet are without a name, nor is it in the power of language to describe them.

It is enough for the public if artists can see and understand these distinctive or essential qualities of the machine from the specification. It is enough for the parties at a trial, if the jury perceive and comprehend them, and find them, in their opinion, sufficiently described in the patent or specification.

It comes next in course to consider the novel doctrine assumed by the defendants, that the plaintiffs must be considered as claiming a patent for the combination, such as it was exemplified in their machine, or else they must be considered as limited to special improvements, and these they must designate. Having already considered the latter alternative, I proceed to consider the former. In the first place, there is not a word of combination in the plaintiffs' patent, nor would this be necessary to secure his invention, if this were in fact only a combination of such parts as, properly speaking, in relation to mechanics, could be combined ; for the inventor is entitled to his patent, if he fully explain his invention, and the principle and character thereof, so as to distinguish it from all others known or used before ; and surely this might be done in *Evans's case* without using the word com-

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bination. But what is combination, and what parts may be combined? Is driving a nail, or turning a screw into a piece of wood a combination? Is putting arms or spokes to a hub—is putting two wheels to an axis, a combination? It is obvious enough, what combination is not. Nor is it less plain what it is. The connection of several distinct machines together, like Evans's mill, so as to be operated upon by one power, giving coöperative motion to all, is clearly a combination. * There each machine has its cha- [* 466] racteristic, constituent parts, a being, a life of its own; but the connection of a thousand dead parts in one machine, having but one single operation, can never be considered a combination. A watch is a combination; for the main-spring is one power, and puts the whole machine into operation, but the hair-spring is a power that regulates this motion. Here, then, are two distinct operations. So in the card machine of Whittemore, there is a combination of parts, each performing a distinct operation, and the whole acted upon and regulated by numerous powers. But in the plaintiffs' reel there is but one power, and one single simple operation, that of moving the traversing set of arms; and it is said "that some machines are so simple, that they cannot be considered as combinations." The reel, therefore, of the plaintiffs cannot be regarded as a combination. But if it were, and the only alleged difference were the use of the rack and pinion instead of the screw, the question of difference is for the jury; and they are to decide, "whether, on the whole, there is any substantial difference between the machines, or whether they are substantially the same. Slight or colorable differences will not protect the defendants in their infringement, or defeat the right of the patentee;" and this brings us back to the general question of identity, which lies exclusively within the province of the jury; for infringement or not, of course identity or not, says Judge *Rooke*, is for the jury to decide.

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I have now considered the several questions made at the trial, and have shown, as it is believed, that the questions, whether the plaintiffs jointly invented the reel, whether the patent is broader than the invention, and whether the improvement, as such, is sufficiently described for all the purposes of the patent law, are all purely questions of fact. And I have

also shown, as it is believed, that the doctrine of combination does not apply to the plaintiffs' reel; * but

[* 467] whether it does or not, that the question of the identity of the defendants' and plaintiffs' machine is still the same, and is merely a question of fact.

In presenting this view of the subject, it will be perceived that I have directly encountered all the objections taken in the defendants' motion, which are comprised in the first five causes assigned for a new trial. The five first causes are so involved with each other, that an attempt to give a special reply to each, would have left the whole subject in confusion. They altogether amount to this merely, that the plaintiffs have invented nothing; that if they have, their invention is not sufficiently described and distinguished in the specification; but if it is sufficiently described, the defendants have not used the plaintiffs' invention. All this is matter of fact, and as such was properly submitted to the jury; and on all these points the evidence was either full for the plaintiffs, and uncontradicted, or else there was evidence on both sides; whence it follows that the verdict for either of said five causes, or for the last, cannot be set aside as being against evidence.

As to the sixth cause, that the judge misdirected the jury touching the validity of the plaintiffs' joint patent, to wit, that it was valid, although patents for the same invention had been issued, in 1809, to each of the plaintiffs, as sole inventor of the same, and for aught that appeared, both the patents were in force when the action on the joint patent was commenced. The counsel for the plaintiffs is satisfied on authorities, that

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this direction was unexceptionable and correct. This is a new question in Court, although a practice in the patent-office has doubtless given many occasions of its being raised. But as this is not a point mainly in controversy now, I shall content myself with stating a few points of law, and citing the authorities that support them.

* It is a natural right, which every patentee hath, [* 468] to surrender his invention, if the acceptance of it imposed no condition which remained unperformed. In England a patentee may surrender his patent into Chancery,¹ and when the surrender is enrolled a *vacatur* is entered of course. This is by order of Chancery according to ancient practice. But the Circuit Court of the United States has no cognizance in chancery of patents, nor has the law designated any mode whereby a patentee may surrender his patent. In favor, therefore, of common rights, a Court of Common Law will presume a surrender, wherever it is for the interest of a patentee that he shall be considered as having surrendered. But the subsequent acceptance of a patent, which is incompatible with a former one, is in law an implied surrender of the former. The patents of 1809 are already inconsistent with the patent of 1818. Nay, the plaintiffs, by their subsequent oath of joint invention, have utterly defeated all title under their precedent patents, independently of the surrender implied by the acceptance of the last patent.

Touching the plaintiffs' oaths as to their respective exclusive invention, it was regarded as clearly a matter of mistake, into which joint inventors might naturally fall when ignorant, as they each were, of the extent of the other's design and contrivance. In conclusion it is proper to observe that this motion for a new trial is an application to the sound discretion of the Court for an equitable interposition of its powers.

¹ See Dyer's case, 1 Dyer, 179, and notes.

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To what equitable consideration are these defendants entitled? Were they not the clerk and apprentice of the plaintiff, Barrett? Did they not learn of him the use of the machines in question? Did they not employ a workman of his to take the measurement of his machines, and then, from [* 469] the very outset, engage him in a * suite of contrivances, to approximate to the plaintiffs' machines, and yet to save the appearance of invasion of their rights, while, in fact, the original design of the defendants was unquestionably, by slight and colorable differences, to conceal the infringement they consciously intended? Surely it must be admitted on all hands, that the plaintiffs have invented a most valuable method of extending the silk for dying; and if a jury of the country, selected from that public for whose benefit the patent is granted, are in truth satisfied on all the material points, it cannot be justice to perplex and harass the plaintiffs with the necessity of further suit to obtain enjoyment of their just right and privilege. Besides, it must be remembered that patents in England receive a strict construction, because they are there considered as being in derogation of common right. Whereas, in the United States they are more justly regarded as bounties upon the productions of genius, and as means of great and extensive benefit to the public. As such, they ought here to receive the most liberal construction; and no patent should be held void, if it in fact fulfil the ultimate design of the patent law; if it furnish in the specification a description essentially certain, to enable the public to avail itself of the invention after the patent term shall have expired. This is the object of the law; and to this, as the great end of all its provisions, ought the attention of the judiciary and juries to be directed.

STORY, J. This case has been argued for the plaintiffs, as fully and as ingeniously as its merits will allow, upon the same

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principles and reasonings, which were pressed upon the Court at the trial. If they have failed to convince the understanding of the Court, it is because in some instances the premises, and in others, the conclusions, are radically unsound and inadmissible. I pass over all the learned lecture, as to what constitutes matter of fact and * what of law, [* 470] and what are the relative rights of Courts and juries as to matters of fact, because no novelty and no instruction can attach themselves to the discussion. The whole doctrine lies in the elements of the Common Law, undisputed and indisputable. As little do I think it necessary to discuss the question, what constitutes the identity or diversity of machines in the abstract; or to philosophize respecting the different mechanical powers. My humble knowledge does not permit me to venture on such difficult topics, and fortunately my duties as a judge do not require me to master them. I am content on these, as on other occasions, to learn from those who can give the proper instruction, and then to apply it to the solution of such questions of law as are fit to be entertained here. To be sure I must continue to believe, until better instructed, that the different mechanical powers are not one and the same power; and that a motion, which is communicated by a screw, is not communicated in the same way as that by a lever, a wheel, a wedge, or a pulley.

As to the opinion of skilful witnesses, whether the principles of two machines are the same, no person doubts that it is competent evidence to be introduced into a patent cause. But care should be taken to distinguish what is meant by a principle. In the minds of some men, a principle means an elementary truth, or power; so that in the view of such men all machines, which perform their appropriate functions by motion, in whatever way produced, are alike in principle, since motion is the element employed. No one, however, in the least acquainted with law, would for a moment contend

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that a principle in this sense is the subject of a patent; and if it were otherwise, it would put an end to all patents for all machines, which employed motion, for this has been known as a principle, or elementary power, from the beginning of time. The true legal meaning of the principle of a [* 471] machine, with reference to the * Patent Act, is the peculiar structure or constituent parts of such machine. And in this view the question may be very properly asked, in cases of doubt or complexity, of skilful persons, whether the principles of two machines be the same or different. Now, the principles of two machines may be the same, although the form or proportions may be different. They may substantially employ the same power in the same way, though the external mechanism be apparently different. On the other hand, the principles of two machines may be very different, although their external structure may have great similarity in many respects. It would be exceedingly difficult to contend that a machine, which raised water by a lever, was the same in principle with a machine which raised it by a screw, a pulley, or a wedge, whatever in other respects might be the similarity of the apparatus.

But, although the testimony of witnesses be admissible to prove the identity or diversity of machines in principle, yet, after all, it is but matter of opinion; and its weight must be judged of by all the other circumstances of the case. It is infinitely more satisfactory to ascertain, if we can, the precise differences and agreements; and when these can be subjected to the eyes, they almost supersede all the evidence of mere opinion. In all my experience I can scarcely recollect a single instance, in which the general question, whether the principles of two machines were the same or different, has not produced from different witnesses, equally credible and equally intelligent, opposite answers. This could result only from the different meanings attached to the word, and from confound-

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ing its various senses. And this has been completely shown when the same witnesses came to explain the precise agreements and differences, in which they have almost uniformly agreed. The case now before the Court is a perfect proof in point. The witnesses differed as to the identity or diversity of the * principles of the machines ; but [* 472] they all agreed in what were the precise differences and agreements in fact. There seemed then nothing left for the jury to decide, but whether these differences were substantial or formal ; if substantial, then the machines were not alike ; if formal only, then they were alike. And the question, whether the principles were the same in both machines, was in reality, when all the facts were given, rather a matter of law, than of the opinion of mechanics ; at least matter of law was necessarily mixed up with it, which mechanics could not be presumed to be acquainted with.

The opinion, however, which I shall express, will not turn in any material respect upon any facts controverted at the trial. I shall discuss the motion for a new trial, so far as facts are concerned, upon the admissions and statements, which the plaintiffs did not and could not deny. The doctrine of patents may truly be said to constitute the metaphysics of the law. The difficulty lies not so much in the general principles as in the minute and subtle distinctions, which occasionally arise in the application of those principles. I will endeavor, however, to lay down some general rules, which appear to me to embrace the whole merits of the present controversy, and then apply those rules more pointedly to the facts of this case.

In the first place, a joint patent may well be granted upon a joint invention. There is no difficulty in supposing, in point of fact, that a complicated invention may be the gradual result of the combined mental operations of two persons acting together, *pari passu*, in the invention. And if this be true,

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then as neither of them could justly claim to be the sole inventor in such a case, it must follow that the invention is joint, and that they are jointly entitled to a patent. [* 473] And so are the express words of the Patent * Act,¹ which declares that if any person or persons shall allege that he or they have invented, &c., a patent shall be granted to him or them for the invention.

In the next place, a joint patent cannot be sustained upon a sole invention of either of the patentees ; for the Patent Act gives no right to a patent, except to the inventor ; and requires an oath from the party who claims a patent, that he is the true inventor.

In the next place, a joint patent for an invention is utterly inconsistent with several patents for the same invention by the same patentees. For it is impossible that any person can be, at the same time, the joint and sole inventor of the same invention. If, therefore, each of the joint patentees obtains a several patent for the same invention, as his own exclusive invention ; and, afterwards, without surrendering the first patent, they obtain a joint patent for the same as a joint invention, either the former sole patents are void, or the joint patent is void. For, besides the apparent inconsistency of the patents, if all could be sustained, then a recovery upon the joint patent would be no bar to a suit upon the several patents ; and the parties might obtain a double recompense for the same infringement. There is an additional reason which deserves great consideration ; and that is, that if sole and joint patents could be sustained by the same parties for the same invention, they might be successively taken out, so that the term of the exclusive right might be prolonged for a great length of time, instead of being limited to fourteen years. I am, therefore, clearly of opinion that a grant of a subsequent

¹ Act of 21 February, 1793, ch. 13, § 1.

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patent for an invention, is an estoppel to the patentee to set up any prior grant for the same invention, which is inconsistent with the terms of the last grant. And I have very great doubts whether, when a patent is once granted to any person for an invention, he can legally acquire any right under a subsequent patent for the same invention, unless his first patent be *repealed for some original [* 474] defect, so that it might truly be said to be a void patent.

In the next place if several patents are taken out by several patentees for a several invention, and the same patentees afterwards take out a joint patent for the same as a joint invention, the parties are not absolutely estopped by the former patents from asserting the invention to be joint; but the former patents are very strong evidence against the joint invention. The reason of this doctrine is, not that estoppels are odious in the law, but that a party may innocently mistake, as to the extent of his own claims. And though a sole and joint invention, by the same persons of the same thing, cannot exist in fact; yet a party may suppose that he has invented what in truth has been partly suggested by another mind.

In the present case each of the plaintiffs (Barrett and Stearns) obtained, in the year 1809, a several patent for the present invention, as his sole invention; and the patent, on which this action is brought, is a joint patent granted in 1818. In this view the doctrine already stated directly applies in the case. It is the same, as was stated to the jury at the trial, and on the most mature reflection, I adhere to it.

In the next place a patent may be for a new combination of machines to produce certain effects; and this, whether the machines, constituting the combination, be new or old. But in such case, the patent being for the combination only, it is no infringement of the patent to use any of the machines separately, if the whole combination be not used; for in such

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a case the thing patented is not the separate machine, but the combination ; and the statute gives no remedy, except for a violation of the thing patented. This was the doctrine of

Mr. Justice Washington in his most able opinion in [*475] *Evans v. Eaton* ; and it has not *been in the slightest degree shaken in the Supreme Court.¹ I

hesitate not one moment in adopting it, as established on solid foundations. It has indeed been said that where there is a patent for the whole of a machine, whoever imitates it, either in whole or in part, is subject to an action at the suit of the patentee.² But supposing this doctrine to be true in any case and under any qualifications, (which may well be doubted,) it can apply only where the whole machine is entirely new, and cannot apply where the patent is limited, by its very terms, to the combination of several machines.

Further. A patent under the general Patent Act cannot embrace various distinct improvements or inventions ; but in such case the party must take out separate patents. If the patentee has invented certain improved machines, which are capable of a distinct operation ; and also has invented a combination of those machines to produce a connected result, the same patent cannot at once be for the combination and for each of the improved machines ; for the inventions are as distinct as if the subjects were entirely different. A very significant doubt has been expressed on this subject by the Supreme Court ; and I am persuaded that the doubt can never be successfully removed.³

Further. If a patent be for an improved machine, or for an improvement of a machine, (for I follow Mr. Justice Heath⁴

¹ *Evans v. Eaton*, 3 Wheat. R. 454, 476, 506.

² *Bovill v. Moore*, 2 Marsh. R. 211.

³ *Evans v. Eaton*, 3 Wheat. R. 454, 506.

⁴ *Boulton v. Bull*, 2 H. Bl. 463, 482.

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and the Supreme Court¹ in thinking that the meaning of the terms is substantially the same,) then the patent must state in what the improvement specifically consists; and
* it must be limited to such improvement. If, there- [* 476]
fore, the terms be so obscure or doubtful, that the Court cannot say what is the particular improvement which the patentee claims, and to what it is limited, the patent is void for ambiguity.² And if it covers more than the improvement, it is void for another reason, that it is broader than the invention.

Further. Where a combination of machinery already exists up to a certain point; and the patentee makes an addition or improvement to the machinery; he must confine his patent to the improvement; for if he takes a patent for the whole machine as improved, not distinguishing between the new and old, nor limiting his patent to the improvement, it is void, because, as so claimed, it is not his invention.³

Further. If an invention consist in a new combination of machinery, or in improvements upon an old machine to produce an old effect; the patent should be for the combined machinery or improvements on the old machine, and not for a mere mode or device for producing such effects, detached from the machinery. This appears to have been the doctrine of all the judges in *Boulton v. Bull*,⁴ and was illustrated by several of the cases there put. And in a recent case, where a patent was obtained for "an improved mode of lighting cities," it was held, that it was not supported by a specification describing an improved street lamp; and that the patent ought to have been for an improved street lamp.⁵ So, where

¹ *Evans v. Eaton*, 3 Wheat. R. 454.

² *M'Farlane v. Price*, 1 Starkie R. 199.

³ *Bovill v. Moore*, 2 Marsh. R. 211.

⁴ 2 H. Bl. 463.

⁵ *Cochrane v. Smethurst*, 1 Starkie R. 205.

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the patent was for "a new invented manufacture of lace, called French, otherwise ground lace," and the specification went generally to the invention of mixing silk and cotton thread upon the frame; it being proved, that, prior [* 477] to the patent, silk and cotton * thread had been used together and intermixed upon the same frame, the Court held the patent bad, since the plaintiff claimed the exclusive liberty of making lace, composed of silk and cotton thread mixed, and not of any particular mode of mixing it; and the evidence proved it had been mixed before.¹ This doctrine may not be of as extensive consequence under our Patent Act, where the specification forms a part of the patent, and may control its generality, as in England, where the specification is separated from it. But it distinctly shows the necessity of an exact description, so that the patent may conform to the invention.

Let us now apply these principles to the case at bar. The patent is "for a new and useful improvement, being a mode of dyeing and finishing all kinds of silk woven goods." If these terms alone were to be considered as descriptive of the subject-matter of the patent, it would be open to the objection in *Cochrane v. Smethurst*,² for the specification shows no other mode of dyeing and finishing silks, than by the use of an improved reel and an improved silk frame; and the patent ought to be for these improvements. But as the specification forms a part of the patent, and controls the generality of the preceding terms, it is to be construed a patent for a mode of dyeing and finishing silk woven goods, by means of an improved reel and an improved silk frame. The patent, then, is not for a mode of dyeing alone, but of dyeing and finishing silks; and this, by means of the use of both machines, so that it is a

¹ *The King v. Else*, 11 East R. 109, note.

² 1 Starkie R. 205.

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patent for the machines in combination, and not separately. If so, then the defendants may use either of the machines separately, without infringing the patent-right ; for the exclusive right of the combination only is secured to the plaintiffs. In this view, there is an end of the present suit ; for it is admitted by the plaintiffs, * that the defendants [* 478] did not use the silk frame, and that the only infringement, for which they seek a recompense, is the use of the reel. But if the patent could be construed as a patent for each of the machines severally, as well as in the combination, then it would be void ; because two separate inventions cannot be patented in one patent. And the same objection would lie against it, if it were to be construed as a patent for each of the machines severally, and not in combination.

If, however, all these difficulties could be surmounted, and the patent were to be construed as a patent for an improved reel and an improved frame separately, there remain other insuperable objections. There is no pretence that the patent can be sustained for the whole reel, as a new invention, although some part of the language of the specification might lead to the conclusion that the plaintiffs so intended to claim ; for reels were in use before for the same purpose. And if it were otherwise, the plaintiffs could not recover ; for the defendant does not use precisely the same machine ; and if he did, the patent would be broader than the invention, and so void. The patent, therefore, must stand, if at all, as a patent for the improvements only upon the old reel. And what the improvements claimed by the plaintiffs are, must be decided exclusively by the terms of their specification. The words of the specification, after describing the improved reel, are : — “There has been, it is said, a reel heretofore in use for the like purpose ; but this, if it ever were so used, consisted of four arms, or two cross pieces, adjusted to a square axle ; and the set of arms were kept separate or fixed upon the axle, not

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by a screw, but by pins passing through holes in said axle. Instead of pins affixed to the arms, there were common tenter hooks driven into the inner side of the arms, and the whole so constructed as to be utterly inapplicable to the purpose of dyeing silk or other goods without great injury. The [* 479] machine, * for which the applicants claim a patent, is, in all material respects, an improvement upon this.” This is the whole statement of the improvements in the reel, in the plaintiffs’ specification. And assuming that it is not utterly defective, from omitting to specify the particular improvements for which the patent is claimed, (for a general statement, that the patented reel is, in all material respects, (without stating what these are,) an improvement on the old reel, is no specification at all,) the plaintiffs have bound themselves to the improvements so specified, and cannot now claim beyond them.¹ Now, the plaintiffs have specified no particular number of arms to be used in their machine, as among their improvements, and therefore no particular number of arms is patented. The machine is stated by themselves to consist “of two sets of arms, each resembling in form the hub and spokes of a wheel, without the rim or fellies.” There is, therefore, nothing new in this particular; and, in point of fact, the plaintiffs use eight arms and the defendants ten arms in their respective reels. The two principal improvements, actually specified, are the use of a screw, to separate gradually and keep apart the opposite arms of the reel, instead of a pin passing through a hole in the axle; and the use of oblique transverse pins to hold the selvages of the silk, instead of tenter hooks. Now, in point of fact, the defendant does not in his reel use the pins described in the specification, but staples, with a small barb, which are at least as different in form and effect from the pins, as the pins are different from tenter hooks. And pins or hooks of all sizes and finish were proved at the

¹ Rex v. Cutler, 1 Starkie R. 354.

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trial to have been used for at least thirty years last past, for the same purpose. There is no pretence that the staples and barbs used by the defendants are exactly in size, shape, and direction, like the plaintiffs'. Then, as to the screw; it is a sufficient *answer to the plaintiffs, that, by [* 480] their own showing, the defendant never used the screw in his reels; but used a rack and pinion, which, it is agreed, is a different mechanical power. The only two improvements, therefore, which are specified, are not used by the defendant, either separately or in combination. How, then, is it possible to contend that he has violated the plaintiffs' patent?

This is not all. The pin or hook used for this purpose is not a new invention. It has been long in use, and, as was proved at the trial, at least for thirty years. I do not say that a pin or hook was used exactly of the same shape, dimensions, and oblique position, as that used by the plaintiffs. But it is to be considered that the mere change of the form or proportions of any mechanical apparatus is not, by the express terms of the Patent Act, to be deemed a patentable invention. And as to the screw, its use for the very purpose proposed by the plaintiffs, is completely described in the work cited at the bar, printed in 1789. The words are, "these frames are held together by means of a screw, so as to be easily let out, or taken in, according to the breadth of the cloth."

If, therefore, the patent could be considered as a patent for each of these improvements separately, it could not be sustained; for neither of them is new in substance. If, for the combined improvement, then, in the first place, the defendant has not used them; and, in the next place, the patent is broader than the invention; for, up to a certain point, the improvements existed before. The screw was in use for the same purpose, as early as 1789.

But, if we could go beyond the patent and specification,

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and consider the patented improvements to be such improvements as the plaintiffs now claim, it would not relieve the case from a single difficulty. The plaintiffs now claim in addition to the improvements already specified, 1st. The use of more arms than four to wind the silk in a spiral form.

[* 481] * The silk was wound in a spiral form before ; and surely it cannot be pretended that the use of more than four arms on a reel or wheel was not known as well before as since the plaintiffs' invention. Besides ; the plaintiffs have not specified any particular number of arms as their invention, and they never used but eight ; and if such use constitute a separate invention, the defendant is at least as well entitled to claim the use of his ten as his own invention. If adding a given number of arms be an invention, adding a different number is not less an invention. 2dly. The plaintiffs claim the use of the side pieces to support and steady the screw during the operation. This is not, as I recollect, used by the defendants for the same purpose ; nor, if used separately with the screw, is it any thing new. If, therefore, the whole improvements, as now claimed, were specified in the schedule, the plaintiffs could not legally support a patent for them separately ; and if they are claimed in combination, then the defendants have not infringed upon that combination ; and if they had, the plaintiffs could not recover, because the combination up to a certain point existed (as they have shown) before. So that, to sustain their patent in point of law, the plaintiffs are driven to construe it to be for the combination, and the evidence of infringement fails them ; and to sustain their suit in point of fact, they are obliged to construe their patent to be for the improvements severally, and then they fail upon the clearest principles of law applied to the facts.

I have thus gone over the whole grounds of this cause ; and in every possible view, in which I can contemplate the law or the facts of the case, the verdict is wrong. Under such cir-

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cumstances, to suffer it to stand, would be a mockery of justice. It would be surrendering the whole rights of the community to the mistakes or prejudices of juries. The public ought to know that if a jury should be misled by the ingenuity or zeal of counsel, there is a redeeming * spirit in [* 482] the law itself; and that no judge, in these times, can be weak or wicked enough to abandon what his duty plainly and peremptorily enjoins upon him.

Let the verdict be set aside, and a new trial granted.

New trial granted.

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[3 Wheat. 454.]

Under the 6th section of the Patent Law of 1793, ch. 156, the defendant pleaded the general issue, and gave notice that he would prove at the trial, that the machine, for the use of which, without license, the suit was brought, had been used previous to the alleged invention of the plaintiff, in several places which were specified in the notice, or in some of them, "and also at sundry other places in Pennsylvania, Maryland, and elsewhere in the United States. The defendant having given evidence as to some of the places specified, offered evidence as to others not specified. Held, that this evidence was admissible. But the powers of the court, in such a case are sufficient to prevent, and will be exercised to prevent, the patentee from being injured by surprise.

Testimony, on the part of the plaintiff, that the persons, of whose prior use of the machine the defendant had given evidence, had paid the plaintiff for licenses to use the machine since his patent, ought not to be absolutely rejected, though entitled to very little weight.

Quære, Whether, under the general Patent Law, improvements on different machines can be comprehended in the same patent, so as to give a right to the exclusive use of several machines separately, as well as a right to the exclusive use of those machines in combination?

However this may be, the act of the 21st January, 1808, ch. 117, "for the relief of Oliver Evans," authorizes the issuing to him of a patent for his invention, discovery, and improvements, in the art of manufacturing flour, and in the several machines applicable to that purpose.

Quære, Whether congress can constitutionally decide the fact, that a particular individual is an author or inventor of a certain writing or invention, so

¹ See also Appendix, Note 2, to this case.

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as to preclude judicial inquiry into the originality of the authorship or invention ?

Be this as it may, the act for the relief of Oliver Evans does not decide that fact, but leaves the question of invention and improvement open to investigation under the general Patent Law.

Under the sixth section of the Patent Law, ch. 156, if the thing secured [* 455] by patent had been in use, or had been described in a public * work anterior to the supposed discovery, the patent is void, whether the patentee had a knowledge of this previous use or description, or not.

Oliver Evans may claim, under his patent, the exclusive use of his inventions and improvement in the art of manufacturing flour and meal, and in the several machines which he has invented, and in his improvement on machines previously discovered. But where his claim is for an improvement on a machine, he must show the extent of his improvement so that a person understanding the subject may comprehend distinctly in what it consists.

The act for the relief of O. E. is engrafted on the general Patent Law, so as to give him a right to sue in the Circuit Court, for an infringement of his patent-rights, although the defendant may be a citizen of the same State with himself.

ERROR to the Circuit Court for the district of Pennsylvania.

This was an action brought by the plaintiff in error against the defendant in error, for an alleged infringement of the plaintiff's patent-right to the use of his improved *hopper-boy*, one of the several machines discovered, invented, improved, and applied by him to the art of manufacturing flour and meal, which patent was granted on the 22d January, 1808. The defendant pleaded the general issue, and gave the notice hereafter stated. The verdict was rendered, and judgment given thereupon for the defendant in the court below ; on which the cause was brought, by writ of error, to this Court.

At the trial in the Court below, the plaintiff gave in evidence, the several acts of Congress entitled respectively, "An act to promote the progress of useful arts, and to repeal the acts heretofore made for that purpose ;" "An act to extend the privilege of obtaining patents, for useful discoveries and * inventions, to certain persons therein mentioned, and to enlarge and define penalties for

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violating the rights of patentees ;” and “ An act for the relief of Oliver Evans ;” the said Oliver’s petition to the Secretary of State, for a patent,¹ and the patent thereupon *granted to the said Oliver, dated the twenty- [* 457] second day of January, in the year 1808 ;² and further gave in *evidence, that an agent for the plain- [* 458] tiff, wrote a note to the defendant, in answer to which, he called on the *agent at Chambersburg, [* 459] at the house of Jacob Snyder, on the ninth of August, 1813 ; there were a *number of millers pre- [* 460] sent ; the defendant then told the agent that he had got Mr. Evans’s Book, a plate in *the Millwright’s [* 461] Guide, and if the agent would take forty dollars, the defendant would give it him ; the *defendant [* 462] said that his hopper-boy was taken from a plate in Mr. Evans’s book ; he said he would give no more, alleging, that the hundred dollars the agent asked was too much ; that the stream on which his mill was, was a small head of Cono-gocheage. The agent then declared, that if the defendant would not pay him by Monday morning he would commence a suit in the Circuit Court.

The plaintiff further gave in evidence, that another agent for the plaintiff was in the defendant’s mill on the second of November, 1814, and saw a hopper-boy there, on the principles and construction of the plaintiff’s hopper-boy. This witness had heard that a *right was obtained under [* 463] Pennsylvania ; but did not know of any rights under Pennsylvania sold by the plaintiff ; and did not know that it was erected in any mill after the patent under Pennsylvania. The *defendant’s hopper-boy had an upright [* 464] shaft, with a leading arm, in the first place, and a

¹ See *ante*, p. 70.² See *ante*, p. 74.

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[* 465] large arm inserted * with flights, and leading lines, and sweepers ; a little board, for the purpose of
[* 466] sweeping the meal in the * bolting hoppers, and spreading it over the floor ; a balance weight, to cause the arms to play up and down lightly over the
[* 467] meal. The leading arms were about five * feet long, and seemed to be in proportion, the arm about fourteen, and the length of the sweep about nine inches.
[* 468] * And the defendant, having previously given the plaintiff written notice, that upon the trial of the
[* 469] * cause, the defendant would give in evidence, under the general issue, the following special matter, to
[* 470] * wit: " 1st. That the improved hopper-boy, for which, *inter alia*, the plaintiff in his declaration
[* 471] alleges he * has obtained a patent, was not originally discovered by the patentee, but had been in use anterior to the supposed discovery of the patentee, in sundry places, to wit: at the mill of George Fry and Jehu Hollingsworth, in Dauphin county, Pennsylvania ; at Christian Stauffer's mill, in Warwick township, Lancaster county, state of Pennsylvania ; at Jacob Stauffer's mill, in the same county ; at Richard Downing's mill, in Chester county, Pennsylvania ; at Buffington's mill on the Brandywine ; at Daniel Houston's mill in Lancaster county, Pennsylvania ; at Henry Stauffer's mill in York county, Pennsylvania ; and at Dohl's mill in the same county, or at some of the said places, and also at sundry other places in the said State of Pennsylvania, the
[* 472] State of Maryland, and elsewhere * in the United States. 2d. That the patent given to the plaintiff, as he alleges in his declaration, is more extensive than his discovery or invention, for that certain parts of the machine in said patent, called an *improved hopper-boy*, and which the plaintiff claims as his invention and discovery, to wit, the upright shaft, arms, and flights, and sweeps, or some of

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them, and those parts by which the meal is spread, turned, and gathered at one operation, and also several other parts, were not originally invented and discovered by him, but were in use prior to his said supposed invention or discovery, to wit, at the places above mentioned, or some of them. 3d. That the said patent is also more extensive than the plaintiff's invention or discovery; for that the application of the power that moves the mill or other principal machine to the hopper-boy is not an original invention or discovery of the plaintiff, but was in use anterior to his supposed invention or discovery, to wit, at the places above-mentioned or some of them. 4th. That the said patent is void, because it purports to give him an exclusive property in an improvement in the art of manufacturing meal, by means of a certain machine, termed an improved hopper-boy, of which the said plaintiff is not the original inventor or discoverer; parts of the machine in the description thereof referred to by the patent, having been in use anterior to the plaintiff's said supposed discovery, to wit, at the places above-mentioned, or some of them; and the said patent and description therein referred to contains no statement, specification, or description, * by [* 473] which those parts, so used as aforesaid, may be distinguished from those of which the said plaintiff may have been the inventor, or discoverer, protesting at the same time that he has not been the inventor or discoverer of any of the parts of the said machine. 5th. That the improved elevator, described in the declaration, or referred to therein, was not originally discovered by the plaintiff, but was anterior to his said supposed discovery or invention, described in certain public works, or books, to wit, in *Shaw's Travels*; in the first volume of the *Universal History*; in the first volume of *Mormer's Husbandry*; in *Ferguson's Mechanics*; in *Bossuet's Histoire des Mathematiques*; in *Wolf's Cours des Mathematiques*; in *Desagulier's Experimental Philoso-*

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phy, and in *Proney's Architecture Hydraulique*, or some of them. 6th. That the said patent is more extensive than the invention or discovery of the plaintiff, because certain parts of the machine called an improved elevator, were, anterior to the plaintiff's said supposed invention or discovery, described in certain public works, or books, to wit, the works or books above-mentioned, or some of them ; and that the said patent is void, because it neither contains or refers to any specification or description by which the parts so before described in the said public works, may be distinguished from those parts of which the plaintiff may be the inventor, or discoverer, protesting, at the same time, that he has not been the inventor or discoverer of any of the parts of the said machine ; " gave in evidence the existence of hopper-boys prior to the plaintiff's [* 474] alleged discovery at sundry mills in the State * of Pennsylvania, mentioned in the said notice ; and further offered to give in evidence the existence of hopper-boys prior to the plaintiff's alleged discovery, at sundry other mills in the State of Pennsylvania, not mentioned in the said notice ; and the counsel for the plaintiff objected to the admission of any evidence of the existence of hopper-boys in the said mills not mentioned in the said notice. But the court decided that such evidence was competent and legal. To which decision the counsel for the plaintiff excepted. The plaintiff, after the above evidence had been laid before the jury, offered further to give in evidence, that certain of the persons mentioned in the defendant's notice, as having hopper-boys in their mills, and also certain of the persons not mentioned in the said notice, but of whom it has been shown by the defendant that they had hopper-boys in their mills, had, since the plaintiff's patent, paid the plaintiff for license to use his improved hopper-boy in the said mills respectively. But the counsel for the defendant objected to such evidence as incompetent and illegal, and the court refused to permit the

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same to be laid before the jury. To which decision the plaintiff's counsel excepted.

The court below charged the jury, that the patent contained no grant of a right to the several machines but was confined to the improvement in the art of manufacturing flour by means of those machines; and that the plaintiff's claim must, therefore, be confined to the right granted, such as it was. That it had been contended that the schedule was part of the patent, and contained a claim to the invention of the peculiar properties and principles of the hopper-boy as * well as the other machines. But the court was [* 475] of opinion, that the schedule is to be considered as part of the patent, so far as it is descriptive of the machines, but no farther; and even if this claim had been contained in the body of the patent, it would have conferred no right which was not granted by that instrument.

The court further proceeded to instruct the jury that the law authorized the President to grant a patent, for the exclusive right to make, construct, use, and vend to be used, any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement in any art, machine, &c., not known or used before the application. As to what constitutes an improvement, it is declared, that it must be in the principle of the machine, and that a mere change in the form or proportions of any machine shall not be deemed a discovery. Previously to obtaining the patent, the applicant is required to swear, or affirm, that he verily believes that he is the true inventor or discoverer of the art, machine, or improvement, for which he solicits a patent; and he must also deliver a written description of his invention, and of the manner of using it, so clearly and exactly, as to distinguish the same from all other things before known, and to enable others, skilled in the art, to construct and use the same. That from this short analysis of the law, the following rules might

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be deduced. 1st. That a patent may be for a new and useful art ; but it must be practical ; it must be applicable and referable to something by which it may be proved to be useful ; a mere abstract principle cannot be appropriated by patent. 2d. The discovery must not only be useful, [* 476] but *new* ; it must not have been * known or used before in any part of the world. It was contended by the plaintiff's counsel, that the title of the patentee cannot be impeached, unless it be shown that he *knew* of a prior discovery of the same art, machine, &c. ; and that *true* and *original* are synonymous terms in the intention of the legislature. But, as it was not pretended that those terms meant the same thing in common parlance, neither was it the intention of the legislature to use them as such. The first section of the law, referring to the allegations of the application for a patent, speaks of the discovery as something " not known or used before the application ;" and in the 6th section it is declared, that the defendant may give in evidence that the thing secured by patent, was not *originally* discovered by the patentee, but had been in use, or had been described in some public work *anterior* to the *supposed* discovery. 3d. If the discovery be of an improvement only, it must be an improvement in the principle of a machine, art, or manufacture, before known or used ; if only in the form or proportion, it has not the merit of a discovery which can entitle the party to a patent. 4th. The grant can only be for the discovery as recited and described in the patent and specification. If the grantee is not the original discoverer of the art, machine, &c., for which the grant is made, the whole is void. Consequently, if the patent be for the whole of the machine, and the discovery were of an improvement, the patent is void. 5th. A machine, or an improvement, may be new, and the proper subject of a patent, though the parts of it were before known and in use. The combination, therefore, of old

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machines, to produce a new *and useful result, [* 477] is a discovery for which a patent may be granted.

The above principles would apply to most of the questions that had been discussed. It was strongly insisted upon by the defendant's counsel, that this patent is broader than the discovery; the evidence proving that, in relation to the hopper-boy, for the using of which this suit is brought, the plaintiff can pretend to no discovery beyond that of an improvement in a machine known and used before the alleged discovery of the plaintiff. This argument proceeded upon the supposition, that the plaintiff had obtained a patent for the hopper-boy, which was entirely a mistake. The patent was "for an improvement in the art of manufacturing flour," by means of a hopper-boy and four other machines described in the specification, and not for either of the machines so combined and used. That the plaintiff is the original discoverer of this improvement, was contested by no person, and, therefore, it could not with truth be alleged that the patent is broader than the discovery, or that the plaintiff could not support an action on this patent against any person who should use the whole discovery.

But could he recover against a person who had made or used one of the machines, which in part constitutes the discovery? The plaintiff insisted that he could, because, having a right to the whole, he is necessarily entitled to the parts of which that whole is composed. Would it be seriously contended that a person might acquire a right to the exclusive use of a machine, because when used in combination with others, a new and useful result is produced, which he could not have acquired independent of that combination? * If he could, then if A were proved to be the [* 478] original inventor of the hopper-boy, B of the elevator, and so on, as to the other machines, and either had obtained patents for their respective discoveries, or chose to

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abandon them to the public, the plaintiff, although it was obvious he could not have obtained separate patents for those machines, might, nevertheless, deprive the original inventors, in the first instance, and the public in the latter, of their acknowledged right to use those discoveries, by obtaining a patent for an improvement consisting in a combination of those machines to produce a new result.

The court further charged the jury, that it was not quite clear that this action could be maintained, although it was proved beyond all controversy that the plaintiff was the original inventor of this machine. The patent was the foundation of the action, and the gist of the action was, the violation of a right which that instrument had conferred. But the exclusive right of the hopper-boy was not granted by this patent, although this particular machine constitutes a part of the improvement of which the plaintiff is the original inventor, and it is for this improvement, and this only, that the grant is made. If the grant then was not in this particular machine, could it be sufficient for the plaintiff to prove, in this action, that he was the original inventor of it?

Again : could the plaintiff have obtained a separate patent for the hopper-boy, in case he were the original inventor of it, without first swearing, or affirming, that he was the true inventor of that machine? Certainly not. Has the plaintiff then taken, or could he have taken, such an oath in this case? Most assuredly he could not ; because the prescribed form [* 479] of the oath * is, that he is the inventor of the art, machine, or manufacture, for which he solicits a patent. But since the patent which he solicited was not for the hopper-boy, but for an improvement in the manufacture of flour, he might, with safety, have taken the oath prescribed by law, although he knew at the time that he was not the true inventor of the hopper-boy ; and thus it would happen that he could indirectly obtain the benefit of a patent

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right to the particular machine, which he could not directly have obtained, without doing what, it must be admitted in this case, he had not done.

But this was not all. If the law had provided for fair and original discoverers a remedy when their rights are invaded by others, it had likewise provided corresponding protection to others, where he has not the merit. What judgment could the district court have rendered upon a *scire facias* to repeal this patent, if it had appeared that the plaintiff was not the true and original inventor of the hopper-boy? Certainly not that which the law has prescribed, namely, the repeal of the patent; because it would be monstrous to vacate the whole patent, for an invention of which the patentee was the acknowledged inventor, because he was not the inventor of one of the constituent parts of the invention, for which no grant is made. But the court would have no alternative but to give such a judgment, or, in effect, to dismiss the *scire facias*; and if the latter, then the plaintiff would have beneficially the exclusive right to a machine, which could not be impeached in the way prescribed by law, although it should be demonstrated that he was not either the true or the original inventor of it. And *supposing the jury should be [* 480] of opinion, and so find that the plaintiff was not the original inventor of this machine, would not the court be prevented from declaring the patent void, under the provisions of the 6th section of the law, for the reason assigned why the district court could not render judgment upon a *scire facias*? Indeed it might well be doubted whether the defence now made by the defendant could be supported at all in this action, (if this action could be maintained,) inasmuch as the defendant cannot allege, in the words of the 6th section, *that the thing secured by patent* was not originally discovered by the patentee, since, in point of fact, the thing patented was,

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originally discovered by the patentee, although the hopper-boy may not have been so discovered. But if this defence could not be made, did not that circumstance afford a strong argument against this action? If the plaintiff was not the inventor of the parts, he had no right to complain that they were used by others, if not in a way to infringe his right to their combined effect. If he was the original inventor of the parts which constitute the whole discovery, or any of them, he might have obtained a separate patent for each machine of which he was the original inventor.

Upon the whole, although the court gave no positive opinion upon this question, they stated that it was not to be concluded that this action could be supported, even if it were proved that the plaintiff was the original inventor of the hopper-boy. But if an action would lie upon this patent for violation of the plaintiff's right to the hopper-boy, still the plaintiff could not recover, if it had been shown to the [* 481] satisfaction of the *jury, that he was not the original discoverer of that machine.

It appeared, by the testimony of the defendant's witnesses, that Stauffer's hopper-boy was in use many years before the alleged discovery of the plaintiff; that the two machines differed from each other very little in form, in principle, or in effect. They were both worked by the same power which works the mill; and they both stir, mix, cool, dry, and conduct the flour to the bolting-chest. Whether the flights and sweepers in the plaintiff's hopper-boy were preferable to the slips attached to the under part of the arm in Stauffer's; or whether, upon the whole, the former is a more perfect agent in the manufacture of flour than the latter, were questions which the court would not undertake to decide; because, unless the plaintiff was the original inventor of the hopper-boy, although he had obtained a separate patent for it, he could not recover in this action, however useful the improvement might be,

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which he had made in that machine. If the plaintiff had obtained a patent for his hopper-boy, it would have been void, provided the jury should be of opinion, upon the evidence, that his discovery did not extend to the whole machine, but merely to an improvement on the principle of an old one, and if this should be their opinion in the present case, the plaintiff could not recover.

It had been contended by the plaintiff's counsel, that the defendant, having offered to take a license from the plaintiff, if he would consent to reduce the price of it to forty dollars, he was not at liberty to deny that the plaintiff is the original inventor of this * machine. This argu- [* 482] ment had no weight in it, not merely because the offer was rejected by the plaintiff's agent, and was, therefore, as if it had not been made ; but because the law prevents the plaintiff from recovering, if it appear on the trial that he was not the original inventor. If the offer amounted to an acknowledgment, that the plaintiff was the original inventor, (and further it could not go,) this might be used as evidence of that fact, but it would not entitle the plaintiff to a verdict, if the fact proved to be otherwise.

The plaintiff's counsel had also strongly insisted, that under the equity of the tenth section of the law, the defence set up in this case ought not to be allowed after three years from the date of the patent. This argument might, perhaps, with some propriety, be addressed to the legislature, but was improperly urged to the court. The law had declared, that in an action of this kind, the defendant may plead the general issue, and give in evidence that the plaintiff was not the original inventor of the machine for which the patent was granted. The legislature has not thought proper to limit this defence in any manner ; and the court could not do it.

But what seemed to be conclusive of this point was, that the argument would tend to defeat altogether the provision

of the sixth section, which authorizes this defence to be made ; for, if it could not be set up after three years from the date of the patent, it would be in the power of the patentee to avoid it altogether, by forbearing to bring suits until after the expiration of that period. And thus, although the [* 483] law has * carefully provided two modes of vacating a patent improvidently granted, the patentee, though not the original inventor, and, however surreptitiously he may have obtained his patent, may secure his title to the exclusive use of another's invention, if he can for three years avoid an inquiry into the validity of his title.

The last point was, that Stauffer's invention was abandoned, and, consequently, might be appropriated by the plaintiff. But if Stauffer was the original inventor of the hopper-boy, and chose not to take a patent for it, it became public property by his abandonment ; nor could any other person obtain a patent for it, because no other person would be the original inventor.

To this charge the plaintiff's counsel excepted.

February 26. *Mr. C. J. Ingersoll*, for the plaintiff, premised, that this patent granted an exclusive right for fourteen years in the improvement in the art, by means of the five machines, and for the several machines ; the peculiar properties of each in its practical results, and the improvement of the art by the combination of the whole. The proof of this position is, that the defendant uses the precise machine, copied for the plaintiff's application, and offered to pay for it ; but they differed in price, which led to the contesting the originality of the plaintiff's invention.

1. It is said, in the charge of the Court below, that the action is founded on the patent, which contains no grant of a right to the several machines, but is confined to the improvement in the art, by means of those machines. The pa-

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tent is to be made out in the *manner and form [* 484] prescribed by the general act. What are that manner and form? By reciting the allegations and suggestions of the petition; giving a short description of the invention, or discovery; and *thereupon* granting an exclusive right in the *said invention or discovery*. The manner and form of *these* letters-patent are a recital of, 1st. The citizenship of the patentee. 2d. The allegations and suggestions of the petition, as to both the improvement and the machines in a short description, referring to the annexed schedule for one more full and particular in the inventor's own words. 3d. That he has petitioned *agreeably to the special act*. 4th. A grant of the *said* improvement. The description must be short and *referential*. It must be a *description*. By the first section of the act of the 10th of April, 1790, ch. 34, it was to be described clearly, truly, and fully; perhaps because the board, constituted by that law, was to decide whether they deemed the discovery or invention sufficiently useful or important for letters-patent. The patent, by express reference, adopts the special act *in extenso*. The connecting terms *which* and *said*, bind the whole to the granting clause; the allegations and suggestions *recited* are part of the grant; the machines are the means of *every* end, particular as well as general; nor can there be any practical result without them. To confine such a patent to one general result from a combination of the *whole* machines, nullifies it. It is never so in practice, and would operate infinite injustice in other cases. 2. But the schedule is part of the patent in *all* cases; *in this case it is especially so. By the act of [* 485] 1790, ch. 34, s. 6, the patent *or specifications* are *prima facie* proof of every thing which it is incumbent on the plaintiff to establish; and by the existing law, the specification is considered as explanatory of the terms used in the

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patent, so as to limit or enlarge the grant.¹ But it is said in the grant, that the schedule annexed is made part of the patent. It is made so by the public agent to avoid trouble, litigation, and unnecessary recitals. The petition, schedule, and description, are all referred to, and incorporated with the patent. What does the law mean by a recital of allegations and suggestions? What more can a petitioner do than allege and suggest? He cannot shape or prescribe the manner and form of the grant. The charge denies that the schedule, at any rate, is more than *descriptive* of the machines, or that it would confer any right, even if claimed in the patent. But if no right would be conferred by insertion in the grant itself, what becomes of the argument which ascribes such potency to the grant? The charge says, the grant can only be for the discovery *as recited and described* in the patent and *specification*. The grant is not for the parts, because it is for the whole; not in their rudiments or elements; not for wheels, cogs, or weights, nor for wood, iron, or leather; but for the peculiar properties, the new and useful practical results from each machine, and the vast improvements from their combination in this art. The charge supposes it impossible to obtain a patent * for a hopper-boy, unless the plaintiff could swear that he invented that machine. But the oath is not a material, or at least, not an indispensable perquisite.² 3. The special act for the relief of the plaintiff, decides him to be the inventor of the machines and improvements for which he has obtained a patent. By the constitution, art. 1, s. 8, Congress have power to promote the progress of science and the useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries. This has been done by Congress in the instance of the plaintiff. The special act is an

¹ Whittemore v. Cutter, 1 Gallis. 429, *ante*, 28.

² Whittemore v. Cutter, 1 Gallis. 433, *ante*, 31.

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absolute grant to him, binding on all the community, and precluding any inquiry into the originality of the invention. It includes a monopoly in his invention, discovery, and improvement in the art, *and* in the several machines discovered, invented, improved, and applied, for that purpose. The patent is to issue on a simple application in writing by the plaintiff, without any prerequisites of citizenship, oath, fee, or petition, specification and description to be filed. The act of 1793, ch. 156, requires all these, and then grants a patent for *invention or discovery*; whereas this grant is for that, and for *improvements* in the art, *and* in the several machines. It is a remedial act, and should receive a liberal construction to effectuate the intentions of the legislature.¹ The patent is as broad as the law, if the grant be governed by the recital. Its construction is to be against the grantor, and according to the intent; * nor is it to be avoided by [* 487] subtle distinctions; if there are two interpretations, the sensible one is to be adopted.² 4. The improved hopper-boy of the plaintiff is the only new and useful discovery which was in evidence in the case; the court misconstrued the law in their charge in this respect, inasmuch as the true construction of it is not that the patentee shall be the first and original discoverer of a patentable thing, but “the true inventor” of such a thing; that such a thing was truly discovered and patented without knowledge of its prior use, or public employment, or existence; more especially where, as in the present instance, the controversy is not between conflicting patents, but between the true patentee of a new and useful patentable thing, and a person defending himself against an infringement, on the plea of its prior use by third persons who had no patent, and whose dis-

¹ *Whittemore v. Cutter*, 1 Gallis. 430, *ante*, 30.

² *Jenk. Cent.* 138. *Eystor v. Studd*, *Plowd.* 467; *The U. S. v. Fisher*, 2 *Cranch*, 386, 399.

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covery, even if proved, was of a thing never in use or public existence, but in total disuse. The stat. 21 Jac. 1, ch. 3, s. 6, an. 1623, grants the monopoly "of the sole working or making of any manner of new manufactures, within this realm, to the *true* and first inventor and inventors of such manufactures, which others at the time of making such grant, shall not use," &c. It is contended, under our law, that the *utility* is to be ascertained as well the *originality*; and that this, as well as that, is partly a question for the jury. The thing patentable must be *useful*, as well as new. The *useful* thing patented

prevails over one not useful nor patented, though [* 488] in *previous* partial existence. This is not the case of conflicting patentees; and to destroy this patent, the previous *use* must appear, there being no pretence of description in a *public* work. The title of the act is "for the promotion of the *useful* arts." The first section speaks of "any new *and useful* arts," not *known or used*, &c. The sixth, of that which "had been *in use*, or described in some *public* work anterior to the *supposed* discovery." What degree of use does the law exact? a use *known* or described in a *public* work. Not merely an experimental, or essaying; nor a clandestine, nor obscure use. It must be useful, and in use, perhaps in *known*, if not *public* use; something equivalent to filing a specification on record. Now here utility was lost sight of in search of novelty. It seemed to be taken for granted, that proving the preëxistence of an unpatented hopper-boy defeated the plaintiff's patent. The desuetude of the rival hopper-boy from inutility was established. The question was between a new and useful patented machine, and an useless and obsolete one never patented; and which, not being *useful*, never could be patented. But that the patentee's is useful nobody questions. At all events, the question of fact, whether in use, should have been left to the jury. The jury are substituted for the *board*, which,

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under the first law, was to decide whether the supposed invention was "sufficiently useful and important" for a patent. The court below suppose Stauffer to have given his discovery to the public. But it fell into disuse; there was nothing to give. Stauffer did not know its value; if he * had abandoned a field with unknown treasure in the ground, could he afterward claim the treasure? ¹ 5. The defendant's testimony of the use of hopper-boys in mills, not specified in his notice, was erroneously admitted. The object of the provision in the 6th section of the Patent Law of 1793, ch. 156, was to simplify the proceedings, and to enable the defendant to give in evidence under his notice, what he would otherwise be obliged to plead specially. The sufficiency of the notice is, therefore, to be tested by the rules of special pleading; which, though technical, are founded in good sense and natural justice, and are intended to put the adverse party on his guard as to what the other intends to rely upon in his defence. But such a notice as this could not answer that purpose. 6. The plaintiff's testimony of the payment for licenses to use his improved hopper-boy, ought not to have been rejected. It ought to have been admitted as circumstantial evidence entitled to some weight.

Mr. *Hopkinson* and Mr. *Sergeant*, *contrà*. 1. The admissibility of evidence of the use of the hopper-boys, anterior to the plaintiff's alleged invention, in mills not specifically mentioned in the notice, depends upon the construction that may be given to the 6th section of the act of the 21st of February, 1793, ch. 156, taken in connection with the notice. This section is substituted for the 6th section of the act of

¹ Grotius de J. B. ac. P. l. 3, ch. 20, s. 28.

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the 10th of April, 1790, ch. 34. The office of the [* 490] section, *in each of these acts, is two-fold : 1st. To state what shall constitute a defence. 2d. To state the manner in which the defendant may avail himself of it. And whatever difficulties may exist (if any there be) in the construction of the section, arise from the combination of this two-fold object. That this was the object of the section is perfectly obvious. The general issue would be a denial of the allegation contemplated by the 5th section of the act of 1793, and the 4th of the act of 1790. If the acts had stopped there, it is manifest that the defendant could have had no defence, but what was legally within the scope of the general issue. The 10th section would not have availed him, because, the limitation of time, and the grounds for repealing a patent upon a *scire facias*, are totally different from those which ought to constitute a defence to the action. The patent may be opposed, in an action, upon the ground that the patentee is not the *original* inventor ; but it can be repealed only upon the ground that he is not the true inventor. Fraud (proof that it was surreptitiously obtained) is the necessary basis in the one case ; but error and mistake is equally available in the other. Neither could the defendant avail himself of the provisions in the prior part of the act ; for these are merely *directory*, and they terminate in the provision made by the 5th section, which would have been conclusive. The 6th section is, therefore, a proviso to the 5th. The 6th section of 1790, made the patent *prima facie* evidence only, which would have opened the inquiry as to the *truth* of the invention. It appears, then, that the object of the [* 491] proviso was, in the first place, * to settle what should constitute a defence. These matters would not have been within the scope of the general issue, by the rules of pleading. They would have presented the subject of a special plea in bar. The act, therefore, at the same time pro-

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vides, that they may be given in evidence under the general issue. The design, in this respect, was to save the necessity of special pleading on the one hand, and, on the other, to give a reasonable notice. Does the law require the *evidence* to be set out? No; and yet, if surprise is to be fully guarded against, this ought certainly to be stated, in order that the plaintiff may prove that it is false, or proceeds from corrupt witnesses, &c. Is it then necessary that *all the particulars* should be given, the state, county, township, town, street, square, number of the house? The law does not require it. What certainty, then, is required in the notice? The answer is obtained by ascertaining the use and intention of the section, which were to save the necessity of special pleading. What then must be alleged in a special plea? Not the evidence or facts, but the matter of defence, which may be that the plaintiff was not the true inventor, but that the invention was before his supposed discovery. You must state what is the ground and essence of the defence, and nothing more; all else is surplusage. E. G. That the plaintiff was not the true inventor of the hopper-boy, but the same was in use, prior to his supposed discovery, *at the mill of A*. Now its being in use at *the mill of A* is not of the essence of the defence, for it is as good if used at the *mill of B*; the essence is, that it was used before. The *defendant then [* 492] would be entitled to lay the place under a videlicet, and of course would not be obliged to prove it, but might prove any other. If, then, the law did not mean to increase the difficulty of the defendant, the same may be done in a notice. Consider the inconveniences of a contrary practice. A machine has been used in a foreign country; the country, town, and place, may be *unknown*. Shall I, therefore, be deprived of the benefit of my invention? Again, *it is known*. I am bound to give thirty days' notice before trial, and no more. *Cui bono*, that I should mention a town or place in England?

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The intention is, that the plaintiff shall come prepared to prove where his invention was made, and not to disprove the defendant's evidence; that he shall have notice of the *kind* of defence intended, in order that he may shape his case accordingly. If notice is given that the defendant will give in evidence, that the plaintiff's machine was used before his supposed discovery; this is notice of special matter, tending to prove that it was not invented by him. The law does not require a *statement* or *description* of the special matter, but notice that special matter will be given in evidence, tending to prove certain facts. There is no reciprocity in the contrary rule. The declaration is general; it does not specify the *date* of the invention, the *place* of the invention, nor the *evidence* or *facts* by which the originality and truth of the invention are to be proved. Yet these are all extremely important to the defendant, to enable him to prepare his defence. As to the breach, it is equally general; it does not state the *time* except as a mere matter of form, by which the

[* 493] * plaintiff is not bound. It does not state the *place*, except by the very liberal description necessary for the venue, but which is not at all binding. And, finally, the rule contended for is impracticable, consistently with the purposes of justice; for it may, without any fault of the defendant, deprive him of the benefit of a perfectly good defence, upon a mere requisition of form, which he cannot possibly comply with. The notice states the use of the hopper-boy at a number of mills, specially described by the state, county, and the name of the proprietor, "and at sundry other places in the said State of Pennsylvania, the State of Maryland, and elsewhere in the United States." It is not alleged, nor could it be, that the defendant had the knowledge that would have enabled him to extend the specification. Nor is it alleged that he could have acquired the knowledge, by any exertion he might have made; on the contrary, the course he has

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taken is indicative of perfectly fair intention. The exception is, that the defendant was permitted to give evidence that the hopper-boy "had been used at sundry other mills in Pennsylvania," precisely in the words of the notice. To sustain this exception, then, the court must decide, that this cannot in *any case* be done. But if it cannot be shown, that in a single supposable case, this would work injustice, and defeat the law, it is sufficient. Now it is very clear, that in many cases, this may be precisely the state of the party's knowledge, and all he can obtain, and it may be precisely the state of the *evidence*. Suppose a witness should know that hopper-boys were used in sundry mills, but not their precise local *situation, name of owner, &c. Or, suppose he [* 494] should have seen a hopper-boy that bore the most evident marks of having been *used* in a mill, or mills. The *effect* of such evidence is quite another question ; its competency and relevancy are for the Court ; its credibility, and the inferences of fact that are to be made from it, are for the jury. The same supposition would apply to its having been described in a public work. Is it necessary to give the title of the book, name of the author, and number of the edition ? This may be impracticable. The defendant may have a witness who has seen the thing in use in a *foreign* country, and not be able to give a single particular ; or who has seen it described in a foreign work, of which he can give no further account. Such evidence, if *credited*, would be entirely conclusive ; and yet he could have no benefit of it, because he had not done what was impossible. But even if the witness knows all these particulars, the defendant has no means of compelling him to disclose them before the trial. The rules of pleading aim to establish a convenient certainty on the record, by giving the party notice of what is alleged, and furnishing evidence of what has been decided. In many instances, they fall short of this, their avowed design ; in none

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do they go beyond it. For the purpose of preventing surprise, they are wholly ineffectual; they give no notice of particular facts, of evidence, of witnesses. The corrective of the evil, if evil there be, is to be found in the exercise of the general superintending authority of the Court, applied to cases where there may really be surprise or fraud. So [* 495] in this case, if there really had been *surprise, (fraud is out of the question,) the court had the power to grant a new trial. This power is an amply sufficient corrective; and its existence affords a decisive answer to the argument drawn from the possible injustice that may be done.

2. The exception to the refusal to admit evidence of the payment for the use of licenses, will be easily disposed of. The *fact* to be established on the one side, and disapproved on the other, was, that the hopper-boy was in use before the alleged invention or discovery of Evans. The evidence offered had no bearing whatever upon the question of fact. If believed, it went no farther than to show, that those who had paid, thought it best to pay; a decision that might be equally prudent, whether the fact was, or was not, as alleged. Such testimony would be more objectionable than the opinion of the witness; for it would be only presumptive proof of opinion, without the possibility of examining its grounds. As *opinion*, it would be inadmissible; as evidence of opinion, it would still be more objectionable.

3. The plaintiff's patent can only be considered in one of three points of view. 1st. As a patent for the improvement in the art of manufacturing flour; that is for the combination. 2d. As a patent for the combination, and also for the several machines; that is, a joint and several patent. 3d. As a patent simply for the several machines. It is very clear that the patent itself is for the combination only; though it is equally clear, that by the terms of the law, he might have obtained a patent for the *whole*, and also for the *several parts*. That this is the

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necessary * construction of the patent, is plain from [* 496] the patent itself, taken in connection with the act of 21st of January, 1808, ch. 117. The act authorizes a patent to be issued for his *improvements* in the art of manufacturing flour, *and* in the several machines, &c. The matters are plainly different. They are the subject of distinct patents, to be obtained in the “*manner and form*” prescribed by the act of 1793, ch. 156. The object of the special act, was to put Evans upon the same footing as if his former patent had not been issued; but it did not mean to dispense with any of the requisites of the general law. With the general requisite (that he was the inventor) it could not dispense; the constitution did not permit it. By the general law, *improvement in an art*, and *improvement in a machine*, are distinct patentable objects. This patent is only for the improvement in the art of manufacturing flour, and the recital of the special act, and the words “which” and “said” do not at all help it. It is true, it is an improvement operated by means of the machines, but not exclusively. The result may be secured, without securing the means. This patent was granted to the plaintiff; was received by him; and must be presumed to be according to his application and his oath. The oath is, that he is the true inventor of the “*improvements* above specified;” which *term* is applied in the specification, as in the patent, only to the *art*. But, it is said the specification is a part of the patent, and limits or enlarges it, as the case may be. Mr. Justice Story, in the case which has been cited, only says, that the *specification [* 497] may control the generality of the patent.¹ But the specification in the case now before the Court, does not claim the machines. If the patent was for a combination, the plain-

¹ Whittemore v. Cutter, 1 Gallis. 437, ante, 35.

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tiff's action was gone ; he could not maintain it against a person using one of the machines. If the patent was for the combination, and also for the several machines, that is, a joint and several patent, then the patentee might proceed upon it as the one or the other, according to the nature of the alleged invasion. If he proceed upon it for a breach of the right to the combination, he must show the originality of invention, and might be defeated by opposite proof. If for a breach of the right to any one of the machines, he might be defeated by showing that he was not the original inventor of the machine. So if it be considered a several patent, that is, as if he had five distinct patents. But, in no conceivable case, can he stand upon any but one of these three grounds, nor claim to have the benefit of a larger, or even of a different patent.

4. From this analysis, which is necessary to prevent confusion, we come to inquire into the nature of the case presented to the Court for decision, and to which the charge was to be applied ; premising, 1st. That no exception can be taken to what the Court did not give in charge to the jury ; and, 2dly. That no exception can be taken to an opinion, however erroneous, that had no bearing upon the issue to be decided by the jury. It is apparent from the record, that the action

of the plaintiff was founded upon the alleged use, [* 498] * by the defendant, of a machine called a hopper-boy, of which the plaintiff claimed to be the inventor ; that the evidence on both sides applied to this allegation, and to this alone ; the plaintiff claiming to be the inventor, and the defendant denying it. The charge of the Court noticed the several arguments that had been used at the bar, and examined the general question as to the character of the patent ; upon which, however, as it had not been discussed, no opinion was given. This is clear ; for if an *opinion* had been expressed, it must have been that the action was not maintainable. Nothing short of *that* would have been mate-

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rial. But the Court left the case to the jury, as of an action that this was maintainable, and instructed them as to the principles by which it was to be decided; which negatives the conclusion of any opinion having been given, that the action was not maintainable. If the defendant had required the Court to charge that the action was not maintainable, and they had charged that it was, or declined to charge at all, he would have had ground of exception. But the plaintiff cannot complain, because he has what is equivalent to a decision in his favor. 5. The statute of James, (21 Jac. I. c. 3,) A. D. 1623, confined monopolies to the first and true inventors of manufactures not known or used before. One hundred and seventy years had elapsed when our act passed; commerce and the arts had made such advances, such facilities had been created for the diffusion of knowledge, that every thing known by use, or described in books, might be considered as common property. It would have been strange to adopt a * different principle. The act of [* 499] Congress does not. It is a mistake to suppose there is in this respect any difference between the Act of Congress and the Act of Parliament. One says "useful" inventions, the other "new and useful;" but both have the expression "not used or known before." A patent can only be upon an allegation that the applicant has invented something *new* and *useful*. Its *novelty* may certainly be questioned; perhaps its *usefulness*. But where the defence is, that the thing was known or used before, is it necessary to prove the usefulness of the thing so known or used? The act does not require it; nor is there any good reason why the patentee should be permitted to controvert it.

Mr. *Harper*, in reply, insisted, 1. That the Court below had erred in admitting testimony of the use of the plaintiff's machine in mills not specified in the notice. The statute

was not framed with a view to the benefit of the defendant alone. The notice to be given, is not that vague, indistinct, general notice, which is set up on the other side. It must be an effectual, useful notice ; such a notice as may put the patentee on his guard, and enable him to see what are the precise grounds of defence. It must be more specific than a mere transcript of the particular class of grounds of defence, such as suppression of parts, redundancy, &c. The circumstances of the *time*, the *place* when and where used, and by what *persons*, are essentially necessary in order to enable the patentee to meet the defence. The burden of proof [* 500] is, in effect, thrown upon the patentee ; and *the law intended that he should meet it fairly. Such a notice as that given in this case would not be good, if put into the form of a special plea. The degree of certainty required in a plea, in a statement of the *time* and *place* when and where material facts have happened, is one of the most difficult questions of the law ; but these circumstances must always be laid, and must be proved as laid, whenever it is essential to enable the other party to maintain his case. There is a distinction between the *matter of defence* and the *evidence* by which it is to be maintained. A notice of the particulars of the evidence is not required, but of the time and place where the former use of the machine in question occurred. Nor is this unreasonable ; for it is highly improbable that any body would be able to testify as to the minute particulars of an invention, without being able to remember in what work he had seen it described, or to state in what place and at what time he had seen it used. 2. The special act for the plaintiff's relief is a distinct, substantive, independent grant, declaring the plaintiff to be the original inventor, and as such, entitled to a patent. It contains no reference to the general Patent Law, nor does it reserve any right in others to contest the originality of his invention. The defendant,

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therefore, cannot say that the plaintiff is not the inventor, though he may deny that he has violated the plaintiff's rights as inventor. Congress is not confined by the constitution to any particular mode of determining the fact who are inventors or authors. It is true, a patent or copyright can only be granted to an inventor or author ; but the originality of the * invention or authorship may be deter- [* 501] mined by Congress itself, upon such testimony as it deems sufficient ; or by an administrative act, by the decision of some board or executive officer ; or, lastly, by a judicial investigation ; according as the legislative will may prescribe either of these several modes. The Act of Parliament, 15 Geo. 3, for the relief of Watt and Boulton, the inventors of the improved steam-engine, and extending the term of their patent for twenty-five years, contained an express provision that every objection in law competent against the patent, should be competent against the act, "to all intents and purposes, *except so far as relates to the term thereby granted.*"¹ The Act of Congress for the relief of Oliver Evans contains no such provision. The conclusion, therefore, is, that the legislature meant to *quiet* him in his claim, after he had so long enjoyed it, and in consideration of his peculiar merits, and of his former patent having been vacated for informality. 3. The Court below instructed the jury that the patent was not for any one machine, but for the combined effect of the whole ; though they concluded by leaving it upon the prior use, still the intimation that the action could not be maintained, even though the prior use of it was not proved, did not leave the fact to the jury free from bias. Though not a positive direction to the jury to find for the defendant, it had the effect of a nonsuit. The *wishes* of the grantee, and the *intention* of

¹ Hornblower v. Boulton, 8 T. R. 95, 97.

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the grantor, both extended, as well to a patent for [* 502] the several machines, * as to a patent for the combined effect of the whole. The word "improvement," though in the singular number, extends not only to the plaintiff's improvement in the art of manufacturing flour, but to his improvement in the several machines by means of which the operations of the art are conducted. This was a patent for an *improvement* on the particular machine in question, and not for its original invention. In this respect it is like that of Watt and Boulton for their improvement on the steam-engine. 4. The prior use, which is to defeat a patent, ought to be a *public* use. The defence here set up, under, the 6th section of the Patent Law of 1793, ch. 156, was, that the patentee was not the original discoverer, and that the thing had been in use, &c. But how else could it be shown that he was not the discoverer, but by showing that it had before been in *public* use? A mere secret furtive use would not disprove the fact of his being the original discoverer. If this were so, then the art of printing and gunpowder were not invented in Europe, because they had been before used in a sequestered corner of the globe, like China. But there is a distinction between a *first* discovery and an *original* discovery. The art of printing was *originally* discovered in Germany, though it was *first* invented in China. So the plaintiff would not cease to be the original inventor of the hopper-boy, even if it had been proved that another similar machine had been before privately used in a single mill. It ought, therefore, to have been left to the jury to find for the plaintiff, if they believed that the use was a secret use.

[* 503] * MARSHALL, C. J., delivered the opinion of the Court.

In this case exceptions were taken in the Circuit Court, by the counsel for the plaintiff in error.

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1st. To the opinion of the Court, in admitting testimony offered by the defendant in that Court.

2d. To its opinion in rejecting testimony offered by the plaintiff in that Court.

3d. To the charge delivered by the judge to the jury.

Under the 6th section of the act for the promotion of useful arts, and to repeal the act heretofore made for that purpose, the defendant pleaded the general issue, and gave notice that he would prove at the trial, that the improved hopper-boy, for the use of which, without license, this suit was instituted, had been used previous to the alleged invention of the said Evans, in several places, (which were specified in the notice,) or in some of them, "and also at sundry other places in Pennsylvania, Maryland, and elsewhere in the United States." Having given evidence as to some of the places specified in the notice, the defendant offered evidence as to some other places not specified. This evidence was objected to by the plaintiff, but admitted by the Court; to which admission the plaintiff's counsel excepted.

The 6th section of the act appears to be drawn on the idea, that the defendant would not be at liberty to contest the validity of the patent on the general issue. It therefore intends to relieve the defendant from the difficulties of pleading, when it allows him to give in * evidence matter [* 504] which does affect the patent. But the notice is directed for the security of the plaintiff, and to protect him against that surprise to which he might be exposed, from an unfair use of this privilege. Reasoning merely on the words directing this notice, it might be difficult to define, with absolute precision, what it ought to include, and what it might omit. There are, however, circumstances in the act which may have some influence on this point. It has been already observed, that the notice is substituted for a special plea; it is farther to be observed, that it is a substitute to which the

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defendant is not obliged to resort. The notice is to be given only when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course. He may still plead specially, and then the plea is the only notice which the plaintiff can claim. If, then, the defendant may give in evidence on a special plea the prior use of the machine at places not specified in his plea, it would seem to follow that he may give in evidence its use at places not specified in his notice. It is not believed that a plea would be defective, which did not state the mills in which the machinery alleged to be previously used was placed.

But there is still another view of this subject, which deserves to be considered. The section which directs this notice, also directs that if the special matter stated in the section be proved, "judgment shall be rendered for the defendant, with costs, and the patent shall be declared void." The notice

might be intended not only for the information of [* 505] the plaintiff, * but for the purpose of spreading on the record the cause for which the patent was avoided. This object is accomplished by a notice which specifies the particular matter to be proved. The ordinary powers of the Court are sufficient to prevent, and will, undoubtedly, be so exercised, as to prevent the patentee from being injured by the surprise.

This testimony having been admitted, the plaintiff offered to prove that the persons, of whose prior use of the improved hopper-boy the defendant had given testimony, had paid the plaintiff for license to use his improved hopper-boy in their mills since his patent. This testimony was rejected by the Court, on the motion of the defendant, and to this opinion of the Court, also, the plaintiff excepted.

The testimony offered by the plaintiff was entitled to very little weight, but ought not to have been absolutely rejected, Connected with other testimony, and under some circum-

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stances, even the opinion of a party may be worth something. It is, therefore, in such a case as this, deemed more safe to permit it to go to the jury, subject, as all testimony is, to the animadversion of the Court, than entirely to exclude it.

We come next to consider the charge delivered to the jury.

The errors alleged in this charge may be considered under two heads :

1st. In construing the patent to be solely for the general result produced by the combination of all the machinery, and not for the several improved machines, as well as for the general result.

2d. That the jury must find for the defendant, if they * should be of opinion that the hopper-boy [* 506] was in use prior to the invention of the improvement thereon by Oliver Evans.

The construction of the patent must certainly depend on the words of the instrument. But where, as in this case, the words are ambiguous, there may be circumstances which ought to have great influence in expounding them. The intention of the parties, if that intention can be collected from sources which the principles of law permit us to explore, are entitled to great consideration. But before we proceed to this investigation, it may not be improper to notice the extent of the authority under which this grant was issued.

The authority of the executive to make this grant, is derived from the general Patent Law, and from the act for the relief of Oliver Evans. On the general Patent Law alone, a doubt might well arise, whether improvements on different machines could regularly be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of those machines in combination. And if such a patent would be

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irregular, it would certainly furnish an argument of no inconsiderable weight against the construction. But the "Act for the relief of Oliver Evans" entirely removes this doubt. That act authorizes the Secretary of State to issue a patent, granting to the said Oliver Evans the full and exclusive right, in his invention, discovery, and improvements in the art of manufacturing flour, and in the several machines [* 507] * which he has invented, discovered, improved, and applied to that purpose.

Of the authority, then, to make this patent coextensive with the construction for which the plaintiff's counsel contends, there can be no doubt.

The next object of inquiry is, the intention of the parties, so far as it may be collected from sources to which it is allowable to resort.

The parties are the government, acting by its agents, and Oliver Evans.

The intention of the government may be collected from the "Act for the relief of Oliver Evans." That act not only confers the authority to issue the grant, but expresses the intention of the legislature respecting its extent. It may fairly be inferred from it, that the legislature intended the patent to include both the general result, and the particular improved machines, if such should be the wish of the applicant. That the executive officer intended to make the patent coextensive with the application of Oliver Evans, and with the special act, is to be inferred from the reference to both in the patent itself. If, therefore, it shall be satisfactorily shown from his application, to have been the intention of Oliver Evans to obtain a patent including both objects, that must be presumed to have been also the intention of the grantor.

The first evidence of the intention of Oliver Evans is furnished by the act for his relief. The fair presumption is,

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that it conforms to his wishes ; at least, that it does not transcend them.

The second, in his petition to the Secretary of State, * which speaks of his having discovered cer- [* 508] tain useful improvements, and prays a patent for them, “agreeably to the Act of Congress, entitled, an Act for the relief of Oliver Evans.” This application is for a patent coextensive with the act.

This intention is further manifested by his specification. It is not to be denied, that a part of this specification would indicate an intention to consider the combined operation of all his machinery as a single improvement, for which he solicited a patent. But the whole taken together, will not admit of this exposition. The several machines are described with that distinctness which would be used by a person intending to obtain a patent for each. In his number 4, which contains the specification of the drill, he asserts his claim, in terms, to the principles, and to all the machines he had specified, and adds, “they may all be united and combined in one flour-mill, to produce my improvement in the art of manufacturing flour complete, or they may be used separately for any of the purposes specified and allotted to them, or to produce my improvement in part, according to the circumstances of the case.”

Being entitled by law to a patent for all and each of his discoveries ; considering himself, as he avers in his specification and affirmation, as the inventor of each of these improvements ; understanding, as he declares he did, that they might be used together so as to produce his improvement complete, or separately, so as to produce it in part ; nothing can be more improbable, than that Oliver Evans intended to obtain a patent solely for their combined operation. His * affirmation, which is annexed to his specification, [* 509] confirms this reasoning. To the declaration that

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he is the inventor of these improvements, he adds, "for which he solicits a patent."

With this conviction of the intention with which it was framed, the instrument is to be examined.

The patent begins with a recital, that Oliver Evans had alleged himself to be the inventor of a new and useful improvement in the art of manufacturing flour, &c., by the means of several machines, for a description of which reference is made to his specification.

It will not be denied that, if the allegation of Oliver Evans was necessarily to be understood as conforming to this recital, if our knowledge of it was to be derived entirely from this source, the fair construction would be, that his application was singly for the exclusive right to that improvement which was produced by the combined operation of his machinery. But in construing these terms, the Court is not confined to their most obvious import. The allegation made by Oliver Evans, and here intended to be recited, is in his petition to the Secretary of State. That petition is embodied in, and becomes a part of the patent. It explains itself, and controls the words of reference to it. His allegation is not "that he has invented a new and useful improvement," but that he has discovered certain useful improvements. The words used by the department of State in reciting this allegation, must then be expounded by the allegation itself, which is made a part of the patent.

The recital proceeds, "which improvement has not been known," &c. These words refer clearly to the [* 510] *improvement first mentioned and alleged in the petition of Oliver Evans, and are of course to be controlled in like manner with the antecedent words, by that petition. This part of the recital is concluded by adding, that Oliver Evans has affirmed, that he does verily believe

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himself to be the true inventor or discoverer of the said improvement.

But the affirmation of Oliver Evans, like his petition, is embodied in the grant, and must, of course, expound the recital of it. That affirmation is, that he does verily believe himself to be the true and original inventor of the *improvements* contained in his specification.

In every instance, then, in which the word improvement is used in the singular number throughout the part of the recital of this patent, it is used in reference to a paper contained in the body of the patent, which corrects the term, and shows it to be inaccurate.

The patent, still by way of recital, proceeds to add, "and agreeably to the Act of Congress, entitled 'an Act for the relief of Oliver Evans,' which authorizes the Secretary of State to secure to him, by patent, the exclusive right to the use of such *improvement* in the art of manufacturing flour and meal, and in the several machines which he has discovered, improved, and applied to that purpose; he has paid into the treasury, &c. and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said *improvement*, and praying that a patent may be granted for that purpose."

*To what do the words "said improvement" [*511] relate? The answer which has been given at the bar is entirely correct. To the improvement mentioned in the statute and in the petition, to both of which direct reference is made. But in the statute, and in the petition, the word used is "*improvements*," in the plural. The patent, therefore, obviously affixed to the word improvement, in the singular, the same sense in which the plural is employed, both in the statute and in the petition. We are compelled from the whole context so to construe the word in every place in which it is used in the recital, because it is constantly

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employed with express reference to the Act of Congress, or to some document embodied in the patent, in each of which the plural is used.

When, then, the words "said improvement" are used as a term of grant, they refer to the words of the recital, which have been already noticed, and must be construed in the same sense. This construction is rendered the more necessary by the subsequent words, which refer for a description of the improvement to the schedule. It also derives some weight from the words "according to law," which are annexed to the words of grant. These words can refer only to the general Patent Law, and to the "Act for the relief of Oliver Evans." These acts, taken together, seem to require that the patent should conform to the specification, affirmation, and petition of the applicant.

It would seem as if the claim of Oliver Evans was rested at the Circuit Court, on the principle that a grant [* 512] for an improvement, by the combined operation * of all the machinery, necessarily included a right to the distinct operation of each part, inasmuch as the whole comprehends all its parts. After very properly rejecting this idea, the judge appears to have considered the department of State, and the patentee, as having proceeded upon it in making out this patent. He supposed the intention to be, to convey the exclusive right in the parts as well as in the whole, by a grant of the whole ; but as the means used are in law incompetent to produce the effect, he construed the grant according to his opinion of its legal operation.

There is great reason in this view of the case, and this Court has not discarded it without hesitation. But as the grant, with the various documents which form a part of it, would be contradictory to itself ; as these apparent contradictions are all reconciled by considering the word "improvement" to be in the plural instead of the singular number ; as

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it is apparent that this construction gives to the grant its full effect, and that the opposite construction would essentially defeat it, this Court has, after much consideration and doubt, determined to adopt it, as the sound exposition of the instrument.

The second error alleged in the charge, is in directing the jury to find for the defendant, if they should be of opinion that the hopper-boy was in use prior to the improvement alleged to be made thereon by Oliver Evans.

This part of the charge seems to be founded on the opinion, that if the patent is to be considered as a grant of the exclusive use of distinct *improvements [* 513] it is a grant for the hopper-boy itself, and not for an improvement on the hopper-boy.

The counsel for the plaintiff contends, that this part of the charge is erroneous, because, by the "Act for the relief of Oliver Evans," Congress has itself decided that he is the inventor of the machines for which he solicited a patent, and has not left that point open to judicial inquiry.

This Court is not of that opinion. Without inquiring whether Congress, in the exercise of its power "to secure for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries," may decide the fact that an individual is an author or inventor, the Court can never presume Congress to have decided that question in a general act, the words of which do not render such a construction unavoidable. The words of this act do not require this construction. They do not grant to Oliver Evans the exclusive right to use certain specified machines; but the exclusive right to use his invention, discovery, and improvements; leaving the question of invention or improvement open to investigation, under the general Patent Law.

The plaintiff has also contended, that it is not necessary for the patentee to show himself to be the first inventor or

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discoverer. That the law is satisfied by his having invented a machine, although it may have been previously discovered by some other person.

Without a critical inquiry into the accuracy with which the term invention or discovery may be applied to [* 514] any other than the first inventor, the Court * considers this question as completely decided by the 6th section of the general Patent Act. That declares that if the thing was not *originally* discovered by the patentee, but had been in use, or had been described in some public work, anterior to the supposed discovery of the patentee, judgment shall be rendered for the defendant, and the patent declared void.

Admitting the words "*originally* discovered," to be explained or limited by the subsequent words, still if the thing had been in use, or had been described in a public work, anterior to the supposed discovery, the patent is void. It may be that the patentee had no knowledge of this previous use or previous description ; still his patent is void ; the law supposes he may have known it ; and the charge of the judge, which must be taken as applicable to the testimony, goes no farther than the law.

The real inquiry is, does the patent of Oliver Evans comprehend more than he has discovered ? If it is for the whole hopper-boy, the jury has found that this machine was in previous use. If it embraces only his improvement, then the verdict must be set aside.

The difficulties which embarrass this inquiry are not less than those which were involved in the first point. Ambiguities are still to be explained, and contradictions to be reconciled.

The patent itself, construed without reference to the schedule and other documents to which it refers, and which are incorporated in it, would be a grant of a single improvement ;

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but construed with those * documents, it has been [* 515] determined to be a grant of the several improvements which he has made in the machines enumerated in his specification. But the grant is confined to improvements. There is no expression in it which extends to the whole of any one of the machines which are enumerated in his specification or petition. The difficulty grows out of the complexity and ambiguity of the specification and petition. His schedule states his first principle to be the operation of his machinery on the meal from its being ground until it is bolted. He adds "this principle I apply by various machines, which I have invented, constructed, and adapted to the purposes hereafter specified."

His second principle is the application of the power that moves the mill to his machinery.

The application of these principles, he says, to manufacturing flour, is what he claims as his invention or improvement in the art.

He asserts himself to be the inventor of the machines, and claims the application of these principles, to the improvement of the process of manufacturing flour, and other purposes, as his invention and improvement in the art.

The schedule next proceeds to describe the different machines as improved, so as to include in the description the whole machine, without distinguishing his improvement from the machine as it existed previous thereto ; and in his fourth number he says, "I claim the exclusive right to the principles, and to all the machines above specified, and for all the uses and purposes specified, as not having been heretofore known or used before I discovered them."

* If the opinion of the Court were to be formed [* 516] on the schedule alone, it would be difficult to deny that the application of Oliver Evans extended to all the machines it describes. But the schedule is to be considered

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in connection with the other documents incorporated in the patent.

The affirmation which is annexed to it avers, that he is the inventor, not of the machines, but of the improvements herein above specified.

In his petition he states himself to have discovered certain useful improvements, applicable to the art of manufacturing flour, and prays a patent for the same ; that is, for his improvements, agreeably to the Act of Congress, entitled, " an Act for the relief of Oliver Evans." After stating the principles as in his schedule, he adds, " the machinery consists of an improved elevator, an improved conveyor, an improved hopper-boy, an improved drill, and an improved kiln-dryer."

Although, in his specification, he claims a right to the whole machine, in his petition he only asks a patent for the improvements in the machine. The distinction between a machine and an improvement on a machine, or an improved machine, is too clear for them to be confounded with each other.

The Act of Congress, agreeably to which Evans petitions for a patent, authorizes the Secretary of State to issue one, for his improvements in the art of manufacturing flour, " and in the several machines which he has invented, discovered, improved, and applied to that purpose."

[* 517] * In conformity with this act, this schedule, and this petition, the Secretary of State issues his patent, which, in its terms, embraces only improvements. Taking the whole together, the Court is of opinion, that the patent is to be construed as a grant of the general result of the whole machinery, and of the improvement in each machine. Great doubt existed whether the words of the grant, which are expressed to be for an *improvement* or *improvements* only, should be understood as purporting to be a patent only for the improvements ; or should be so far controlled by

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the specification and petition, as to be considered as a grant for the machine as improved, or in the words of the schedule and petition, for "an improved elevator, an improved conveyor, an improved hopper-boy, an improved drill, and an improved kiln-dryer." The majority of the Court came at length to the opinion, that there is no substantial difference, as they are used in this grant, whether the words grant a patent for an improvement on a machine, or a patent for an improved machine; since the machine itself, without the improvement, would not be an improved machine. Although I did not concur in this opinion, I can perceive no inconvenience from the construction.

It is, then, the opinion of this Court that Oliver Evans may claim, under his patent, the exclusive use of his inventions and improvements in the art of manufacturing flour and meal, and in the several machines which he has invented, and in his improvements on machines previously discovered.

* In all cases where his claim is for an improve- [* 518] ment on a machine, it will be incumbent on him to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists.

Some doubts have been entertained respecting the jurisdiction of the Courts of the United States, as both the plaintiff and defendant are citizens of the same State. The 5th section of the Act to promote the progress of useful arts, which gives to every patentee a right to sue in a Circuit Court of the United States, in case his right be violated, is repealed by the 3d section of the Act of 1800, ch. 179, (xxv.) which gives the action in the Circuit Court of the United States, where a patent is granted "pursuant" to that act, or to the Act for the promotion of useful arts. This patent, it has been said, is granted not in pursuance of either of those acts, but in pursuance of the Act "for the relief of Oliver Evans."

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But this Court is of opinion, that the Act for the relief of Oliver Evans is engrafted on the general Act for the promotion of useful arts, and that the patent is issued in pursuance of both. The jurisdiction of the Court is, therefore, sustained.

As the charge delivered in the Circuit Court to the jury differs in some respects from this opinion, the judgment rendered in that Court is reversed and annulled, and the cause remanded to the Circuit Court, with directions to award a *venire facias de novo*, and to proceed therein according to law.

Judgment reversed.

[*519] *JUDGMENT. This cause came on to be heard on the transcript of the record of the Circuit Court for the district of Pennsylvania, and was argued by counsel. On consideration whereof, this Court is of opinion, that there is error in the proceedings of the said Circuit Court in this, that the said Court rejected testimony which ought to have been admitted ; and also in this, that in the charge delivered to the jury, the opinion is expressed that the patent, on which this suit was instituted, conveyed to Oliver Evans only an exclusive right to his improvement in manufacturing flour and meal, produced by the general combination of all his machinery, and not to his improvement in the several machines applied to that purpose ; and also, that the said Oliver Evans was not entitled to recover, if the hopper-boy, in his declaration mentioned, had been in use previous to his alleged discovery.¹ Therefore, it is considered by this Court, that

¹ There is evidently a mistake in this part of the certificate. It should be, as is manifest from the charge of the Circuit Court, the statement of the 2d question by the Chief Justice (*ante*, pp. 505, 506,) "that the hopper-boy was in use prior to the *invention* of the *improvement* thereon by Oliver Evans."

This is a MS. note made by Judge Story in a volume belonging to the Dane Law Library.

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the judgment of the Circuit Court be reversed and annulled, and that the cause be remanded to the said Circuit Court, with directions to award a *venire facias de novo*.¹

¹NOTE ON THE PATENT LAWS.

[Appendix. 3 Wheat. 655.]

THE patent acts of the United States are, in a great degree, founded on the principles and usages which have grown out of the English statute on the same subject. It may be useful, therefore, to collect together the cases which have been adjudged in England, with a view to illustrate the corresponding provisions of our own laws; and then bring in review the adjudications in the courts of the United States.

By the Statute of 21 Jac. I. ch. 3, commonly called the Statute of Monopolies, it is enacted, (§ 1,) "that all monopolies, and all commissions, grants, licenses, charters, and letters-patent, heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of any thing within this realm, or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give license or toleration to do, use, or exercise any thing against the tenor or purport of any law or statute, or to give or make any warrant for any such dispensation, license, or toleration, to be had or made, or to agree or compound with any others for any penalty or forfeiture, limited by any statute, or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money that is or shall be due by any statute, before judgment thereupon had; and all proclamations, inhibitions, straits, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing the same, or any of them, are altogether contrary to the laws of the realm, and so are and shall be utterly void and of none effect, and in no wise to be put in use or execution." The 6th section, however, provides, "that any declaration before-mentioned shall not extend to any letters-patent, and grants of privilege, for the term of fourteen years, or under, hereafter to be made, *of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others, at the time of*

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making such letters-patent and grants, shall not use, so as also they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters-patent, or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be if this act had never been made, and none other."

It is under this last section that patents for new and useful inventions are now granted in England; and by a proviso, or condition, always inserted in every patent, the patentee is bound particularly to describe and ascertain the nature of his invention, and in what manner the same is to be constructed or made, by an instrument in writing, under his hand and seal, and to cause the same to be enrolled in the Court of Chancery within a specified time. *Harmer v. Playne*, 11 East, 101; *Boulton v. Bull*, 2 H. Bl. 463; *Hornblower v. Boulton*, 8 T. R. 95; 2 Bl. Com. 407, note by Christian, (7.) This instrument is usually termed the specification of the invention; and all such instruments are preserved in an office for public inspection.

Upon the construction of the British Patent Act, taken in connection with the conditions inserted in the letters-patent, a great variety of decisions have been made. 1. As the statute contains no restriction confining the grants to British subjects, it is every day's practice to grant patents to foreigners, and no such patent has ever been brought into judicial doubt. 2. A patent can be granted only for a thing *new*; but it may be granted to the first inventor, if the invention be *new in England*, though the thing was practised beyond sea before; for the statute speaks of *new manufactures within this realm*; so that if it be new here, it is within the statute, and whether learned by travel or study is the same thing. *Edgeberry v. Stevens*, 2 Salk. 447; Hawk. P. C. b. 1, ch. 79, and see Noy, 182, 183. 3. The language of the statute is *new manufacture*; but the terms are used in an enlarged sense, as equivalent to new device, or contrivance, and apply not only to *things made*, but to the *practice of making*. Under *things made* we may class, in the first place, new compositions of things, such as manufactures in the ordinary sense of the word; secondly, all mechanical inventions, whether made to produce old or new effects; for a new piece of mechanism is certainly a thing made. Under *the practice of making*, we may class all new artificial manners of operating with the hand, or with instruments in common use, new processes in any art, producing effects useful to the public. When the effect produced is some new substance, or composition, it would seem that the privilege of the sole working, or making, ought to be for such new substance or composition, without regard to the mechanism, or process, by which it has

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been produced, which, though perhaps also new, will be only useful as producing the new substance. When the effect produced is no new substance, or composition of things, the patent can only be for the mechanism, if new mechanism is used; or for the process, if it be a new method of operating with or without old mechanism, by which the effect is produced. Per *Eyre*, Ch. J., in *Boulton v. Bull*, 2 H. Bl. 463, 492, and *Lawrence*, J., in *Hornblower v. Boulton*, 8 T. R. 95, 106. A patent, therefore, under certain circumstances, may be good for a *method*, as well as for an *engine*, or *machine*. Ibid. and 8 T. R. 95, 106; *Rex v. Cutler*, 1 Starkie's N. P. R. 354. 4. A patent cannot be for a mere principle, properly so called; that is, for an elementary truth. But the word principle is often used in a more lax sense, to signify constituent parts, peculiar structure, or process; and in specifications it is generally used in this latter sense; and in this view, it may well be the subject of a patent. Ibid. 5. It was formerly considered that a patent could not be for an improvement (3 Inst. 184); but that opinion has been long since exploded; and it is now held that a patent may well be for a new improvement. *Harmer v. Playne*, 14 Ves. 130; *Ex parte Fox*, 1 Ves. & Beames, 67; *Boulton v. Bull*, 2 H. Bl. 463, 488; 8 T. R. 95; Bull. N. P. 77. 6. A patent must be of such manufacture or process as no other did, at the time of making the letters-patent, use; for though it were newly invented, yet, if any other did use it at the time of making the letters-patent, or grant of the privilege, it is declared void by the act. 3 Inst. 184. And in a very recent case of a patent for a new mode of making verdigris, one of the objections was, that the invention was in public sale by the patentee, before the grant of the patent; and *Gibbs*, Ch. J., on that occasion said, "with respect to this objection, the question is somewhat new. Some things are obvious as soon as they are made public; of others, the scientific world may possess itself by analysis; some inventions almost baffle discovery. But to entitle a man to a patent, the invention must be *new to the world*. The public sale of that which is afterwards made the subject of a patent, *though sold by the inventor only*, makes the *patent void*. It is in evidence that a great quantity was sold in the course of four months, before the patent was obtained." And if the jury were satisfied of that fact, his lordship added, "that he thought the patent void." *Wood v. Zimmer*, 1 Holt's N. P. Rep. 58. 7. The invention must not only be new, but useful; for if it be contrary to law, or mischievous, or hurtful to trade, or generally inconvenient, it is, by the terms of the statute, void. 3 Inst. 184. 8. A patent can legally be granted only to the first and true inventor; for such are the descriptive terms of the statute. 3 Inst. 184. But if the original inventor has con-

fined the invention to his closet, and the public be not acquainted with it, a second inventor, who makes it public, is entitled to a patent. *Boulton v. Bull*, 2 H. Bl. 463, and *Dolland's patent*, cited 2 H. Bl. 470, 487. 9. The patent must not be more extensive than the invention; therefore, if the invention consist in an addition or improvement only, and the patent is for the whole machine or manufacture, it is void. *Buller's N. P.* 76; *Boulton v. Bull*, 2 H. Bl. 463, and cases there cited; *The King v. Else*, 11 East, 109, note; *Harmar v. Playne*, 11 East, 101; S. C. 14 Ves. 180. Therefore, where a patent was for the exclusive liberty of making lace composed of silk and cotton thread mixed, not of any particular mode of making it, and it was proved that silk and cotton thread were before mixed on the same frame for lace, in some mode or other, though not like the plaintiff's, the patent was held void, as being more extensive than the invention. *The King v. Else*, 11 Inst. 109, note. A person may obtain a patent for a machine, consisting of an entirely *new combination of parts*, although the parts may have been separately used in former machines; and the patent may correctly set out the whole as the invention of the patentee. But if a combination of a certain number of those parts have previously existed, up to a certain point, in former machines, the patentee merely adding other combinations, the patent should comprehend such improvements only. *Bevill v. Moore*, 2 Marshall's R. 211. 10. If a person has invented an improvement upon an existing patented machine, he is entitled to a patent for his improvement; but he cannot use the original machine until the patent for it has expired. *Ex parte Fox*, 1 Ves. & Beames, R. 67. 11. Although the specification is not annexed to a patent in England, and the patent contains a concise description only of the invention; yet, as there is a proviso in the patent, requiring the enrollment of a specification in chancery, within a specified time, and in default making the patent void, the patent is always construed in connection with the specification, and the latter is deemed a part of the patent, at least for the purpose of ascertaining the nature and extent of the invention claimed by the patentee. *Boulton v. Bull*, 2 H. Bl. 364; *Hornblower v. Boulton*, 8 T. R. 95. 12. Care should be taken that the specification comports with the patent; for otherwise it will not sustain the grant. For where a patent was obtained for an improved mode of lighting cities, it was held by *Le Blanc, J.*, that it was not supported by a specification, describing an improved lamp. The patent ought to have been for an improved street lamp. *Lord Cochrane v. Smethurst*, 1 Starkie's N. P. R. 205. No technical words, however, are necessary to explain the subject of a patent; but the the Court will construe the terms of the patent, and of the specifica-

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tion, in a liberal manner, and give them such a meaning as best comports with the apparent intention of the patentee. *Hornblower v. Boulton*, 8 T. R. 95; *Boulton v. Bull*, 2 H. Bl. 463. Therefore, where the patent was "for a method of lessening the consumption of steam and fuel in fire-engines," one objection was, that the patent was for a philosophical principle only, neither organized nor capable of being organized, whereas it ought to have been for a formed machine; a second objection was, that if it was a patent for a formed machine, it was for the whole machine, when the invention was only an improvement or addition to an existing machine. But the Court of King's Bench, on examining the specification were of opinion, that both of the objections were unfounded, although the terms of the specification were so doubtful and obscure as to have produced a division of opinion in the Court of Common Pleas. *Hornblower v. Boulton*, 8 T. R. 95; *Boulton v. Bull*, 2 H. Bl. 463. Both of these cases were very elaborately discussed, and contain more learning on the subject of patents than can be found in any other adjudication, and are, therefore, deserving of the most accurate attention of every lawyer. In both of them all the judges agreed, that a mere mistake in terms, or in the correct sense of words, would not vitiate a patent, if the Court could give a reasonable construction to the whole specification. Mr. Justice *Heath* said, "when a mode of doing a thing is referred to something permanent, it is properly termed an *engine*; when to something fugitive, a *method*." "If *method* and *machinery* had been used by the patentee as convertible terms, and the same consequences would result from both, it might be too strong to say that the inventor should lose the benefit of his patent by the misapplication of this term." "Method is a principle reduced to practice; it is, in the present instance, the general application of a principle to an old machine." "*A patent for an improvement of a machine, and a patent for an improved machine, are in substance the same.*" The specification would serve for both patents; the new organization of parts is the same in both." Mr. Justice *Rooke* said, "a new invented *method* conveys to my understanding the idea of a new mode of construction. I think those words are tantamount to fire-engines of a newly invented construction; at least, I think they will bear this meaning, if they do not necessarily exclude every other. The specification shows that this was the meaning of the words, as used by the patentee, for he has specified a new and particular mode of constructing fire-engines. It seems, therefore, but reasonable, that if he sets forth his improvement intelligibly, his specification should be supported, though he professes only to set forth the principle." Mr. Justice *Buller* said, "the method and mode of doing a thing are the same; and I think it is impossible to support a patent for

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a method only, without having carried it into effect, and produced some new substance." "When the thing is done or produced, then it becomes the manufacture which is the proper subject of a patent." The remarks of Lord Chief Justice *Ayre* have been already stated. He, however, considered the patent not to be for a fire-engine, but in effect for a *manner of working a fire-engine, so as to lessen the consumption of steam*; and, he added, "the specification calls a method of lessening the consumption of steam in fire-engines a *principle*, which it is not; the act (of parliament) calls it an *engine*, which perhaps, also, it is not; but both the specification and statute are referable to the same thing, and when they are taken with their correlative, are perfectly intelligible." "A narrower ground was taken in the argument, which was to expound the word *engine* in the body of this act, (meaning the special act of parliament for this patent,) in opposition to the title of it, to mean a *method*; and I am ready to say I would resort to that ground, if necessary, in order to support the patent, *ut res magis valeat quam pereat*." In the King's Bench, Mr. Justice *Lawrence* observed, "*engine* and *method* mean the same thing, and may be the subject of a patent. *Method*, properly speaking, is only placing several things, and performing several operations, in the most convenient order; but it may signify *contrivance*, or *device*; so may an *engine*; and, therefore, I think it may answer the word *method*. So, *principle* may mean an elementary truth; but it may also mean constituent parts." 13. The patent being granted upon condition that the invention is new, (at least in England,) and useful, and also that the patentee shall deliver and enrol in chancery a specification of his invention, it is *necessary* for the patentee to establish, by proof, when his invention is called in question in a suit, that he has complied with these conditions. If, therefore, the novelty or effect of the invention be disputed, the patentee must show in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this, on his part, is sufficient; and it is then incumbent on the defendant to falsify the specification. *Turner v. Winter*, 1 T. R. 602. 14. In respect to specifications, (objections to which form the most common, and indeed, usually, the most fatal defence to suits for infringements of patents,) several rules have been laid down. In the first place, a man, to entitle himself to the benefit of a patent of monopoly, must disclose his secret, and specify his invention in such a way, that others of the same trade, who are artists, may be taught to do the thing for which the patent is granted, by following the directions of the specification, without any new invention or addition of their own. *Rex v. Arkwright*, Bull, N. P. [77.] In the second place, he must so describe it that the

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public may, after the expiration of the term, have the use of the invention in as cheap and beneficial a way as the patentee himself uses it; and therefore, if the specification describe many parts of an instrument, or machine, and the patentee uses only a few of them, or does not state how they are to be put together or used, the patent is void. *Rex v. Arkwright*, Bull. N. P. [77]; *Harmer v. Playne*, 11 East, 101. So, if the patentee could only make the article with two or three of the ingredients specified, and he has inserted others which will not answer the purpose, that will avoid the patent. So, if he makes the article with cheaper materials than those which he has enumerated, although the latter will answer the purpose, the patent is void. *Turner v. Winter*, 1 T. R. 602. In the third place, if the specification be, in any part of it, materially false, or defective, or obscure and ambiguous, or give directions which tend to mislead the public, the patent is void. *Rex v. Arkwright*, Bull. N. P. [77]; *Turner v. Winter*, 1 T. R. 602. Therefore, where in a patent for trusses for ruptures, the patentee omitted what was very material for tempering the steel, which was rubbing it with tallow, Lord Mansfield held the patent, for want of it, void. *Liardet v. Johnson*, Bull. N. P. [76]; S. C. cited 1 T. R. 602, 608, per *Buller, J.* So, where a patent was for a new mode of making verdigris, and the specification omitted an ingredient, (aqua fortis,) which, though not necessary to the composition for which the patent was claimed, was a more expeditious and beneficial mode of producing the same effects, and was as such used by the patentee, Lord Ch. J. *Gibbs* held the patent void. *Wood v. Zimmer*, 1 Holt's N. P. R. 58. So, if the specification direct an ingredient to be used which will not answer the purpose, or is never used by the patentee, the patent is void. *Turner v. Winter*, 1 T. R. 602. So, if the patentee says, in his specification, he can produce three things by one process, and he fails in any one, the patent is void. *Turner v. Winter*, 1 T. R. 602. So, if the specification direct the same thing to be produced several ways, or by several different ingredients, and any of them fail, the patent is void. *Turner v. Winter*, 1 T. R. 602. In the 4th place, if the invention be of an improvement only, it is indispensable that the patent should not be more broad than the invention, and the specification should be drawn up in terms which do not include any thing but the improvement. *Boulton v. Bull*, 2 H. Bl. 463; Bull. N. P. 76; *Bovill v. Moore*, 2 Marsh. R. 211. And in the specification for such improvement, it is essential to point out precisely what is new and what is old; and it is not sufficient to give a general description of the construction of the instrument, without such distinction, although a plate be annexed containing detached and separate representations of the parts in which the improvement consists. There-

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fore, where a patent was "for certain improvements in the making of umbrellas and parasols," and the specification contained a minute description of the construction of them, partly including the usual mode of stitching the silk, and also certain improvements in the insertion of the stretches, &c., and throughout the whole specification no distinction was made between what was new and what was old, Lord *Ellenborough* said, "the patentee ought, in his specification, to inform the person who consults it, what is new and what is old. He should say, my improvement consists in this, describing it by words if he can, or, if not, by reference to figures. But here the improvement is neither described in words nor figures, and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was new and what was old. A person ought to be warned by the specification against the use of a particular invention." *M'Farlane v. Price*, 1 Starkie's N. P. R. 199. And it may be added, also, that the public have a right to purchase the improvement by itself, and not to be encumbered with other things, where the improvement is of the old machine. But where the patentee obtained a patent for a new machine, and afterwards another patent for improvements in the said machine, in which the grant of the former was recited, it was held, that a specification, containing a full description of the whole machine so improved, but not distinguishing the new improved parts, or referring to the former specification, otherwise than as the second recited the first, was sufficient. Lord *Ellenborough* on that occasion said, "it may not be necessary, indeed, in stating a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and then to apply to those the improvement; but on many occasions it may be sufficient to refer generally to them. As in the instance of a common watch, it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them." *Harmer v. Playne*, 11 East, 101; S. C. 14 Ves. 180. The case, also, of *Bovill v. Moore*, already cited, (2 Marsh. R. 211,) affords very important instruction on this point. In the fifth place, if a patentee in his specification sum up the principle in which his invention consists, if this principle be not new, the patent cannot be supported, although it appear that the application of the principle, as described in the specification, be new; for the patentee, by such summing up, confines himself to the benefit only of the principle so stated. *Rex v. Cutler*, 1 Starkie's N. P. R. 354. 15. If a patent is void, the patentee cannot enforce performance of a covenant for the observance of the exclusive right, entered into by the covenantor, in contemplation of the patent being good. *Hayne v. Maltby*, 3 T. R. 438. 16. The right of a patentee

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is assignable at law ; and upon such an assignment the assignee has the exclusive right to maintain an action for any infringement of the patent. See *Boulton v. Bull*, 2 H. Bl. 463. 17. Where the patentee has assigned his patent, in an action by the assignee against the patentee, for an infringement of the patent, the latter will not be permitted to aver against his deed that the invention is not new. *Oldham v. Langmead*, cited 3 T. R. 439. 18. Where the patent is void, from any of the causes before stated, the party sued for an infringement may, under the general issue, avail himself of any such matter in his defence. 19. Or the patent itself may be repealed by a *scire facias* by the king, upon the ground of fraud, or false suggestion. The mode of proceeding on *scire facias* may be seen in 2 *Saunders's Rep.* 72, Williams's note, (4,) s. 4.

These are the principal doctrines established in the English Courts, upon the subject of patents for new inventions. In respect to the adjudications under the patent laws of the United States, it is matter of regret that so few of them have been published ; but the following are the leading provisions of the act, and the principles which have been recognized as applicable to it. It may be convenient to follow the order of the Patent Act itself, and to arrange the decisions under the corresponding heads to which they properly belong.

The first Patent Act of the United States was passed in the year 1790, (Act of the 10th of April, 1790, ch. 34,) and was repealed by another act, passed in the year 1793, (Act of the 21st of February, 1793, ch. 11,) and this last act, as amended by the Act of 1800, (Act of the 17th of April, 1800, ch. 25,) constitutes the present general Patent Law of the United States. 1. By the first section of the Act of 1793, any citizen who has invented any new and useful *art, machine, manufacture, or composition of matter*, or any *new and useful* improvements therein, *not known or used before* the application, may, on application and petition to the Secretary of State, obtain a patent for the exclusive right and liberty of *making, constructing, using, and vending* to others to be used, the said invention or discovery, upon complying with the regulations of the act ; and the patent is required to recite the allegations and suggestions of the petition, and give a short description of the invention or discovery. The letters-patent, previous to their being issued, are to be examined by the Attorney-General, and are by him to be certified to be conformable to law, and are then to be recorded in the office of the Secretary of State. The Act of 1800, ch. 25, ss. 1, 2, extends this provision to aliens who have resided two years in the United States ; and also to the legal representatives and devisees of a person entitled to a patent, who dies before it is obtained. The original inventor of a machine, who has reduced his invention first

into practice, is entitled to a *priority of the patent-right* : and a *subsequent* inventor, although an original inventor, cannot sustain his claim, although he has obtained the first patent ; for *qui prior est in tempore, potior est in jure*. Woodcock v. Parker, 1 Gallis. R. 438 ; Odiorne v. Winkley, 2 Gallis. R. 51. And, therefore, every subsequent patentee, although an original inventor, may be defeated of his patent-right, upon proof of such prior invention put into actual use. Bedford v. Hunt, 1 Mason's R. ; for then the invention cannot be considered as *new*. If an inventor make a gift of his invention to the public, and suffer it to go into general use, he cannot afterwards resume the invention, and claim an exclusive right under a patent. Whittemore v. Cutter, 1 Gallis. R. 478. By *useful* invention, in the Patent Act, is meant an invention which may be applied to a beneficial use in society, in contradiction to an invention injurious to the morals, health, or good order of society, or frivolous and insignificant. Bedford v. Hunt, 1 Mason's R. ; Lowell v. Lewis, 1 Mason's R. It is not necessary to establish that it is in all cases superior to the modes now in use for the same purpose. Ibid. 2. By the second section, any person who shall have invented an improvement, shall not be at liberty to use the original discovery, nor shall the original inventor be at liberty to use the improvement. And the simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery. (See Odiorne v. Winkley, 2 Gallis. R. 51.) If the inventor of an improvement obtain a patent for the whole machine, the patent, being more extensive than the invention, is void. Woodcock v. Parker, 1 Gallis. R. 439 ; Whittemore v. Cutter, 1 Gallis. R. 478 ; Odiorne v. Winkley, 2 Gallis. R. 51. 3. By the third section, every inventor, before he can obtain a patent, is required to swear that he is the *true inventor* or *discoverer* of the art, machine, or improvement, for which he solicits a patent, and to deliver a *written description* of his invention, and of the manner of using, or process of compounding it, in such *full, clear, and exact* terms, *as to distinguish the same from all other things before known*, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle, or character, by *which it may be distinguished from other inventions* ; and he is to accompany the whole with drawings and written references, where the nature of the case admits of drawings ; or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is a composition of matter ; which description, signed by himself, and

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attested by two witnesses, is to be filed in the office of State; and the inventor is moreover to deliver a model of his machine, if the secretary shall deem it necessary. The patentee must describe, in his specification, with reasonable certainty, in what his invention consists; otherwise it will be void for ambiguity. If it be for an improvement in an existing machine, he must, in his specification, distinguish the new from the old, and confine his patent to such parts only as are new; for if both are mixed up together, and a patent is taken for the whole, it is void. *Lowell v. Lewis*, 1 Mason's R. The taking of the oath is directory to the party; but if, by mistake, the oath is not taken before the issuing of the patent, the patent is not thereby rendered void. *Whittemore v. Cutter*, 1 Gallis. R. 429.

4. By the fourth section, patentees may assign their rights, and, upon the assignment being recorded in the office of State, the assignee shall stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assignees in any degree. Where the patentee has assigned an undivided moiety of his patent-right, the action for an infringement of the right should be in the joint names of the patentee and the assignee. *Whittemore v. Cutter*, 1 Gallis. R. 429. But an assignee of the patent-right, by an assignment excepting *certain places*, is not an assignee entitled to sue within the act. *Tyler v. Tuel*, 6 Cranch, 324.

5. The third section of the Act of 1800 (which is a substitute for the fifth section of the Act of 1793) declares, that any person who, without the written consent of the patentee, &c., shall "*make, devise, use, OR sell,*" (the words of the fifth section of the Act of 1793, were, "*make, devise, AND use, or sell,*") the thing patented, shall forfeit three times the actual damages sustained by the patentee, &c., to be recovered by an action on the case, in the Circuit Court of the United States, having jurisdiction thereof. Upon this section it has been held that the making of a patented machine, *fit for use, and with a design to use it for profit*, in violation of the patent-right, is, of itself, a breach of this section, for which an action lies; but where the making only, *without a user*, is proved, *nominal* damages only are to be given for the plaintiff. *Whittemore v. Cutter*, 1 Gallis. R. 429, 478. If a *user* is proved, the measure of damages is the value of the use during the time of the user. *Ibid.* But the act gives the plaintiff a right to his *actual damages* only, and not to a vindictive recompense, as in other cases of tort. *Ibid.* And neither the price of, nor the expense of making, a patented machine, is a proper measure of damages in such case. *Ibid.* The sale of the materials of a patented machine by a sheriff, upon an execution against the owners, is not a sale which subjects the sheriff to an action under the third section of the Act of 1800. *Siwan v. Guild*, 1 Gallis. R. 485. In an action on this section, the jury are to find the *single dama-*

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ges, and the Court are to treble them. *Whittemore v. Cutter*, 1 Gallis. R. 479. 6. The sixth section authorizes the defendant to plead the general issue, and give this act, and any special matter, in evidence, of which *notice in writing* may have been given to the plaintiff *thirty* days before trial, tending to prove, (1) that the specification does not contain the whole truth relative to the discovery, or that it contains more than is necessary to produce the described effect, *which concealment, or addition, shall fully appear to have been for the purpose of deceiving the public*; (2) or that the patented thing was not originally discovered by the patentee, *but had been in use*, or had been described in some public work, anterior to the supposed discovery of the patentee; (3) or that he had surreptitiously obtained a patent for the discovery of another person; in either of which cases, judgment shall be rendered for the defendant, with costs, *and the patent shall be declared void*. Besides the points decided in the principal case in the text, (*Evans v. Eaton*,) the following are deserving of notice. It is clear, that this section does not include all the matters of defence which the defendant may be legally entitled to make; as, for instance, it does not include the case of the non-existence of the fact of infringement in any shape; the case of an assignment from the plaintiff, or a written license, or purchase from the plaintiff, or that the patentee is an alien not entitled to a patent; which are clearly bars to the action, upon the very terms of the act, as well as the general principles of law. *Whittemore v. Cutter*, 1 Gallis. R. 429, 435. So, if the specification do not describe the invention in clear and exact terms, so as to distinguish it from other inventions, but be so ambiguous and obscure that it cannot be with reasonable certainty ascertained for what the patent is taken, or what it includes, the patent is void for ambiguity; and the fact may be shown in his defence by the defendant. *Lowell v. Lewis*, 1 Mason's R. But if the invention is *definitely* described in the patent and specification, *so as to distinguish it from other inventions before known*, the patent is good, although it does not describe the invention in such full, clear, and exact terms, that a person skilled in the art, or science of which it is a branch, could construct or make the thing; unless such defective description or concealment *was with intent to deceive the public*. *Whittemore v. Cutter*, 1 Gallis. R. 429; *Lowell v. Lewis*, 1 Mason's R. In order to defeat a patent, it is not necessary to prove that the invention has previously been in *general use*, and generally known to the public. It is sufficient, if it has been previously known to, and put in use by, other persons, however limited in extent the use or the knowledge of the invention may have been. *Bedford v. Hunt*, 1 Mason's R. 7. The seventh section applies only to the cases of patents, under State authority, before the Constitution of the United

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States. 8. The eighth section applied only to applications then pending for patents, under the Patent Act of 1790. 9. The ninth section directs that, in cases of interfering applications for a patent for the same invention, the same may be referred to arbitrators, chosen by the applicants and the Secretary of State, whose award shall be final, "as far as respects the granting of the patent;" and if either of the applicants refuse to choose an arbitrator, the patent shall issue to the opposite party. It has been held that such an award is not conclusive in any other respect than as to the mere issuing of the patent; and that it decides nothing as to the right of invention, or other claims of either party, but that either party may contest, in a suit at law, the validity of the patent. *Stearns v. Barrett*, 1 Mason's R. 10. The tenth section provides that, upon oath or affirmation being made before the district judge of the district where the patentee, his executors, &c., reside, that any patent was obtained "*surreptitiously*, or upon *false suggestion*," (the words of the Act of 1790 are "*surreptitiously by* or upon false suggestion,") the district judge may, if the matter appear sufficient, at any time within three years after the issuing of the patent, grant a rule that the patentee show cause why process should not issue against him, to repeal the patent; and if sufficient cause be not shown, the rule shall be made absolute, and the judge shall order process to be issued against such patentee, &c., *with costs of suit*. And if no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by the Court for the repeal of the patent; and if the plaintiff fails in his complaint, the *defendant* shall recover costs. It has been held, that the proceedings upon the rule to show cause are summary; and that when it is made absolute, it is not, that the patent be repealed, but only that process issue to try the validity of the patent, on the suggestion stated in the complaint. That this process is in the nature of a *scire facias* at the common law, to repeal patents, and the issues of fact, if any, are to be tried, not by the Court, but by a jury; that the judgment upon this process is in the nature of a judgment on a *scire facias* at common law, upon which a writ of error lies, as in other cases, to the Circuit Court, where there is matter of error apparent on the record, by bill of exceptions, or otherwise. That the patent itself is slight, but *prima facie* evidence, in favor of the patentee, that it is his invention; that if it appear that he is but a joint inventor, and he takes out the patent as his *sole* invention, it is an obtaining of the patent upon *false suggestion* within the act. *Stearns v. Barrett*, 1 Mason's R. 11. The remaining sections of the act, (11, 12,) contain no matter of any general importance; the eleventh being directory only as to the fees of office, and the twelfth being a repealing clause of the Act of 1790.

Odiorne v. The Amesbury Nail Factory. 2 Mason.

ODIORNE v. THE AMESBURY NAIL FACTORY.

[2 Mason, 28.]

An inventor cannot, under the Patent Act of the United States, have two subsisting valid patents at the same time, for the same invention. The first patent, while it remains in full force and unrepealed, is an estoppel to any subsequent patent by the same person for the same invention, and the time of his exclusive right begins to run from that period.

THIS was an action of trespass on the case, brought by the plaintiffs against the defendants for the violation of a patent right obtained by one Jesse Reed, in the year 1814, for a new and useful improvement in machinery for cutting, griping, and heading nails of various sizes at one continued operation, and assigned by said Reed to the plaintiffs.

The defendants pleaded the general issue, and filed the following specification of special matter, to be given in evidence.

1st. That the machine, or combination of machinery claimed by the plaintiffs under the patent stated in the declaration in this cause, was not originally discovered by the said Jesse Reed, but by a certain Jacob Perkins, and that the said Jesse Reed has surreptitiously obtained the said [* 29] patent * for the discovery of another person, to wit, of the said Jacob Perkins.

2d. That the machine, or combination of machinery claimed by the plaintiffs under the patent stated in the said declaration, was not originally discovered by the said Jesse Reed, but was described in a public work anterior to the said supposed discovery, to wit, in a certain patent issued by the Secretary of State, to a certain Jesse Reed, dated the 16th day of September, 1810, and also in a certain patent issued to Guppy & Armstrong, assignees of Jacob Perkins, dated 14th of February, 1799.

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3d. That the discovery or invention contained or described in the patent stated in the said declaration, is contained or described in a certain patent issued to the said Jesse Reed, dated 16th of September, 1810, which is still unrepealed, and that a patent of the date last mentioned was granted to the said Jesse Reed, for the whole or part of the same invention or discovery patented by the patent stated in the said declaration.

4th. That the patent stated in the said declaration is broader than the discovery or invention of the said Jesse Reed, in this, that certain parts of the said alleged discovery or invention were in use prior to the said supposed discovery or invention; and there is nothing in the said patent by which the said parts can be distinguished from other parts, of which the said Jesse Reed may have been the inventor, and that the parts so in use before the said discovery are the following, to wit, the horns, conductor, clearer, and gauge.

5th. That the patent described in the plaintiff's declaration is also broader than the invention or discovery of the said Jesse Reed, in this, that a part of the improvement, alleged to have been invented and discovered by the said Jesse, consists in the combination and application of certain parts of the machine described in his said patent, and of certain mechanical powers, which combination and application were in use prior to his alleged discovery.

* 6th. That the improvements, alleged by the [* 30] plaintiffs to have been invented by said Reed, contain no new principle or application of principles, or mode of operation, or combination of machinery, not before known and in use.

7th. That the machine and combination of machinery, described in the plaintiff's patent and specification recited in the declaration, is the same with the machine and combination of machinery described in a certain patent and specifi-

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cation issued by the Secretary of State to the said Jesse Reed, dated 22d of February, A. D. 1807, which patent, at the Circuit Court of the United States for the district of Massachusetts, at the October term thereof, A. D. 1815, was adjudged to be vacated.

Evidence was produced by the defendants, in the opening of the defence, to prove that the plaintiffs, in the year 1810, had obtained a patent for the same invention and improvements contained in the patent, for a violation of which this action was brought, and this fact was not denied by the plaintiffs.

STORY, J. Independent of every other objection, there is one, which seems admitted in point of fact, and is certainly established in evidence, that is decisive against the plaintiffs. It appears that the plaintiffs obtained a patent in September, 1810, substantially for the same invention and improvements, which are contained in the patent on which they now sue. That patent remains in full force and unrepealed. It cannot be, that a patentee can have in use at the same time two valid patents for the same invention ; and if he can successively take out, at different times, new patents for the same invention, he may perpetuate his exclusive right during a century, whereas the Patent Act confines this right to fourteen years from the date of the first patent. If this proceeding could obtain countenance, it would completely destroy the whole consideration derived by the public for the

[* 31] * grant of the patent, namely, the right to use the invention at the expiration of the term specified in the original grant. I hold it to be the necessary conclusion of law that the inventor can have but a single valid patent for his invention ; and that the first he obtains, while it remains unrepealed, is an estoppel to any future patent for the same invention, founded upon the general Patent Act.

Kneass v. The Schuylkill Bank. 4 Wash.

The public have, by the first patent, acquired an inchoate interest, which cannot be defeated by any merely ministerial acts of the officers of the government.

George Sullivan, for the plaintiffs.

Benjamin R. Nichols, for the defendant.

* KNEASS v. THE SCHUYLKILL BANK. [* 9]

[4 Wash. 9.]

Quære, If printing on the back of bank-notes with *steel* plates, is an infringement of a patent for copper-plate printing on the bank-notes.

In actions for violating a patent-right, the defendant on the general issue, without notice, may give in evidence the Act of Congress without pleading it; also alienage, and a license to use the machine, may be so given in evidence. Copper-plate printing on the back of bank-notes is an art for which a patent may issue.

Under the general issue, without notice, the defendant cannot give in evidence any matters mentioned in the sixth section of the Act of Congress.

The meaning of the term "useful" in the Act of Congress.

On the general issue, without notice, the defendant may object to the plaintiff's recovery, on the ground that there is no specification, or that it is unintelligible; that the patent is broader than the discovery; that it is for an improvement which is not distinguished from the original invention; and that the suggestions of the petition are not recited in the specification.

A mistake in an expression, proved to be so by other parts of the specification, will not vitiate the patent.

It is unnecessary to describe in the specification what is in common use, and well known.

Merely describing in the specification the parts of the rolling press, and the *modus operandi*, do not make them parts of the thing granted.

THIS was an action for the violation of the plaintiff's patent-right. The whole case is stated in the charge.

WASHINGTON, J., charged the jury. This is an action to recover damages for a violation of the plaintiff's patent-right.

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The declaration states the granting of the patent to the plaintiff, as the inventor of a new and useful improvement in printing on the back or reverse face of bank-notes or bills, as an additional security against counterfeiture; and the breach laid in the declaration is, that the defendant did, without the consent or license of the plaintiff, make, devise, use, and sell the thing so invented, in violation, &c.

To this declaration the defendants have pleaded the general issue, without giving notice of any special matter intended to be offered in evidence.

The specification annexed to the patent sets forth with much precision the mode of *printing* copperplates, with a description of the rolling press employed in the operation; varying very little, if at all, from the common rolling press; and then concludes in the following terms, — “ the improvement or application I wish to secure, is, to print copperplate on both sides of the note or bill; or copperplate on one side and letter-press on the other; or letter-press on both [* 10] sides * of a bank-note or bill, as an additional security against counterfeiture.”

The first point which arises is that put in issue by the plea. Have the defendants, in point of fact, infringed the plaintiff's right? This is denied by the defendants, and the question to which this denial gives rise is strictly within the province of the jury to decide.

The nature and extent of the plaintiff's right have already been stated. The defendants admit that they have used bank-notes with prints impressed by *steel plates* on the reverse face, and letter-press on the face; but they deny that this is *copperplate* printing, as expressed in the patent. Upon this point the parties are at issue.

To aid the court and jury in this inquiry, books of science have been referred to, which, I must acknowledge, have shed much less light on the subject than might have been expected.

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In Rees's Encyclopedia, printing is divided into *common press* and *rolling press*, as general terms. The latter is said to be employed in taking off prints or impressions from *copper plates*, engraven or etched. The inquiry respecting the nature of copperplate printing is answered by a reference to *rolling-press printing*. The only conclusion which I can draw from all this is, that rolling-press printing was originally made from engravings on copper, and that the continued use of this metal for a great length of time rendered the term synonymous with rolling-press printing, which, nevertheless, appears to be the general term in contradistinction to common press printing. It would seem not improbable that copperplate printing became, in process of time, a term used to express printing from engravings, without reference to the metal on which the engravings were made, and continued to be so used until a late period, when the mode of engraving steel plates was discovered. Joubert, who, in his Dictionary of Arts and Sciences, describes a copperplate printer to be one who makes impressions from images or other works, engraved on copper, *pewter, or other matter*, seems in a great measure to countenance this supposition.

After all, it must be acknowledged that those authorities fall short of affording that degree of satisfaction upon which the judgment can safely rest; and it may, therefore, be more useful to inquire whether, in common parlance, amongst men acquainted with and practising this art, copperplate printing was generally understood, particularly about the year 1815, when this patent was granted, to include printing from engravings on steel or other metals, as well as copperplates? Aikins, Duffie, Coffin, and Miers, all whom are either engravers or printers from engravings, are relied upon by the plaintiff's counsel to prove the affirmative, and they also state that no man skilled in the art can distinguish one from the other; that it is the same art, and may be used indifferently by the

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same workman. The first witness is very positive that copperplate printing is used as the general term, without reference to the metal. The defendants rely principally upon the testimony of Bacon in opposition to these witnesses. [* 11] *It is for you to decide upon this evidence. I shall merely observe that it lies upon the plaintiff to satisfy your minds on this subject. Apparently, the two species of engravings are different; and besides this, the expressions in the specification are those of the plaintiff, and it therefore behooves him to explain and to clear them of ambiguity.

Secondly. It is contended by the plaintiff's counsel, that, even if copperplate does not include steel-plate printing, still the use of the latter by the defendants, applied to bank-notes, to produce the effect stated in the patent, is a mere evasion, and is virtually an infringement of his right.

Without admitting or denying this argument, because it is unnecessary to do either, the Court feels no difficulty in saying that, if the use of steel plates be an *improvement* upon printing from copperplates, for which a patent might have been obtained by the inventor, the use of the former by the defendants can with no propriety be considered as an infringement of the plaintiff's right, unless it has appeared that they have also used the plaintiff's improvement. The witnesses seem all to concur in the opinion that the improvement is considerable.

Should the opinion of the jury be unfavorable to the defendants upon the first point, objections of a nature purely legal are then made to the plaintiff's right of recovery.

It is contended that the patent is invalid, 1. Because it is for a thing not patentable under the Act of Congress; 2. Because the specification is ambiguous; and 3. Because the patent is broader than the invention.

But a preliminary question must be settled before the merits

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of these objections can be decided upon ; and that is, can these defences be made under the general issue merely ?

We agree with the defendants' counsel, that they may give in evidence the Act of Congress, without notice. But this permission does not allow evidence of special matter to be given, other than such as is mentioned in the sixth section, unless it can be admitted upon general principles of law, as included in the general issue.

The permission so frequently met with in statutes, to the defendant, to plead the general issue, and to give the statute in evidence, extends no farther than to exempt the defendant from the necessity of pleading the statute specially, which, where it is of a private nature, it would otherwise be necessary to do. But it extends no farther ; and as the question, whether a particular statute be of a public or private nature, is not always of easy solution, this permission is not unfrequently provided from abundant caution.

It has been decided, upon general principles, that certain matters of a special nature, other than those enumerated in the sixth section, may be given in evidence under the general issue, such as alienage in the plaintiff, and a license by him to use the patented invention. With these decisions we agree, and they show that mere surprise * on [* 12] the plaintiff forms no objection to such evidence, since the plaintiff might not suspect that such would be the nature of the defence.

We come now to the particular objections before noticed.

1. Can the defendant, upon the general issue, insist that the plaintiff's discovery is one for which a patent could not be granted ? This question may at once be answered by the solution of another. Is this a discovery of an *art*, machine, &c., or of an improvement in any art, machine, &c. ? If it be either, then it is the subject of a patent by the express words of the Act of Congress. What is the discovery for

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which this patent was granted? Printing with copperplates on the reverse face of bank-notes, &c. And can it be contended that this is not an art? Is not every species of printing an art?

But it is contended that printing, either with types or copperplate, is not new, but had been, long previous to plaintiff's invention, in common use; and, as applied to bank-notes for the purpose professed in the patent, that it is not useful. In answer to the first of these objections, it is conclusive to observe that the court and jury cannot *judicially* take notice of it, because it is precisely that kind of defence of which the plaintiff was entitled to notice. If the defendants, instead of pleading that matter specially, chose to avail themselves of the permission given by the sixth section of the act, to plead the general issue, they should have given notice to the plaintiff that they should give such matter in evidence.

2. To the second objection, it may be observed generally that it is always difficult to prove the entire worthlessness of any discovery, or of any article susceptible of use. If the plaintiff's invention correspond substantially with the thing used by the defendants, how can the latter be permitted to say that the thing so discovered and used is worthless?

In the case of *Lowel v. Lewis*, 1 Mason, 182, Mr. Justice *Story*, commenting upon this subject, lays it down that the law only requires that the invention should not be frivolous or injurious to the well being, good policy, and sound morals of society. "The word *useful*, therefore," he adds, "is incorporated into the act, in contradiction to mischievous or immoral." Now, can it be urged that this definition is at all applicable to the plaintiff's invention? Let this question be answered by the witnesses in this cause. Those for the plaintiff agree that the invention is a security against the counterfeiting of the notes; and even Mr. Wilson, the witness most relied upon by the defendants, concurs in the same

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opinion, where the middle part of the plate is used, as it appears to have been by the defendants.

3. Another objection, under this head, made to the patent, is, that it is for *an effect* only. But this is a mistake. The patent, as explained by the specification, is for copperplate, or copperplate and type printing on bank-notes, for the purpose of producing a particular effect, namely, security against counterfeits. The patent is not for *the [* 13] effect, but for the kind of printing by which that effect is produced.

The next objection to the validity of the patent is founded on certain alleged defects in the specification; and the first inquiry is, can any, and what defects in this instrument, be relied on as a defence under the general issue?

It is perfectly clear that the two enumerated in the sixth section of the act cannot be set up at the trial, unless due notice has been given to the plaintiff; these are, that the specification does not contain the whole truth relative to the discovery, or that it contains more than is necessary to produce the described effect, and this with a view to deceive the public.

But are there no other objections to the patent in relation to the specification, which may be urged under the general issue without notice? Suppose there be no specification at all; would not this be such a defect in the plaintiff's title, apparent upon the face of the patent itself, as to turn him out of court, upon a plea which merely puts that title in issue? We strongly incline to think that it would be. The third section requires that a written description of the invention, &c., should be delivered *before the inventor can receive a patent*. Has the Secretary of State any authority to issue the patent, unless this prerequisite be complied with? We think not; and if this conclusion be correct, it follows that the patent, which is the only evidence of the plaintiff's title,

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is invalid. Without the specification, there would, in most cases, be a total failure of the consideration for which the monopoly is granted; as no person could guard himself against an infringement of the patent while it continues in force, or be enabled to use the invention after its termination. The same reason would seem applicable to a specification altogether ambiguous and unintelligible; because the same section requires not only a specification, but that it should be expressed in terms, full, clear, and exact.

If the defendant cannot, under the general issue, object to such a specification, I do not perceive in what other way he could avail himself of it, as it is not one of the cases provided for by the sixth section; nor do I see how it could well be made the subject of a special plea.

Before I take leave of the question, what defence may be made under the general issue without notice, it may be proper to refer to some others which are of frequent occurrence — such as that the patent is broader than the discovery; that it is for an improvement which the specification does not so particularly describe as to distinguish it from the original invention; that the suggestions of the petition are not recited in the patent; and perhaps others similar in principle.

We come now to the inquiry whether the specification in this case is chargeable with the defects imputed to [* 14] it. These are, first, that * it speaks of *printing* copperplates. The answer to this objection is, that the term *printing* is an error of expression apparent on the face both of the patent and specification, by which no person could be misled. The first describes the invention to be an improvement in *printing* on the reverse face of bank-notes; and the latter, when it describes the nature of the plaintiff's claim, speaks of *printing* copperplate.

The next objection to the specification is the omission to describe the mode of printing *letter-press*, which, it is con-

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tended, was as necessary as it was to describe the mode of copperplate printing.

It may safely be admitted that the one was as necessary as the other ; but it is very clear that neither was so, as both modes of printing are well known by persons acquainted with copperplate and type printing, and, of course, neither required a description.

The last objection made to the patent, is, that the description of the rolling press, given in the specification, makes it part of the thing granted, and, consequently, the patent is broader than the invention, which, it is not pretended, extends to the rolling press.

It is very true that the specification, with unnecessary minuteness, describes the rolling press, which is always used in copperplate printing, and also the *modus operandi*. But then it concludes by declaring for what it is the plaintiff claims a patent, and this claim has no reference to the press.

The last objection made to the plaintiff's right of recovery, is, that his action will not lie against a corporation.

No cases were cited by the counsel in support of this objection, and we have had no opportunity to refer to any. The general rule certainly is that corporations are not liable to be sued in actions of tort ; but it by no means follows that they may not be sued in actions on the case for injuries done to the rights of others, notwithstanding the plea is not guilty.

We incline strongly to the opinion, that where a corporate body, acting in that character, directs an act to be done which infringes the right of another, they may be sued in this form of action ; and in this case we shall so decide.

If the jury should find a verdict for the plaintiff, the only remaining inquiry for them will be as to the damages. The Act of Congress has provided a general rule for their government, from which they cannot depart ; but its application to the particular case is frequently difficult and embarrassing.

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The plaintiff is entitled to be compensated for *the damages he has sustained* by the infringement of his right. What that is, it will not be easy for the jury to estimate, as no evidence upon that subject has been given to them ; for it should be noticed that all the evidence applicable to this subject relates to the bills used by the defendants. As to the plaintiff's invention, neither the plates nor any impressions from them have been laid before the jury. All that you can know is that the defendants have issued bank-notes with [*15] *steel-plate printing on the backs of them, as a security against counterfeits. But what the particular device intended by the plaintiff is, or how far it is calculated to produce the same result with that used by the defendants, cannot be easily perceived by the jury. Wilson stated that he considered the impression made *with the middle piece* to be a security against counterfeiting the notes ; but without it, a mere impression on the back of the notes was, in his opinion, of no use.

Verdict for three cents damages.

Charles Ingersoll and Phillips, for plaintiff.

Bradford, Joseph Ingersoll, and Smith, for defendants.

PAUL MOODY v. JONATHAN FISKE ET AL.¹

(2 Mason, 112.)

Where a patent is for several improvements in a machine, and each improvement is summed up in the patent as the invention of the patentee, he is bound by his summary, and if any one of the improvements is found not to be new, his patent is void.

¹ See Peterson et al. v. Wooden, *post*; and ninth section of the act of 3d March, 1837.

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Where several improvements in a machine are distinctly claimed in a patent, an action lies for the piracy of any of the improvements, although the defendants have not used the whole of the improvements.

CASE for an infringement of certain patent rights granted to the plaintiff. There were two counts on two distinct patents in the declaration, but the first was the only one relied on at the trial, being on a patent for "an improvement on the double speeder for roping cotton," &c. The cause was tried on the general issue. The patent was dated the 3d of April, 1819, and the specification annexed to it, contained a very minute description of the double speeder as improved by the plaintiff under distinct articles. In the first article the plaintiff states, "the first part of my invention is a new position of the rollers," which he then proceeds to describe.

In the sixteenth article, the plaintiff sums up his improvements in the following terms. "The above description exhibits all my improvements in the roping machine for roping * cotton, whether called a double speeder [* 113] or by any other name. The parts which I claim as new, and as my invention, are the following:—1st. The position of the rollers. 2d. The two upper cones, with all the mechanism and motions connected with or dependent on them. 3d. The method of moving the belt on the lower cones, and that of communicating motion from the lower driven cone to the spindles, and all the mechanism and method of communicating motion from the upper driven cone to the arbors or axes of the perpetual or endless screws and perpendicular racks, which raise and lower the spindle rail; but I do not claim the said racks and screws, as these, as well as the common heart wheels, have each before been, or may be, used for the same purpose, and either may be applied to my improvement. 5th. The method and machinery by which the said motion of the spindle rail is

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changed from an ascending to a descending movement, and the manner of connecting the same with the wagon carriage. 6th. The said wagon, wagon carriage, gallows frame, catch wheels, the cycloid or cycloidal cam, slides, lever, and pulley shaft, which raise the belts on the upper cones, and all the similar parts which raise the belts on the lower cones, (except the cycloid or cycloidal cam) with all the parts, movements, and mechanism connected with the same. 7th. The flier tubes and methods of applying and using the same. 8th. The rotary motion of the cams, and the intermediate gear work and machinery which produces it."

The seventeenth article then proceeds. "The machine referred to, and from which the description of my improved double speeder is made, as above set forth, has twenty spindles, and produces roping of a convenient size and twist for being afterwards spun into a certain kind of thread or yarn; but I also contemplate the nature and principles of my said invention as applicable to any machine for the like purpose, whether it has more or less spindles, or made to give a greater or less degree of twist. And I do not consider my [* 114] said invention * as confined to any particular form, position, kind of material, degree of velocity, shape, magnitude, or position of the several parts, but the same may be applied to any machine made of iron, brass, copper, or other suitable metal or material; and all the parts above described and set forth may be extremely varied to obtain the object for which similar machines have been, are, or may be used or employed. The position of the rollers, which I consider as an important improvement, may be applied to any machine for spinning as well as for roping, and I have applied it to an improved spinning and filling frame, a description and drawing of which I have prepared for procuring a patent."

The cause was argued by *Gorham* and *Webster*, for the plaintiff, and by *G. Sullivan*, for the defendants.

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The defence at the trial turned mainly on two points. 1st. That the machines used by the defendants were not identical with those of the plaintiff. 2d. That part of the improvements claimed by the plaintiff were known before, and so the patent was broader than the invention, and void.

The counsel for the defendants contended on these points, following the enumeration of the improvements in the 16th article of the patent. 1st. That the position of the rollers was not new. 2d. That the plaintiff had no right to the two upper cones, they not being his invention. And as to the machinery connected with them, it was not used by the defendants. 3d. That the method of moving the belt of the lower cones, and the mechanism connected with it, were not used by the defendants. 4th. That the method of communicating motion from the upper driven cone to the arbors or axes, of the perpetual or endless screws, and perpendicular racks, &c., were not used by the defendants. The same answer was given to the 5th, 6th, and 7th improvements, specified in the 16th article. 8th. That the rotary motion of the *cones, and the intermediate gear [* 115] work and machinery, were not new.

The proof in the cause being very strong, that the position of the rollers was not new, two questions arose. 1st. Whether the plaintiff was concluded by the summing up in his patent, from contending that the position of the rollers was not a substantial part of his invention, or was not *per se* patentable. 2d. If not so precluded, and if the patent was not void, whether the defendants were not liable in this action, if they used any one of the plaintiff's improvements, although the proof should be satisfactory that they did not use all the improvements.

STORY, J. Upon the last point, there has hitherto been considerable difficulty in my mind. But after a good deal of

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reflection on it, I have come to the result, that where the plaintiff claims, as in this case, several distinct and independent improvements in the same machine, and procures a patent for them in the aggregate, he is entitled to recover against any person who shall use any one of the improvements so patented, notwithstanding there has been no violation of the other improvements. In such case, the patent goes for the whole of the improvements, and if each be new, and be claimed distinctly in the patent, as such, there does not seem any good reason why the party who pirates any part of the invention should not be liable in damages. Take the case of a copyright. It has never been supposed that, in order to maintain an action, the whole book should be pirated. It has been adjudged sufficient if a considerable part of the book be pirated, so that such part be that on which the plaintiff is truly and substantially the author.¹ To be sure, a mere extract would not be piracy; but if the substance of the work be taken, or so large a portion of it as makes it a [* 116] substitute for * the original, and materially injures the literary property of the author, it has been thought to be actionable.²

There is no doubt that, by the law of England, a party who pirates any part of the invention of the patentee is liable in damages, notwithstanding he has not violated the whole. I say pirates any part of the *invention*, for any person may lawfully use any machinery, combined with the patentee's invention, which he does not claim as new, or which, if so claimed, has been previously known and used. This is the doctrine in *Bovill v. Moore*,³ which was an action for the violation of a patent "for a machine for the manufacture of bobbin lace or twist net, similar to and resembling the Buckinghamshire

¹ *Carey v. Longman*, 1 East, R. 358, and cases there cited.

² *Rowarth v. Wilkes*, 1 Camp. R. 94.

³ 2 Marsh. R. 211; S. C. Davies on Patents, 211.

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lace net, and French lace net, as made by the hand with bobbins on pillows." Lord Chief Justice Gibbs there said, — "We must consider what the patent proposes to give to the patentee, and what privileges he would possess under the patent. Now the patentee is entitled to the sole use of this *machine*, and whoever imitates it, either in whole or *in part*, is subject to an action at the suit of the patentee." The defendants had used the invention *in part*, but obtained a verdict upon the ground that the plaintiff had not invented the whole machine, but had only made improvements in it, the combination having existed up to a certain point before, and therefore his patent was void, as covering more than his invention. It may be that the decisions have turned upon the peculiar language of the English patents, for in all the precedents which I have seen, the patent gives the exclusive right of the whole invention, and prohibits all other persons, "directly and indirectly, to make, use, or put in practice the said invention, *or any part of the same, &c.*, or in any wise to counterfeit, imitate, or resemble the same, or make or cause to be made any addition thereto, in subtraction from the * same."¹ But as no such intimation is given [* 117] in the reports, I incline to believe that the doctrine stands upon the general principles of law, that he who has the exclusive right to the whole of a thing, has the same right to all the parts which the general right legally includes, that is, (in cases like the present,) to all the parts which he has invented.

The principal difficulty that arises is in the application of the doctrine, and that may in most cases be removed by considering the nature and extent of the patent, or rather of the thing invented and patented. Where the patent goes for the whole of a machine as a new invention, and the machine is

¹ See forms in Collier on Patents, 54, 57, and Davies on Patents, 27, 30.

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in its structure substantially new, any person who pirates a part of the machine, substantially new in its structure, deprives the inventor so far of his exclusive right in his invention, and may in a great measure destroy the value of the patent. Where the patent is for several distinct improvements in an existing machine, or for an improved machine, incorporating several distinct improvements, which are clearly specified, then if a person pirates one of the improvements, he violates the exclusive right of the patentee, for the patent is as broad as the invention, and the invention covers all the improvements; and it is a wrong done to the patentee to deprive him of his exclusive right in any of his improvements. Where a patent is for a *new combination* of existing machinery or machines, and does not specify or claim any improvements or invention, except the combination, unless that combination is substantially violated, the patentee is not entitled to any remedy, although parts of the machinery are used by another, because the patent, by its terms, stands upon the *combination* only. In such a case, proof that the machines, or any part of their structure existed before, forms no objec-

tion to the patent, unless the *combination* has existed before, * for the reason that the invention is limited to the combination. And yet if the combination itself be not wholly new, but up to a certain point has existed before, and the patentee claims the whole combination as new, instead of his own improvements only, as by taking out a patent for the whole machine, doubtless his patent is void, for it exceeds his invention.¹ But if there be different and distinct improvements constituting parts of the combination, which are specified as such in the patent and specification, and any one of them be pirated, the same rule

¹ Bovill v. Moore, 2 Marsh. R. 211; Davies on Patents, 361, 398, 404, 511.

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seems to apply as in other cases where part of an invention is pirated, for the patent then shows that the invention is not limited to the mere combination, but includes the particular improvements specified.

It is often a serious difficulty, from the obscure language of the specification, to ascertain what is the nature and extent of the invention claimed by the patentee. Whether his patent be valid or not must materially depend upon the accuracy and distinctness with which the invention is stated. But in all cases where the patentee claims any thing as his own invention, in his specification, courts of law cannot reject the claim; and if included in the patent, and found not to be new, the patent is void, however small or unimportant such asserted invention may be. This leads me to the first point made at the bar, as to which it appears to me clear, both upon principle and authority, that where a patentee in his specification states and sums up the particulars of his invention, and his patent covers them, he is confined to such summary; and he cannot afterwards be permitted to sustain his patent by showing that some part which he claims in his summing up as his invention, though not in fact his invention, is of slight value or importance in his patent.¹ His patent covers it, *and if it be not new, the patent must be void. [* 119] Here the plaintiff claims a particular position of machinery as his invention, and it clearly appears in evidence that the position is not new. It has existed before, not in machines exactly like the present, but in machines applied to analogous purposes, namely, in machines for roping cotton, and applied for the same purpose as the plaintiff applies them. Without doubt he supposed that he was the first inventor;

¹ Rex v. Cutler, 1 Starkie, R. 354; Davies on Patents, 398, 404; Bovill v. Moore, S. C. 2 Marsh. R. 211.

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but that was his mistake, and will not help the case. The objection, therefore, is fatal.

I wish it to be understood, in this opinion, that though several distinct improvements in one machine may be united in one patent, it does not follow that several improvements in two different machines, having distinct and independent operations, can be so included. Much less that the same patent may be for a *combination* of different machines, and for distinct improvements in each.

The plaintiff, upon this intimation, agreed to take a verdict against him, declaring his patent void, that he might obtain a new patent.

Verdict for defendants.

BOSTON MANUFACTURING COMPANY v. JONATHAN FISKE AND ANOTHER.¹

[2 Mason, 119.]

The jury may, if they see fit, in a case for infringing a patent, give the plaintiff, as part of his "actual damage," such expenses for counsel fees, &c., as have been necessarily incurred in vindicating the plaintiff's right by a suit, and which are not taxable in the bill of costs.

CASE for infringing a patent for "a new and useful improvement of a spinning frame for spinning cotton," invented by Paul Moody, and assigned by him to the plaintiffs. The patent was dated the 17th of January, 1818, and [* 120] the assignment * the 14th of January, 1819. The cause was tried upon the general issue, and the

¹ See *Stimpson v. The Railroads*; *post*.

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principal question was, whether the patentee was the original inventor, it being contended that machines, of substantially the like structure, were known and used before the plaintiff's supposed invention ; and the defendants' counsel cited Rees's Cyclopædia, article Dressing Machine, vol. 40, pt. 1. A question, however, of law arose at the trial, whether the jury might include in the damages, if their verdict was for the plaintiff, counsel fees and other necessary expenses incurred at the trial, which were not within the taxable costs.

STORY, J. In one of the earliest cases which came before me, after my advancement to the bench, this very question arose, and at the trial I decided that counsel fees and other necessary expenses, not included in the taxable costs, were proper to be allowed by the jury, if they saw fit, as part of the "actual damage" of the plaintiff, within the contemplation of the Patent Act. But upon a motion for a new trial, the Circuit Court felt itself constrained, upon the authority of *Arcambal v. Wiseman*, 3 Dall. 306, very much against its own judgment, to declare the contrary doctrine.¹ Since that period, I have not been able, upon inquiry, to learn that any of my brethren hold to so rigid a rule, or have felt themselves bound to limit the discretion of the jury, as to an allowance of items of this nature. Nor can I now deem *Arcambal v. Wiseman*, an authority on which one ought to repose, in a case of this sort, without very serious doubts. The case appears to have been decided on this point, without much argument, and is very imperfectly reported. I have examined the original record. It was a libel filed by the Spanish consul for restitution of a Spanish vessel, captured

¹ *Whittemore v. Cutter*, 1 Gallis. R. 429, *ante*, 18.

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by an armed French vessel, on the high seas. The [* 121] District * Court dismissed the libel, and awarded damages for the delay, &c., to the *captors*. The Circuit Court affirmed the decree, and it was afterwards on error affirmed by the Supreme Court; but a charge of \$1,600 for counsel fees, appearing on the record to have been allowed as part of the damages, the Supreme Court disallowed this item, declaring the general practice of the United States to be in opposition to it, and if that practice were not strictly correct in principle, it ought to be respected until changed by statute. It is to be observed, that this was an admiralty or prize suit. In cases of marine torts, or illegal captures, it is far from being uncommon in the admiralty to allow costs and expenses, and to *mulct* the offending parties, even in exemplary damages, where the nature of the case requires it. In prize causes it is the usual course to allow the captors their costs and expenses upon restitution being decreed, where the original capture is justifiable, or farther proof is required. It can hardly be presumed, that the Court alluded to cases of this nature — to cases of admiralty and prize jurisdiction, for it is scarcely possible that any general uniform practice had been adopted in the United States, at so early a period; and if it had been, it must have been founded on a want of accurate knowledge of the principles and doctrines of Courts of Admiralty on this subject. Courts of Admiralty allow such items, not technically as costs, but upon the same principles, as they are often allowed damages in cases of torts, by Courts of Common Law, as a recompense for injuries sustained, as exemplary damages, or as a remuneration for expenses incurred, or losses sustained, by the misconduct of the other party. The Court, in the remarks imputed to them by the reporter, must have referred only to the general practice in the Courts of Common Law in the United States, not to tax counsel fees in the bill of costs; a

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practice of the propriety of which, as a general rule, no doubt could be entertained. And in the case then before them, the Court may very properly have disallowed the charge, for reasons *applicable to the particular [* 122] predicament of that case. In any other view, it would be impossible to reconcile the case of *Arcambal v. Wiseman*, with the general doctrines of Admiralty Courts, or with the more recent and well established practice of the Supreme Court in cases of marine torts and prize.¹ I feel myself bound, therefore, to declare, that as the authority of *Arcambal v. Wiseman* is shaken so far as it can be considered as containing any general doctrine, governing cases of this nature, I return to what I originally considered the true doctrine ; and that is, that the jury are at liberty, if they see fit, to allow the plaintiff as part of his “actual damage,” any expenditure for counsel fees, or other charges, which were necessarily incurred to vindicate the rights derived under his patent, and are not taxable in the bill of costs.

Verdict for plaintiffs, \$630, single damages.

Gorham and Webster, for plaintiffs.

G. Sullivan, for defendants.

A motion was afterwards made for a new trial, for misdirection on this point, which was refused by the Court, and judgment given for the plaintiffs for the treble damages.

¹ *The Amiable Nancy*, 3 Wheaton, 559 ; *The Mary*, 9 Cranch, 126, 151 ; *The Venus*, 5 Wheaton, 127, 131 ; *The London Packet*, 5 Wheaton, 132, 143.

Dixon v. Moyer. 3 Wash.

DIXON v. MOYER.

[4 Wash. 68.]

Action for violation of the plaintiff's patent for an improvement in the manufacture of saddles.

Upon the plea of not guilty the plaintiff must prove, not merely that the defendant had made a saddle described in his patent, but that it substantially resembled the invention of the plaintiff; and if the difference be in form and proportions only, they are the same.

A patent cannot be said to be obtained in fraud of the right of another, who had given up his rights to the plaintiff, by expressly or tacitly permitting him to obtain a patent for it.

[* 69] * It is contended that the plaintiff must date his right from the time of his application for the patent; the distinction is this, he must in all cases prove that the infringement of his right took place after his application or the date of his patent. But if the defendant attempts to avoid the patent by showing that the plaintiff was not the original discoverer, the patent will be considered as relating back to the original discovery.

The specification must point out the new improvement of the patentee, so as to show in what the improvement consists; and it will not be sufficient that the same is shown on the trial by exhibiting the invention.

Upon a notice of the invention confined to a prior use in the *United States*, the Court will not permit evidence to be given of a prior use in *England*.

THIS is an action for violation of a patent-right, for a new and useful improvement in manufacturing men's and women's saddles, without saddle-trees.

The schedule states, that "the pad is first cut out, and made in any shape thought proper. The part of a pad usually covered with a saddle-tree, is then covered with a piece of thick leather. A piece of web is then sown across the pad, over the thick leather, sufficiently wide for the girth-straps to be attached to it. A cantle of very strong leather is then put on, and secured to the pad. A plate of iron is then put across the head of the pad, to which the stirrup bars are riveted. This plate goes into case-loops, made on each side of the pad; and the extremities of the plate are tied in the

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loops to prevent them from working. A seat cloth is then put on, in the same manner as in the common saddle, in which the saddle-tree is used. The seat is then stuffed and set. The leather for the seat is then drawn over it, and the skirts fitted, as in a common saddle. The seat is then taken off and seamed to the skirts; the flaps are cut out, and instead of being nailed, are sewed to the skirts, a little below the wealt of the seat. The seat is then drawn on, and instead of being nailed, as in the common saddle, it is sewed. The saddle, thus made, resembles in appearance the common saddle in which the saddle-tree is used. It is capable of enduring as much hard usage as the common saddle, and is much easier to the rider, and safer to the horse."

The patent bears date the 16th of July, 1819; but it was proved that the plaintiff had a saddle of the kind above described, made in his shop about the latter end of May preceding. It was also proved that the defendant made and sold saddles without trees, and with skirts and flaps, after the date of the plaintiff's patent, and before the commencement of the suit.

In support of the notice given to the plaintiff, "that the defendant would give in evidence under the general issue that the saddle for which the plaintiff had obtained a patent, was not originally discovered by him, but had been in use in various places within *the United States*, and that the plaintiff had surreptitiously patented the discovery of another person;" witnesses were examined, who * proved, [* 70] that a saddle, substantially like the plaintiff's, was made and sold by a Mr. Andrews, on or just before the 15th of July, 1819; and that another was made by Hudson, and sold on the 28th of May; and it was further proved, that another saddle had been made in the month of April preceding, differing from the plaintiff's only in the circumstance, that the pad and skirts of that saddle were fastened together.

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It further appeared, that one Wimbly, a journeyman in the plaintiff's shop, suggested the improvement for which the patent was obtained ; but that he made no application himself for a patent ; on the contrary, he asked the plaintiff, if he (the plaintiff) could obtain a patent for the discovery, and that he took charge of the shop whilst the plaintiff went to Washington to obtain the patent.

Many witnesses were examined upon the subjects of identity on the plaintiff's and defendant's saddles, and originality of discovery. Upon the first point, the witnesses pointed out some differences between the two saddles, in the manner of making them, and in their external appearances, but both of them were made with skirts and flaps, and without trees. The skirts in the defendant's saddle were so fastened as to answer as a substitute for the draw-down in the plaintiff's, for confining the seat.

Upon the second point it was proved, that the pad-saddles without saddle-trees or skirts and flaps, had been in use long before the 16th of July, 1819, and that the common tree-saddles with skirts and flaps, were as old as the memory of the witnesses could reach.

Phillips, for the defendant, contended,

1. That the defendant was not guilty of having invaded the plaintiff's patent, inasmuch as the saddles which he had made, differed in many respects from the one described in the specification, and shown in Court.

2. That the plaintiff's discovery is nothing more than a combination of old materials, without any thing new ; or, if there be any thing new, the specification does not distinguish the old from the new, or state in what the improvement consists. 1 Mass. Rep. 182 ; 3 Wheat. Rep. App. 21.

3. That the plaintiff was not the first inventor of this saddle, but the same was in use prior to *the date* of the patent,

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which he insisted was the only date to be regarded ; or if the plaintiff has a right go back to the *time of the discovery*, which was the latter end of May, still the same kind of saddle had been previously made and used. 3 Inst. 184. Wood v. Zimmer, 1 Holt's N. P.

4. That the discovery, if it be one, was made by Wimbly ; who not having assigned his right to the plaintiff, his obtaining a patent was surreptitious, in relation to Wimbly ; and for this reason also the patent is void.

C. J. Ingersoll, for plaintiff, combated the points made by the defendant's counsel ; and in reference to the second, insisted, that the specification sufficiently describes the improvement, and *distinguishes the old from [* 71] the new materials ; but that even if it does not, the defendant cannot avail himself of defects in the specification under the general issue, and without also showing that they were introduced for the purpose of deceiving the public ; and finally, that artists only are competent to say whether the specifications is sufficiently explicit, to enable one skilled in the art to make such a saddle as is there described.

CHARGE, WASHINGTON, J. Upon the plea of not guilty, it is incumbent on the plaintiff to prove, not merely that the defendant had made, used, or sold *a saddle* ; but that it substantially resembled the one for which the plaintiff has obtained his patent. And if the difference between them be only in form, or proportions, they are the same in legal contemplation ; since to permit the defendant to shelter himself under a mere formal difference, would be to sanction a fraudulent evasion of the plaintiff's right, and to render the Patent Law a dead letter. The second section of the Patent Law, which declares that simply changing the form or proportions of any *machine or composition of matter*, shall not be deemed a dis-

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covery, affords a sensible and a just rule, equally applicable to an art or manufacture, and has always been so considered and treated.

In actions of this kind, persons acquainted with the particular art to which the controversy relates are usually examined for the purpose of pointing out and explaining to the jury the points of resemblance, or of difference, between the thing patented, and that which is the alleged cause of the controversy ; and the opinions of such witnesses, in relation to the materiality of apparent differences, are always entitled to great respect. But after all, the jury must judge for themselves, as well upon the information so given to them, as upon their own view, where the articles, or models of them, are brought into Court.

The witnesses, who testified in this case, did not entirely agree in opinion as to the nature of the difference between the plaintiff's and the defendant's saddles. Most of them however stated, that it consisted in the workmanship bestowed upon the saddles, and upon their external appearance. You have had an opportunity of examining them, and must decide whether they are, or are not substantially the same. If they are, the plaintiff has made out his case on the general issue ; since it is not denied that the defendant had made and used saddles similar to those produced in Court, subsequent to the 16th of July, 1819, and before the institution of this action.

Another objection to the plaintiff's right of recovery arises out of the special matter given in evidence, of which notice was given by the defendant to the plaintiff. It is, that the plaintiff surreptitiously obtained this patent for a discovery of one Wimbly, who worked as a journeyman in his shop. If the jury are satisfied that the discovery was in reality made by Wimbly, they must be also satisfied that the patent was obtained in fraud of any right which such discovery bestowed

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* upon Wimbly. For if, upon the evidence, you [* 72] should be of opinion, that Wimbly gave up his right of discovery to the plaintiff, by expressly or impliedly permitting him to encounter the trouble and expense of obtaining a patent, it cannot be affirmed that the plaintiff obtained the patent surreptitiously, or in fraud of Wimbly's discovery.

The next inquiry is, whether the saddle for which the plaintiff has obtained a patent, was in use prior to his alleged discovery ?

The patent bears date the 16th of July, 1819; and Taylor, one of the witnesses, has deposed that the first saddle made in the plaintiff's shop, upon which the patent was obtained, was about the latter end of May preceding. Hudson swears that he made a saddle like the plaintiff's, and sold it on the 28th of May, 1819; and Andrews swears, that he saw a saddle substantially the same, except that the skirts and pad were fastened together, in April of the same year.

It is contended by the defendant's counsel, that the plaintiff's right is to date from the time when he applied for the patent, which, for any thing that appears to the contrary, should be considered as having happened on the same day on which the patent issued. If so, then Hudson's saddle was made and sold before the plaintiff's title accrued. But the Court cannot yield its assent to the doctrine of the defendant's counsel. It is incumbent on the plaintiff to show, that the infringement took place after the time of his application, or the date of his patent. But, if the defendant attempts to avoid the patent by showing that the patentee was not the original discoverer of the thing patented, the patent will be considered as relating back to the original discovery. The notice authorized to be given by the sixth section of the law is, that the plaintiff was not the original discoverer, but that the thing patented had been in use, &c., anterior to the supposed *discovery of the patentee.*

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Taking it for granted that this patent is to date from the latter end of May, there would be some difficulty in deciding the question of priority between the plaintiff and Hudson, whose saddle was made also the latter end of May. Did the cause turn on this point, the jury should require the defendant to clear up their doubts, by satisfying them that the right of priority was due to Hudson ; because upon that fact he grounds the defence, and in his notice he undertakes to establish it.

But at all events, if the evidence of Andrews be believed by the jury, and if they are also of opinion that the connecting of the skirts to the pad of the saddle, spoken of by this witness, is a mere difference in form from the patented saddle, the plaintiff cannot be considered as an original discoverer. This, if so found by the jury, is fatal to the plaintiff's right.

The last objection, or the second made by the defendant, is, we think, fully made out, and is not less fatal to the plaintiff's recovery. This is founded on the imperfect description of the thing patented, given in the specification. It

[* 73] professes to be an improvement in the * manufacturing of saddles without trees. The materials and the manner of making the saddles described are all old, or if there be any thing new in the combination, or in the application of the old to the new, they are not distinguished ; nor does the specification describe, or attempt to describe in what the improvement consists. It is quite impossible to say, whether it consists in substituting some other material for the tree, so as to constitute an improvement of the old saddle-tree ; or in adding skirts and flaps to the pad-saddle, which was in use long before the date of the plaintiff's discovery, and was made without trees ; or whether it consists in all, or any of the other described operations in the making of saddles. If in all, then the patent is broader than the discovery, since it is clear that the materials, as well as the process in the

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manufacture described in the specification, are old. If the improvement consists in any one or more of the particulars set forth in the specification, it ought to have been so stated, in order that other persons might have known how to avoid any infringement of the plaintiff's right ; and that the public might have the benefit of the discovery, by referring to the specification itself, after the expiration of the plaintiff's monopoly.

It is not enough for the plaintiff's counsel or the witnesses to point out at the trial, or even for the jury to perceive by examination of the thing patented, and comparing it with others before in use, what it is that constitutes the improvement. This would afford no advantage to third persons, and least of all would it afford consolation to the defendant, who, if he has offended at all, did it innocently, and through ignorance, and can make atonement in no other way, but by submitting to the penalty which the law imposes upon him, and the troubles and expense incident to litigation.

Third persons wishing to avoid these consequences, can safely depend upon no other information than what the records of the Secretary of State's office may afford. No description of the discovery secured by a patent will fulfil the demands of justice and of the law, but such as is of record there, and of which all the world may have the benefit.

It was insisted by the plaintiff's counsel, that this specification is perfectly intelligible to an artist, who could experience no difficulty in making such a saddle as is there described ; and that if it be not so, still the defendant cannot avail himself of the defect, unless he had stated it in his notice, and also proved at the trial an intention in the plaintiff to deceive the public.

But these observations are all wide of the objection, which is not that the specification does not contain the whole truth relative to the discovery, or that it contains more than is

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necessary. It is admitted that the specification does not offend in either of these particulars. But the objection is, that throughout the whole of a very intelligible description of the mode of making the saddle, the patentee has not distinguished what was new, from what was old and before in use, nor pointed out in what particulars his improvement [* 74] consisted. * Upon this objection then, the verdict ought to be for the defendant, whatever the jury may think on the other points.¹

Plaintiff suffered a nonsuit.

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[4 Wash. 259.]

Rules of the Courts of Equity, as to granting injunctions in patent cases.

A patent for an improvement on a horizontal wheel invented by the patentee, without saying what the original invention was, or referring to any thing for information, makes the patent so defective that the Court will not grant an injunction for an alleged invasion of it.

WASHINGTON, J. This case comes before the Court upon a motion for an injunction. The plaintiff, by his bill, claims to be the proprietor of "an improvement on the horizontal circular plane or wheel, invented by him, for the purpose of gaining power by applying animal weight to the propelling of boats on water, or to machinery on land ;" which, the bill charges, was secured to him by a patent dated the 17th of

¹ The Court refused to allow evidence to be given, to prove that saddles like the plaintiff's had been in use in *England* many years ago, the notice being special and confined to the alleged use within the *United States*.

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November, 1819, and that the specification was filed in the Patent-Office on the 13th of April, 1818.

The specification states, that "the method used in this new invention is to have the animals harnessed to any particular part of the boat, or machinery, and to have them acting, or walking on the deck, or on a movable or fixed platform, square, circular, or of any other shape — the same being fixed to a perpendicular shaft, and connected by cog-wheels, so as to act on the water-wheel. By which new position or place in the boat, on which the animals are kept in action, two or four horses will perform, and save the labor of from twelve to twenty when kept moving in the ordinary method at present used in team-boats." The bill sets forth a certificate of the Secretary of State that the specification on which the plaintiff's patent was issued, *dated New York, April 9th, 1818*, was received and filed in the Patent-Office, on the 13th of April, 1818.

The bill charges that the defendants have in use team-boats upon the construction stated in his patent, and prays for an injunction against their continuing to use the same.

The answer of four of the defendants admits that the defendants use team-boats on the Delaware, under a license from a Mr. Langdon, dated 2d of September, 1820, to use boats constructed according to the plan and improvement secured to the said Langdon by patent dated the 5th of June, 1819, and that they have had the said boats in use since the date of their license. It denies that the plaintiff has used or sold his alleged improvement, or that he, or any other person, has practically tested the use or value of his asserted discovery; that the boats used by the defendants do not interfere with the plaintiff's patent; and finally, that the plaintiff's patent is void, on account of the defective description given of the alleged improvement in the specification.

* After the coming in of this answer, and an [* 260]

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unsuccessful motion for an injunction, because the bill did not state that the plaintiff had ever sold or used his improvement, the plaintiff, having obtained leave for that purpose, amended his bill by stating that the plaintiff was, and is, in the actual and profitable enjoyment of his said improvement, and has constructed, and caused to be constructed, several boats upon the principles of his said improvement, and has sold four of them for valuable consideration. No answer has been put in to the amended bill.

The practice of the Court of Equity, upon motions of this kind, is to grant an injunction upon the filing of the bill, and before a trial at law, if the bill state a clear right, and verify the same by affidavit. If the bill states an exclusive possession of the invention, or discovery for which the plaintiff has obtained a patent, an injunction is granted, although the Court may feel doubts as to the validity of the patent. But if the defects in the patent, or specification, are so glaring that the Court can entertain no doubt as to that point, it would be most unjust to restrain the defendant from using a machine or other thing which he may have constructed, probably at great expense, until a decision at law can be had.

The possession of the patentee against all mankind is stated by Lord Eldon, in *Hill v. Thompson*, 14 Ves. 132, to have been the ground on which the injunction was granted in the disputed patent of Watts. But, says the same judge, where the patent is modern, and an injunction is applied for, and objections are made to the specification, or to the validity of the patent, the Court will not, from its own notions respecting the matter in dispute, act on the presumed validity, or invalidity of the patent, without the right having been previously ascertained at law; and will not grant the injunction till the plaintiff has established the validity of his patent at law, which the Court will order. 3 Meriv. 624, 628; 6 Ves. 707; Coop. Eq. 158.

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The objections to the interposition of the Court, by injunction, in this case, are numerous and insurmountable. The following are the most prominent.

1. It appears by the answer, that Langdon's patent was prior in date to the plaintiff's, and that he was in the full enjoyment and possession of it, by the sale of licenses, and the use of boats constructed upon the plan of his patent and specification. It is true that the Secretary of State has certified that the plaintiff's specification was filed in the Patent-Office in April, 1818. But that specification cannot possibly be the one upon which the patent stated in the bill was granted, because that is without date, and the specification mentioned in the certificate is described as being dated *at New York, April 9th, 1818.*

2. The bill, even with the amendment, does not state an exclusive possession of the plaintiff's discovery at any time since the emanation of his patent. The amended bill charges that the plaintiff was *and is, in the [* 261] actual enjoyment of his improvement; that he has constructed boats upon the principles of it, and has sold four of them. But when were these acts performed? For aught that appears, they may have been subsequent to the practical employment by the defendants and others of the right acquired under Langdon's patent.

3. The answer positively denies that allegation in the bill which charges that the defendants have in use boats upon the plan of the plaintiff's asserted improvement, and avers that the boats which they have in use do not interfere with the plaintiff's patent.

4. The last, and by no means the least fatal objection, is to the patent and specification, which are so manifestly defective, that the Court ought not to interpose until the plaintiff shall have established his right at law, if he can do so. The patent is for an *improvement* on the horizontal wheel,

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invented by the plaintiff. But what the nature of the invention was upon which this is alleged to be an improvement, is not stated. Was it patented; and if not, is there any other source of information to which others can resort, in order to find it out, so as to enable them to distinguish the improvement from the original invention, and, in that way, to discover in what the improvement consists? Neither the patent or specification affords the slightest information upon those points. The invention alluded to may, for aught that appears, be known to no other person than the plaintiff. How then can any human being, however skilful in the art, find out, with certainty, or even conjecture, in what the improvement consists, from the patent itself, or from the records in the Patent Office? If the original invention had been patented, the specification should at least have referred, and plainly described it. If it was not, it should have stated what that invention was, and in what the improvement consists. As the matter stands, the nature of the improvement is altogether unintelligible.

The injunction is denied.

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[7 Wheat. 356.]

A party cannot entitle himself to a patent for more than his own invention; and if the patent be for the whole of a machine, he can maintain a title to it only by establishing that it is substantially new in its structure and mode of operation.

If the same combination existed before in machines of the same nature up to a certain point, and the party's invention consists in adding some new machinery, or some improved mode of operation, to the old, the patent should be limited to such improvement; for if it includes the whole machine, it includes more than his invention, and therefore cannot be supported.

When the patent is for an improvement, the nature and extent of the improvement must be stated in the specification, and it is not sufficient that it be

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made out and shown at the trial, or established by comparing the machine specified in the patent with former machines in use.

The former judgment of this Court in the same case, (*ante*, vol. iii. p. 454,) commented on, explained, and confirmed.

A person having an interest only in the question, and not in the event of the suit, is a competent witness.

In general, the liability of a witness to a like action, or his standing in the same predicament with the party sued, if the verdict cannot be given in evidence for or against him, is an interest in the question, and does not exclude him.

ERROR to the Circuit Court of Pennsylvania.

This is the same case which was formerly before this Court, and is reported *ante*, vol. 3, p. 454; and by a reference to that report, the form of the patent, the nature of the action, and the subsequent proceedings, will fully appear. The cause was now again brought before the Court upon a writ of error to the judgment of the Circuit Court, rendered upon the new trial, had in pursuance of the mandate of this Court.

Upon the new trial, several exceptions were taken *by the counsel for the plaintiff, Evans. The first [* 357] was to the admission of one Frederick as a witness for the defendant, upon the ground of his interest in the suit. The witness, on his examination on the *voir dire*, denied that he had any interest in the cause, or that he was bound to contribute to the expenses of it. He said that he had not a hopper-boy in his mill at present, it being then in Court; that it was in his mill about three weeks ago, when he gave it to a person to bring down to Philadelphia; and that his hopper-boy spreads and turns the meal, cools it some, dries it, and gathers it to the bolting-chest. Upon this evidence, the plaintiff's counsel contended that Frederick was not a competent witness. But the objection was overruled by the Court.

Another exception was to the refusal of the Court to allow the deposition of one Shetter to be read in evidence by the

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plaintiff, which had been taken according to a prevalent practice of the State Courts, instead of being taken pursuant to the provisions of the Act of Congress.

But the principal exceptions were to the charge by the Circuit Court, in summing up the cause to the jury, which it is deemed necessary here to insert at large.

WASHINGTON, J. This is an action for an infringement of the plaintiff's patent, which the plaintiff alleges to be,

1. For the whole of the machine employed in the manufacture of flour, called the hopper-boy.

2. For an improvement on the hopper-boy.

The question is, is the plaintiff entitled to recover upon either of these claims? The question is stated [* 358] * thus singly, because the defendant admits that he uses the very hopper-boy for which the patent is, in part, granted, and justifies himself by insisting,

1st. That the plaintiff was not the original inventor of, but that the same was in use prior to the plaintiff's patent, the hopper-boy as patented.

2d. That his patent for an improvement is bad ; because the nature and extent of the improvement is not stated in his specification ; and if it had been, still the patent comprehends the whole machine, and is therefore too broad.

1st. The first is a mixed question of fact and law. In order to enable you to decide the first, it will be well to attend to the description, which the plaintiff has given of this machine, in his specification, a model of which is now before you. Its parts are, (1.) An upright round shaft, to revolve on a pivot in the floor. (2.) A leader or upper arm. (3.) An arm set with small inclining boards, called flights and sweepers. (4.) Cords from the leader to the arm to turn it. (5.) A weight passing over a pulley, to keep the arm tight

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on the meal. (6.) A log at the top of the shaft, to turn it, which is operated upon by the water power of the mill. The flights are so arranged as to track the one below the other, and to operate like ploughs, and at every revolution of the machine to give the meal two turns towards the centre. The sweepers are to receive the meal from the elevator, and to trail it round the circle for the flights to gather it to the centre, and also to sweep the meal into the bolt.

*The use of this machine is stated to be, to [*359] spread any granulated substance over a floor, to stir and expose it to the air, to dry and cool it, and to gather it to the bolt.

The next inquiry under this head is, when was this discovery made? Joseph Evans has sworn, that in 1783 the plaintiff informed him that he was engaged in contriving an improvement in the manufactory of flour, and had completed it in his mind, some time in July of that year. In 1784, he constructed a rough model of the hopper-boy, but having no cords from the extremities of the leader to those of the arm, it was necessary, in making his experiments, to turn round the arm by hand. In 1785, he set up a hopper-boy in his mill, resembling the model in Court, and the machine described in his specification. The evidence of Mr. Anderson strongly supports this witness, and, indeed, the discovery, as early as 1784 or 1785, is scarcely controverted by the defendant.

The defendant insists that a hopper-boy, similar to the plaintiff's, was discovered, and in use, many years anterior, even to the year 1783, and relies upon the testimony of the following witnesses :

Daniel Stouffer, who deposes that he first saw the Stouffer hopper-boy in his father's, Christian Stouffer's, mill, in the year 1764 ; in the year 1775 or 1776, he erected a similar one in the mill of his brother Henry, and another in Jacob Stouffer's mill, in 1777, 1778, or 1779.

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[*360] * Philip Frederick swears, that in 1778 he saw a Stouffer hopper-boy in operation in Christian Stouffer's mill, and in the year 1783 he saw one in Jacob Stouffer's mill, and another in U. Charles's mill, and that it was always called Stouffer's machine.

George Roup stated, that in 1784 he erected one of these hopper-boys in the mill of one Braniwar; and that in 1782 Abraham Stouffer described to him a similar machine, which his father used in his mill.

Christopher Stouffer, the son of Christian, has sworn, that his father, having enlarged his mill, in the year 1780 erected a new hopper-boy of the description above-mentioned, which is still in use in the same mill, now owned by Peter Stouffer.

If these witnesses are believed by the jury, they establish the fact asserted by the defendant, that the Stouffer hopper-boy was in use prior to the plaintiff's discovery.

The next inquiry is into the parts, operation, and use of the Stouffer hopper-boy. This consists of an upright square shaft, which passes lightly through a square mortice in an arm, underneath which are fixed slips of wood, called flights, and the arm is turned by a log on the upper end of it, which is moved by the power which moves the mills.

The arm, with the flights, operates as it turns upon the meal placed below it, and its use is, in a degree, to cool the meal, and to conduct it to the bolt. It will now be proper to compare this machine with the plaintiff's. They agree in the following particulars. They each consist of a shaft, or log, to turn it by the power of the mill, and an arm

[*361] * with flights on the under side of it. They each operate on the mill below the arm, to cool, dry, and conduct it to the bolt.

In what do they differ? The plaintiff's shaft is *round*, and consequently could not turn the arm, into which it is loosely inserted, if it were not for the cords which connect

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the extremities of the arm to those of the leader. The shaft of the Stouffer hopper-boy is *square*, and therefore turns the arm without the aid of a leader or of cords. It has neither a weight nor pulley, nor are the flights arranged in the manner the plaintiff's are, and consequently it does not, in the opinion of most of the witnesses, cool or prepare the flour for packing as well as the plaintiff's.

The question of law now arises, which is, are the two machines, up to the point where the difference commences, the same in principle, so as to invalidate the plaintiff's claim to the hopper-boy, as the original inventor of it? I take the rule to be, and so it has been settled in this and in other Courts, that if the two machines be substantially the same, and operate in the same manner, to produce the same result, though they may differ in form, proportions, and utility, they are the same in principle; and the one last discovered has no other merit than that of being an improved imitation of the one before discovered and in use, for which no valid patent can be granted, because he cannot be considered as the original inventor of the machine. If the alleged inventor of a machine, which differs from another previously patented, merely in form and proportion, *but not in [*362] principle, is not entitled to a patent for an improvement, which he cannot be by the 2d section of the law, he certainly cannot, in a like case, claim a patent for the *machine itself*.

The question for the jury then is, are the two hopper-boys substantially the same in principle? not whether the plaintiff's hopper-boy is preferable to the other. Because if that superiority amounts to an *improvement*, he is entitled to a patent only for an improvement, and not for the whole machine. In the latter case the patent would be too broad, and therefore void when the patent is single.

If you are of opinion that the plaintiff is not the original

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inventor of the hopper-boy, he cannot obtain a verdict on that claim, unless his is an excepted case. The 1st, 2d, 3d, and 6th sections of the general Patent Law conclusively support this opinion. But the *judgment* of the Supreme Court in this case¹ is relied upon by the plaintiff's counsel, to prove that this is an excepted case; insomuch that the plaintiff is entitled to a verdict, although you should be satisfied that he is not the original inventor of the hopper-boy. But we are perfectly satisfied that the interpretation put upon the last clause of the judgment by the plaintiff's counsel is incorrect; and that for the following reasons: 1. The question of priority of invention was not before the Supreme Court; and it is therefore incredible that any opinion, much less a judgment, would have been given upon that point.

[*363] The error in the charge, which *this part of the judgment was obviously intended to correct, is stated by the Chief Justice in the following words:

"The second error alleged in the charge, is in directing the jury to find for the defendant, if they should be of opinion that the hopper-boy was in use prior to the improvement alleged to be made thereon by Oliver Evans.

"This part of the charge seems to be founded on the opinion, that if the patent is to be considered as a grant of the exclusive use of distinct improvements, it is a grant for the hopper-boy itself, and not for an improvement on the hopper-boy." — p. 512.

It contradicts what is stated in p. 517, where it is said that the plaintiff's claim is to the machine "*which he has invented*," &c. Now, if he did not invent the hopper-boy, he has no claim to it; and if so, could the Court mean to say, that he was nevertheless entitled to recover under that claim?

¹ 3 Wheat. Rep. 519; *ante*, 286.

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Such a decision was certainly not called for by the terms of the "Act for the relief of Oliver Evans," but would seem to be in direct violation of it. The act directs a patent to issue to Oliver Evans, not for his *hopper-boy, elevator, &c.*, but "for his invention, discovery, and improvement in the art, &c., and on the several machines which he has discovered, invented, and improved." Now if the *hopper-boy* was not *invented, &c.*, by O. E., this act, without which O. E. could not have obtained a patent, did not authorize the Secretary of State to grant him one for that machine; or if granted, it is clear that it was *improvidently done. [*364] If, indeed, the Supreme Court had been of opinion that the fact of Oliver Evans's prior invention was decided, and could constitutionally have been decided by Congress, there might have been more difficulty in the case; but the argument of counsel, which pressed that point upon the Court, was distinctly repudiated. We conceive that the meaning of that part of the opinion is, that this Court erred in stating to the jury that O. Evans was not entitled to recover, if the *hopper-boy* (that is the original *hopper-boy*) had been in use prior to the plaintiff's alleged discovery of it; because if the plaintiff was entitled to claim an *improvement* on the *hopper-boy*, which this Court had denied, and which the Supreme Court affirmed, this Court was clearly wrong in saying to the jury that the plaintiff could not recover for his improvement, which, in effect, was said. Upon the whole, then, the Court is of opinion, that O. Evans is not entitled to a verdict in his favor as the inventor of the *hopper-boy*, if you should be of opinion that another *hopper-boy*, substantially the same as his in principle, as before explained, up to the point where any alteration or improvement exists in his *hopper-boy*, was invented, and in use prior to the plaintiff's invention or discovery, however they may differ in mere form, proportions, and utility.

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2d. The plaintiff's next claim is to an improvement on a hopper-boy, which claim, we were of opinion in another case, has received the sanction of the Supreme Court. His counsel contend that his improvement is, (1.) On the [* 365] original method of supplying the * bolt by manual labor ; (2.) on his own hopper-boy ; and (3.) on some hopper-boy, invented by some other person. Let this position be analyzed.

1. It is said to be an improvement on the original method by manual labor. But it is obvious that if this be the invention, it is of an original machine, because wherever the Patent Law speaks of an improvement, it is on some *art*, *machine*, or *manufacture*, &c., and not on manual labor, which was applied to the various arts long before the invention of machinery to supply its place.

2. An improvement on his own discovery.

But where is the evidence of such invention ? It is true that Joseph Evans has stated that the plaintiff constructed, in 1784, a rude model of a hopper-boy ; but it was no substitute for manual labor, because without the cords or leading lines, the arm could not move, and it was therefore turned by hand. It was, in fact, in an incomplete state ; in progress to its completion, but not given out, or prepared to be given out to the world as a machine, before 1785 ; when the cords to turn the arm were added.

3. An improvement on a former machine.

This is a fair subject for a patent ; and the plaintiff has laid before you strong evidence, to prove that his hopper-boy is a more useful machine than the one which is alleged to have been previously discovered and in use. If, then, you are satisfied of this fact, the point of law, which has been raised by the defendant's counsel, remains to be considered, which is, that the plaintiff's patent for an improve- [* 366] ment is void, because * the nature and extent of his improvements are not stated in his specification.

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The patent is for an improved hopper-boy, as described in the specification, which is referred to, and made part of the patent. Now does the specification express in what this improvement consists? It states all and each of the parts of the entire machine, its use and mode of operating, and claims as his invention the machine, the peculiar properties or principles of it, namely, the spreading, turning, and gathering the meal, and the rising and lowering of its arm, by its motion to accommodate itself to the meal under it. But does this description designate the improvement, or in what it consists? Where shall we find the original hopper-boy described, either as to its construction, operation, or use; or by reference to any thing, by which a knowledge of it may be obtained? Where are the improvements on such original stated? The undoubted truth is, that the specification communicates no information whatever upon any of these parts. This being so, the law, as to ordinary cases, is clear, that the plaintiff cannot recover for an improvement. The 1st section of the general Patent Law speaks of an improvement as an *invention*, and directs the patent to issue for this said invention. The 3d section requires the applicant to swear or affirm that he believes himself to be the true inventor of the art, machine, or improvement, for which he asks a patent; and further that he shall deliver a written description of his invention, in such full, clear, and exact terms, that any person acquainted with the art, may know how to construct and use *the same, &c. [*367] That it is necessary to the validity of a patent, that the specification should describe in what the improvement consists, is decided by Mr. Justice *Story*, in the cases referred to in the appendix to 3 *Wheat. Rep.* and in the cases of *Bombon v. Bule*, *Boville v. Poor*, *M'Farlane v. Price*, *Harmer v. Playne*, and perhaps some others. What are the reasons upon which this doctrine is founded? They are to guard

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the public against an unintentional infringement of the patent, during its continuance, and to enable an artist to make the improvement, by a reference to some known and certain authority, to be found among the records of the Secretary of State, after the patent has run out. But it is contended by the plaintiff's counsel, that the law would be unreasonable to require, and that it does not require this to be done, unless the improvement is upon a *patented* machine, a description of which can be obtained by a reference to the records of the Secretary of State's office; that it might often be impossible for the patentee to discover, and consequently to describe the parts of a machine in use, perhaps only in some obscure part of the world. The answer to this is, that an improvement necessarily implies an original, and unless the patentee is acquainted with the original, which he supposes he has improved, he must talk idly, when he calls his invention an improvement.

If he knows nothing of an original, then his invention is an original, or nothing; and the subsequent appearance of an original, to defeat his patent, is one of the risks [* 368] which every patentee is exposed to under * our law.

As to the supposed distinction between an improvement on a machine patented, and one not so, there is nothing in it. In both cases the improvement must be described, but with this difference: that in the former case it may be sufficient to refer to the patent and specification, for a description of the original machine, and then to state in what the improvements, or such original consists; whereas, in the latter case, it would be necessary to describe the original machine, and also the improvement. The reason for this distinction is too obvious to need explanation.

If the general law upon this subject has been correctly stated, the next question is, is this an excepted case? It is contended by the plaintiff that it is so. 1st. In virtue of the

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Act for the relief of O. E. ; and 2dly, by the decision of the Supreme Court.

1. Under the private Act, that declares that the patent is to be granted in the *manner and form* prescribed by the general Patent Law. What constitutes the manner and form in which a patent is granted by the law? The obvious answer is, the petition — the patent, with the signature of the President and the seal of the United States affixed to it — the oath or affirmation, the specification, or description of the invention, as required by the 3d section, the drawings and models, if required. Will it be contended that a patent would be granted in the *manner and form* prescribed by this law, if there were no description whatever of the invention? and if it would not, which is taken for granted, where is the difference between the total absence of a specification, and one which has no reference *at all to [* 369] the invention for which the patent is granted?

This is not the case of an imperfect or obscure description ; but of one which relates exclusively to the whole machine, whereas the invention for which the patent is granted, is for an improvement.

2. The opinion of the Supreme Court, which states, “ that it will be incumbent on the plaintiff, where he claims for an improvement, to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists.”¹ But how is it to be shown? The Court has not pointed out the manner, and we therefore think the only fair implication is, that it must be shown as the statute of the United States and the general principles of law require ; that is, by the patent and specification. If it may be shown by parol evidence to the jury, as the plaintiff’s

¹ 3 Wheat. Rep. 518; *ante*, 285.

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counsel contend it may, then it may be fairly asked, *cui bono*, which sort of a showing would then be, so far as it would be productive of any useful purpose? As to the defendant, the evidence comes too late to save him from the consequences of an error innocently committed. As to the public at large, with a view to caution, during the continuance of the patent, and to information of the nature of the improvement after its termination, the evidence given in this cause must be evanescent and totally useless.

We feel perfectly convinced that the meaning of the Supreme Court, as to this point, is again misunderstood by the plaintiff's counsel, not only for the reasons above-
[* 370] mentioned, but because the *extent* * and *construction* of the plaintiff's patent, and not the validity of it, in relation to any one of the machines, were the questions before that Court; and none others (in reference to the charge) were argued at the bar, or reasoned upon by the Chief Justice, in delivering the opinion.

Upon the whole, we are of opinion, that the plaintiff is not entitled to a verdict for the alleged infringement of his patent, for an improvement of the hopper-boy.

Whereupon a verdict and judgment thereon were rendered for the defendant in the Circuit Court, and the cause was again brought by writ of error to the Court.

Mr. C. J. Ingersoll,¹ for the plaintiff, premised a review of Evans's inventions and improvements as in proof in the cause, originating in 1783, and perfected, as regards the hopper-boy, in 1785, the grants from the legislatures of Delaware, Maryland, and Pennsylvania, in 1787; the first patent of the plaintiff under the federal government, in 1790, and the

¹ Some part of his argument is applicable to the points of evidence in the subsequent case of *Evans v. Hettich*.

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second in 1808, by virtue of the special Act of Congress for the relief of Oliver Evans. The great utility of those improvements was now universally acknowledged, while the patentee was deprived of all their advantages. It was a singular misfortune for him, among others, to be under the necessity of bringing his patent a second time before this court, for revision, in the same case, in which much of the matter in dispute was the construction of the opinion formerly pronounced, reversing that of the * Circuit Court of [* 371] Pennsylvania, which that Court had occasion to review. It was the earnest hope of the plaintiff that a full and final decision would now take place, so as to put the subject at rest.

With respect to the matters of evidence, he contended, (1.) That David Aby was incompetent as a witness, because he was sued in *pari delicto*, and of course disposed to vacate the patent he had himself infringed. Interest in such a question is equivalent to interest in the cause. Perhaps even the verdict might be given in evidence, under the 6th section of the Act of 1793, c. 11, which enjoins it on the Court to declare the patent void in the event of a verdict for the defendant. The plaintiff's answer to this objection is, that as the patent is for several machines and improvements, the Court could not annul such a patent, but on the foundation of a verdict against all the claims. But why not? Why not declare it void *pro tanto*? Every principle applicable to common cases applies to this. Nay, it is even more necessary, in so complicated a monopoly, to guard the public against imposition or vexation, by demands founded on any part of it, tried and abrogated. (2.) It was objected to David Aby, as a witness, that he and six others, including the defendants in these cases, as was ascertained on his *voir dire*, combined to defeat the suits, and for that purpose contributed a common purse to bear the expenses of defending them. If any sur-

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plus remained, it was to be returned by the witness, who acted as treasurer — if any deficiencies, it was to be raised by further levies from the contributors. This was [* 372] breaking down all * distinction between bias and interest. It amounted, perhaps, to maintenance.¹

(3.) David Aby was suffered to prove the existence of the Stouffer original hopper-boy, when the notice was that evidence would be given of the existence of the improved hopper-boy. The notice is in 3 *Wheat. Rep.* 470. By this, a complete surprise was inflicted on the plaintiff. The defendant's position was, that for this purpose, he waived the notice of special matter and gave the evidence, under the general issue, as proof of non user. But as the notice is equivalent to a special plea, was it competent to the defendant, after putting it in, to abandon it on the trial? There no doubt are cases when the defendant might avail himself of the general issue.² But this was a case of special matter, *tending* to prove that the specification does not contain the whole truth, or that the thing was not *originally* discovered by the patentee. The decisive proof of this position is, that the defendant was allowed to use the same evidence to show that the plaintiff was not original with his hopper-boy, which he used to show that the defendant did not use the hopper-boy. It was an evasion of the wholesome provisions of the sixth section of the Act of 1793 ;³ calculated to destroy a patent by means which a patentee never could possibly controvert. It was an aggravation of these objections that the Court charged the jury, that after a witness was ruled by the Court to be competent, the jury could not [* 373] * disqualify him on the ground of discredit, but must believe him, unless otherwise contradicted.

¹ 5 Burr. 2730 ; Phill. Ev. ch. 5, p. 49.

² 3 Wheat. Rep. App. 27, *ante*, 287.

³ Act of 1793, c. 11, s. 6 ; 3 Wheat. Rep. 504, *ante*, 273.

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By this course of proceeding, the defendants were their own witnesses, and the plaintiff was not allowed to discredit them. (4.) The Court should have suffered the plaintiff to prove that the son of one of the Stouffers, and the executors of another, purchased Evans's improvements. On the former occasion, similar evidence was sanctioned as to the Stouffers themselves, the alleged originators of the hopper-boy.¹ And why not the acknowledgments of their descendants and legal representatives? It was treated before as evidence of opinion. If so, why not the opinion of one generation as well as another? But it was more than opinion. It was traditionary history of the invention and improvements. (5.) The Court should have suffered the defendant's witness, Philip Frederick, to be asked whether Daniel Stouffer was subject to fits of mental derangement. Stouffer was the defendant's principal witness; and that was a most material circumstance in his faculty to bear credible testimony as to remote periods and obscure circumstances. Besides, the witness, Philip Frederick, if he had denied the fact, might have been contradicted by other testimony; in which respect it was a very important inquiry to be made of him, with a view to Frederick's credit. (6.) The deposition of Michael Forner was overruled, after that of John Shetter had been received under precisely the same circumstances. Neither of them was taken according to the Act of Congress, which is inconvenient and *unfair in its operation. Rules for depositions [*374] were entered by both parties. Both parties took depositions under these rules. When the defendant offered to read Shetter's deposition, no objection was made, and it was laid before the jury. But when the plaintiff offered to read Forner's, taken in the same manner, and under the same rules, it was objected to, and overruled. The clerk testified,

¹ 3 Wheat. Rep. 495, 505, *ante*, 266, 274.

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that for twenty years the practice had been to take depositions by rule, on notice, instead of taking them under the Act of Congress, which requires no notice where the witness lives more than 100 miles from the place of trial. There was, therefore, evidence of mutual consent and understanding between the parties, deducible both from the invariable practice, and from the rules entered and acted on in these cases. Yet the court rejected the plaintiff's proof, and suffered the defendant's to remain as received in force. Thus the plaintiff was most unexpectedly deprived of some of his most material testimony, while the defendants themselves were their own witnesses.

The main matter in dispute was on the Court's construction of the word *improvement*, which it imputed to the patent. This radical difficulty escaped notice when these cases were before discussed in the Circuit and Supreme Courts. 1. It was a misapprehension to suppose that the word exists at all in the patent or specification, in connection with the hopper-boy. The patent is for improvements in the art of manufacturing flour, and for certain other machines, one of which is denominated an *improved* hopper-boy. But the [* 375] distinction is obvious, between * something patented as an improvement of a hopper-boy, and something patented as an improved hopper-boy. The latter was so called, as substituting mere machinery for manual labor. It might be so called as a caveat against unknown but possibly existing originals, which, in the strong illustration of the Court, would avail a defendant if he could prove their existence in the mountains of China. It might be so called, as meaning nothing more than a melioration of the inventor's own original essays. Evans's hopper-boy was a great and most beneficial improvement, which he called an improved hopper-boy. But it had no original. Even the bolt-filler, ascribed to Stouffer,

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alleged to be of earlier origin, was as different in principle, as it was inferior in practice, to the plaintiff's machine.

2. It was a second error of the Court, to take it for granted that the improved hopper-boy was not so described in the specification, as to distinguish it from all things before known or used, and to enable a person skilled in the art to make it. It is so described. [Here the counsel went into a specification of the peculiar structure and properties of the hopper-boy.] No one skilled in the art could misapprehend this description, or be misled by it. The error of the Court was, in condescending to consider itself skilled in the art of which this is a branch. The law does not require of patentees to describe new *and* old, but merely to distinguish new *from* old. Otherwise a patent would be more complex and voluminous than a Welsh pedigree. Take a boat, for instance ; must every species, from the ark downwards, *be de- [*376] scribed? The peculiar properties of the improved hopper-boy are perfectly explained. It is not a mere change of form and proportions, but a combination of well known materials, on new principles, essentially set forth in the specification, so as to prevent all interfering claims during the exclusive term, and to impart the rights to the public afterwards. The authorities were misunderstood by the Court in this respect. They all require, to be sure, a discrimination, when the subject-matter is an improvement. But they require only an essential improvement ; not a recapitulation of the particulars of both the old rudiments, and the new combinations, in detail, distinguishing them in terms.

3. This, however, was a question of fact to have been submitted to the jury, instead of being, as it was, exclusively assumed and determined by the Court. How can a Court decide, whether a person skilled in the art could understand a description, and copy a machine? The cases are uniformly

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so.¹ In all these cases, the Court left this inquiry as a fact to the jury. Indeed, the 6th section of the Act of 1793, c. 11, treats it not only as matter of fact, but of fraud. It must appear that the specification is untrue, either deficient or redundant, in order to deceive the public. It is matter of concealment. Can the Court infer this *scienter*?

5. Indeed, it may well be doubted whether any discrimination is necessary, where, as in this case, there is [* 377] * but one patent in existence. The second section of the law speaks of the case of a prior patented machine. The Court would have the third section to be substantive, without association with the second and sixth. But how can a patentee describe what he never saw? If not before patented, how could he see or know? If he knew, but concealed his knowledge, is it not matter of fraud? The cases, when examined, will be found to have most of them referred their reasoning to the point of conflicting patents. Such is the fact in *Harmer v. Playne*, *Bovill v. Moore*, and *Lowell v. Lewis*. Which explanation is all important to a correct understanding of those cases.

5. The special Act of Congress for the *relief* of Oliver Evans, vouchsafes him from all *technical* obstacles. His improvements by that time were universally acknowledged. Congress did not mean to forestall the ascertainment of their *originality*, which any citizen might try, if he chose, nor their utility. But the relieving Act dispenses with specification, oath, fee, and all the other prerequisites of common cases. It was not designed merely to prolong the term of monopoly, but to relieve it from vexations and frivolous embarrassments.

¹ 8 T. R. 95; 11 East's Rep. 101; 2 Marsh. Rep. 211; Starkie's N. P. Rep. 199; 3 Meriv. 622; 1 Gallis. 438, *ante*, 36; 2 Gallis. 51, *ante*, 52; 1 Mass. 182, 452; 3 Wheat. Rep. 514, App. 17, *ante*, 282, 287.

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Accordingly, it uses the term *improvements*, in addition to the terms applied to such subjects by the Act of 1793 ; and confers on Oliver Evans an exclusive right in his discoveries, machines, and improvements in general, and specifically. The obvious design of this act of grace, was to relieve the grantee from all the formalities to which patentees in common are subjected, * leaving the question of priority [* 378] or originality alone open to inquiry by the country.

6. But even this inquiry was not competent to these defendants, who are citizens of Pennsylvania. The Act of Assembly of that Commonwealth, in 1786, confers on Evans the exclusive right in his hopper-boy, and inflicts penalties on all infractors of it. To this Act, the defendants directly acceded and contributed by their representatives ; and it is a well settled principle, that they are bound by their legislation.¹ Nor is this position at all affected by the 7th section of the Act of 1793, c. 11.

Mr. Sergeant, contra. A patent is intended to secure to an inventor the exclusive right, for a limited time to his invention. At the expiration of the period, the thing thus secured is to become public property, which any one is at liberty to use. In the mean time, every one is to abstain from using the thing patented, at the peril of a severe responsibility in damages. The provisions of the Patent Law have a view to these several objects, all of which are to be promoted as far as possible, and reconciled with each other, the public security and the benefit being protected, as well as the interests of the inventor. He is to enjoy the fruits of his ingenuity, upon terms and conditions, which are compatible with the safety, the peace, and the interests of other citizens.

¹ 10 East's Rep. 586 ; 3 John. Ch. Rep. 598.

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A patent, therefore, in the first place, can only [* 379] be * for an *original invention*. It is of no importance, that a man really believes himself to be the inventor, or is the *true* inventor, having made the discovery himself, without even the knowledge, that the thing he supposes himself to have invented, was known or used before, or described in some public work. However honest he may be, he has not merit as respects the rest of the community, in discovering what was already known and open to common use, nor will he be allowed to appropriate the thing to himself, because he has made a mistake. The *truth* of his invention, though not an original one, will protect him against a summary proceeding to set aside his patent *under the 10th section of the Act of 1793, c. 11* ; but it will not avail him to enforce his claim in an action against an individual. The want of originality, proved by showing that the thing was used or known before, or described in some public work, is, in every case, a valid and conclusive defence.

Again : an invention may be of a machine, or of an improvement on a machine ; of something that was entirely unknown before, or of an addition to or alteration in what was previously known, so as to make it more useful. Each of these is a patentable object ; but the patent, as to both, is to be for the *invention* only, and the laws that govern it, thus understood, will be found to be exactly the same. Novelty is an essential part of the merit, and it is only what is *new* that is to be secured by the patent. A mistake is just as fatal to the patentee in the one case as in the other ; and if [* 380] he should really * believe himself to have invented an improvement, when in truth it was known, used, or described before, he could not give legal effect to his patent. There is, however, one peculiarity in the case of patents for improvements. Improvement being a relative term, presupposes the existence of something to which it refers, known to

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the inventor at the time of making the supposed improvement. If he does not know of it, he cannot know he has improved upon it; and if he does know of it, he can readily describe the improvement he has made, that is, his own invention. A man who has never heard of a time-keeper, might suppose himself the inventor of one; but it is impossible to conceive, that a man who has never heard of such a thing, should believe himself to be the inventor of an improvement upon the time-keeper.

A patent for an entire machine covers the whole — a patent for an improvement, on the contrary, covers only the improvement, and necessarily *supposes there are parts which are not patented*. It is the line between these, and the parts which are patented, that defines the respective pretensions of the patentee and the public; and unless that line be somehow marked, it is impossible to say where the one terminates, and the other begins. Confusion, uncertainty, extortion, fraud, and litigation would be the inevitable consequence.

It is the business and duty of the inventor, then, at the time of applying for his patent, and before he can receive a patent, to deliver a “written description of his *invention*, and of the manner of using, or process of compounding the same, in such full, clear, *and exact terms, *as to* [* 381] *distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same,*” &c., sec. 3. This *specification* is to remain in the office of the Secretary of State, and a copy of it is everywhere made evidence. The design of this provision is manifest; it is to secure to the public the use of the invention, after the expiration of the period for which the patent is granted; and to enable individuals, in the mean time, to know what it is that is intended to be secured, so that they may avoid interference, or,

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if they think proper, dispute the claim of originality. For both these purposes, it was necessary that there should be authentic and recorded evidence, accessible to all, and remaining unchangeable and unchanged. Without a specification, the patent would be void. A specification which does not comply with the requirements of the Act of Congress, is, to all legal intents, no specification, and the patent would be equally void, as if there were literally no specification.

In the present case, the patent is to be regarded, either, (1.) As a patent for the whole machine, or, (2.) As a patent for an improvement on an old and known machine. The utmost that can be contended, is, that the patentee has an election to consider it as the one, or the other; and that is a very liberal concession, inasmuch as it is founded upon the ambiguity of his own specification, from which, generally, a man ought not to be permitted to derive an advantage. [* 382] But it is clear that it cannot be a patent for both; that would be a legal absurdity, involving a plain contradiction in terms.

1. As a patent for the whole machine, including the plaintiff's alleged improvement, it is void, because the plaintiff was not the original inventor of the machine. The fact, that a hopper-boy, known by the name of an S. or Stouffer hopper-boy, having all the essential parts of the plaintiff's machine, and applied to the same uses and purposes, (whether more or less perfectly, is not material to inquire,) existed, and was in use, before the date of the plaintiff's earliest alleged discovery, has twice been proved to the satisfaction of intelligent juries in each of these cases, and is now to be taken for granted, as conclusively established. At the former trial, the learned judge who presided (Mr. Justice *Washington*) instructed the jury, if they should be of opinion that Oliver Evans was not the original inventor, to find for the defendant; which they did accordingly, being fully satisfied

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of the fact. Upon error to this Court, the judgment was reversed, on the ground that the patent was not for the machine, but for an improvement; the phrase "improved hopper-boy," being after much hesitation, deemed equivalent to "improvement" on a hopper-boy. But the opinion of the Court distinctly admits, what indeed cannot be questioned, that if, as respects the hopper-boy, the patent had been for the whole machine, the direction of the learned judge would have been right.

In giving to the plaintiff the benefit of the alternative, the case was put in the most favorable view for him.

* He might claim as inventor of the whole machine, [* 383] or he might claim as inventor of the improvement; but, under this patent he could not claim for both; and in claiming for either, he must of course abide by the settled principles of law, applicable to the construction of the patent thus adopted. Each must be taken singly. The two could be confounded, so as to entitle him upon the one to the benefit of principles belonging to the other. If the patent be for the whole machine, it is void if he is not the original inventor; and that he is not, has been fully established.

It is intimated, however, and will probably be insisted upon hereafter, that admitting the S. or Stouffer hopper-boy to have been previously known and used, the two machines are so entirely different, that Mr. Evans might well be entitled to a patent for the whole. As a question of fact, that has been decided by the verdict of the jury, and the identity of the machine must now be taken for granted, unless the jury were led to the conclusion by an erroneous charge from the Court. What constitutes identity and what diversity, is frequently a question of great difficulty. It was the right and the duty of the judge to inform the jury what were the principles to guide their deliberations in deciding it, and this he has done with admirable clearness, and in conformity with the best authority

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upon this abstruse part of the law. "Where a specific machine already exists," (says Mr. Justice *Story*,) "producing certain effects, if a mere addition is made to such machine, to produce the same effects in a better manner, a [* 384] * patent cannot be taken for the whole machine, but for an improvement only."¹ And the same learned judge says, "the material question, therefore, is not whether the same elements of motion, or the same component parts are used, but whether the given effect is produced substantially by the same mode of operation, and the same combination of powers, in both machines."² The identity here is perfectly apparent upon the description, and still more so upon inspection of the models. The *object* of both is the same — to dispense with manual labor, and supply the hopper — to supply it gradually, in small, successive, regular portions, by means of the power that moves the mill; substituting mechanical contrivances for human agency. The *effect* is the same, to turn, stir, and cool the flour, and thus prepare it for bolting, before it is delivered. The *construction* of the machines, as to "the mode of operation," and "the combination of powers," is the same. In both, there is an upright shaft, with a cog, turned by the power that moves the mill; an arm, resting lightly on the meal, and turned by the upright shaft; something on the under part of the arm, whether flights or sweepers, to gather in the meal to the hopper. So far, they are the same. Now for the differences. The plaintiff's machine has a round shaft, instead of a square one; it has leading lines, which are necessary in consequence of the shaft being round, and a weight to balance the arm. These may all be improvements, but they are only *improve-*

¹ *Whittemore v. Cutter*, 1 Gallis. 430, *ante*, 28.

² *Odiorne v. Winkley*, 2 Gallis. 54, *ante*, 55.

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ments, and do not make a different machine. The name itself bespeaks *identity; the old machine [* 385] was called a bolt-filler, or hopper-boy; and the plaintiff's is called "an improved hopper-boy."

But if the machines be so entirely different, as to entitle the plaintiff to a patent for the whole, though the S. hopper-boy was previously known and used, then it would necessarily follow, that even if the plaintiff were the original inventor of the improved machine, and that was the first invention, yet any one might with impunity make and use such a machine as the S. hopper-boy; that is to say, by stripping off some of the parts, he might entitle himself to use the residue. This is a proposition too monstrous to be maintained. If it be sound, it decides this case without any regard to the question of the original invention, for the defendant, Eaton, used only the S. hopper-boy.

A sure test, however, of the identity, is to consider what parts are indispensable to both machines. They are, the upright shaft with a cog in it, the arm, and the sweeps. With these, the machine will work; without them, it will not. These parts are common to both machines. What is it that the plaintiff has added? What is not indispensable, but perhaps better. That is exactly the definition of an improvement. Can he, in his improved machine, dispense with any one of the parts that belong to the old machine? The answer is clear—he cannot. Can we dispense with any of his additions? Yes, with all of them. The machine is complete, an efficient agent for its purpose, without them; the evidence even leaves it doubtful whether apart from the elevator, it is not the better of the two. It is certainly *in use, and is the very machine for the use [* 386] of which Mr. Eaton is sued. There can be no serious doubt, that if the plaintiff has any claim, it is only for an improvement.

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2. As a patent for an improvement, it is void, because the specification does not show in what the improvement consists, or, in other words, what it is that the plaintiff claims as his invention: "the nature and extent of the improvement are not stated in his specification." This was the precise ground of the decision below.

The counsel for the plaintiff who opened the argument, was understood to concede, that if the patent be for an improvement, and there be nothing in the circumstances of this particular case to make it an exception from the general rule, the law was correctly laid down. And certainly there can be no doubt of this, whether we consider the spirit and terms of the Act of Congress, the decisions in England, or the adjudged cases in the United States.

The current of authority, of every sort, is uniform to establish, that the invention to be patented must be described in such full and exact terms as to "distinguish the same from all things before known." The 2d section of the Act has no relation to this question. That provides for the case, where one man has a patent for a machine, and another for an improvement, declaring that the one shall not be at liberty to use the invention of the other, and thus precisely limiting their respective rights. Does it follow, that if a machine has not been patented, he who improves upon it has a right to appropriate the whole to himself, and withdraw [* 387] * what was before public property from the public use? That no one can afterwards make use of the old and known machine, without the license of the patentee? The section was made with a different view, and leaves what is not provided for upon the same footing on which it before stood. What was common property remains so; the patentee of the improvement is at liberty to use it because it is common, and the legislation was necessary to enable him; but he is not allowed to appropriate it to himself to the exclu-

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sion of others, any more than to appropriate the invention of a prior patentee. The 6th section, which makes it a good defence, that the patentee has stated more or less than the truth in his specification, "for the purpose of deceiving the public," has no relation to the question. There is no allegation here that the machine will not produce the described effect, or that more or less has been stated for the purpose of deceiving or misleading the public. Nor is this, the Court will recollect, a summary proceeding to set aside the patent under the 10th section.

But the question, and the only question is, whether, in an action by a patentee against a person charged with infringing his patent, it is not necessary for the plaintiff to show in what his invention consists. In the former argument of this case, this Court have laid it down expressly, that "in all cases where his claim is for an improvement, it will be incumbent on *him to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists.*"¹ How is this to be shown?

* The answer is obvious—it is to be shown from [* 388] the specification. That such was the meaning of the Court is evident from their adopting almost the very words of the Act of Congress, which are employed to describe the office of the specification, "so that a person understanding," &c. That nothing else could be their meaning is evident, for such, it cannot be denied, is the clear design of the Act of Congress, and such is the established law as collected from authoritative decisions. The patent must not be more extensive than the invention; therefore if the invention consists of an addition or improvement only, and the patent is for the whole machine or manufacture, it is void.² In Eng-

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¹ 3 Wheat. Rep. 518, *ante*, 285.

² Bull. N. P. 76; *Boulton v. Bull*, H. Bl. Rep. 463.

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land, the specification is not annexed to the patent, but is enrolled in Chancery. Yet the specification is a part of the patent for the purpose of ascertaining the nature and extent of the alleged invention.¹

In this country, it is filed in the department of State. An authenticated copy of it is always annexed to the patent, and forms a part of the patent, absolutely essential, because the patent, properly so called, in fact gives no description, referring for that to the specification. The established formula used in all patents, and to be found in the present patent, is, "the said improvement, a description whereof is given in the words of the said Oliver Evans himself, in the schedule hereto annexed, *and is made a part of these presents.*"

[* 389] Now, what should the patent * comprehend?

Where the combination of a certain number of the parts has existed, up to a certain point, in former machines, the patentee merely adding other combinations, the patent should *comprehend such improvements only.*² And the cases that have been already referred to clearly decide, that if the invention be of an improvement only, it is indispensable that the patent should not be broader than the invention; and the *specification should be drawn up in terms that do not include any thing but the improvement.* It is essential to point out what is new, and what is old, so as to show precisely the extent of the alleged improvement. "The patentee ought, in his specification, to inform the person who consults it, what is new and what is old. He should say, my improvement consists in this, describing it by words, if he can, or, if not, by reference to figures. But here the *improvement* is neither described in words or figures; and it would not be in the wit

¹ Boulton v. Bull; Hornblower v. Boulton, 3 Term Rep. 95.

² Bevil v. Moore, 2 Marsh. Rep. 211.

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of man, unless he were previously acquainted with the construction of the instrument, to say what was old and what was new. A person ought to be warned by the specification against the use of a particular invention.¹ It need not be denied that this description might be sufficiently given by reference ; as to some other patented machine, or to some well-known machine in familiar use. For instance, to use the illustration employed by Lord *Ellenbo- [* 390] rough, if we should say, take a common watch, and add or alter such and such parts, describing them. All that is contended, and that is fully supported by authority, and by reason of the case, is, that the specification must, in some way or other, distinguish the new from the old, the improvement from what was known before, so as to show what the patented invention is, or else the patent is broader than the invention, and void. The decided cases in the United States are to the same effect. If the inventor of an improvement obtain a patent for the whole machine, the patent being more extensive than the invention, is void.²

The cases are brought together, well digested, and the principles stated in the Appendix to 3 Wheat. Rep. 13.³

How else can the extent of the improvement be shown ? Shall it be by evidence at the trial ? Then the design of the act would be entirely defeated, and the specification useless. The argument of the Court below upon this point is perfectly conclusive. To say that the patent may be for the whole machine, and the claim for as much as the plaintiff can prove to be original, or rather the defendant cannot disprove, is to make the right depend, not upon the patent, nor even upon

¹ Per Lord Ellenborough ; *M'Farlane v. Price*, 1 Starkie's Rep. 199.

² *Woodworth v. Parker*, 1 Gallis. Rep. 439, *ante*, 38 ; *Whittemore v. Cutter*, 1 Gallis. Rep. 479, *ante*, 40 ; *Odiorne v. Winkley*, 2 Gallis. Rep. 51, *ante*, 52.

³ *Ante*, 287.

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the fact of originality, but upon the evidence the party may have it in his power to produce, and his intelligence and skill in applying it. The right, instead of being [*391] uniform *everywhere, might be one thing in one State, and another in another. In different Courts of the same State, it might be different. And even in the same Court, at different times, as the particular evidence happened to vary, it would be more or less extensive. The patent would in effect be nothing but an outline, large enough of course, to be filled up as occasion might serve. This is an absurdity, and, what is worse, a great temptation to fraud. Besides, under this supposition, how is any man to inform himself what it is that is patented, so that he may avoid the danger of the infringement? It is too late, at the time of trial, to answer any good purpose to the defendant. And how are the public to be informed at the expiration of the time, or how is a person of skill to be able to make the improvement; in short, of what use is the specification, unless it be to define, with precision, the extent and nature of the improvement? The Act of Congress emphatically refers to the specification, and to that alone, as furnishing every thing, without extrinsic aid, and so it must do. If it be broader than the invention, the patent is void.

But it is objected here, that this was a question for the jury, and not for the Court. Whether the specification is broader than the invention, may perhaps in some cases be a question of fact, or, a mixed question of fact and of law, the construction of the written instrument of specification being for the Court, and the other evidence in the case for the jury. But, if it be "incumbent upon the plaintiff to show the extent and nature of his improvement," and that is to be shown from the specification, then it is plainly incumbent upon [*392] him to show from the specification, *where he claims for an improvement, that he has described

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an improvement as distinguished from a known machine. And that, it is submitted, being exclusively a question arising upon the face of the instrument, is a question for the Court. Let us examine the specification. Is there any thing in it which even professes to describe an improvement, as distinguished from a machine known or used before? Does it not plainly, and in terms, include the whole machine? That is evidently a question of law, upon the face of the instrument, and it may be confidently pronounced, that it does include the whole, and that no man can so read the specification, as to ascertain which parts are claimed by the plaintiff, and which are not; or, that there are any parts which are not claimed by him. But, it is due to the Court, further to say, that the charge in this respect, must, as in all other cases, be understood with reference to the allegations and to the evidence. If there had been an attempt to prove, or even an assertion, the most distant intimation, that men of skill in mechanics, bringing to the study of this difficult specification, the aid of peculiar knowledge, could discern in it a line between new and old, or any defined limits of improvement, that would doubtless have been fit to be heard, and whatever matter proper for the consideration of a jury might have arisen, would have been submitted to the jury. But no such evidence was offered — the record shows it. No such suggestion even was made; it was not pretended — the charge shows it; for the part excepted to was itself a reply by the Court to an argument of the plaintiff's counsel, * which [* 393] admitted that the specification did not show in what the improvement consisted, by contending for the extravagant position that it was competent to show by evidence at the trial, which is in effect to say, that the plaintiff was entitled to whatever the defendant had not disproved.

It has been said, however, and to our very great surprise, that the Court below erred in dealing with this patent as a

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patent for an improvement; that it is not for an improvement, but for an *improved hopper-boy*. When this case was formerly before the Circuit Court, that Court dealt with the patent as a patent for a hopper-boy, and not for an improvement. Upon error to this Court, one error principally relied upon was, that the Court below had thus construed it to be a patent for the machine.¹ And it was contended that an "improved hopper-boy," and an "improvement on a hopper-boy," were one and the same. "This," says one of the counsel, "was a patent for an *improvement* on the particular machine in question, and not for its original invention." And of that opinion were the Court, after much deliberation.² And can it now be contended, in the same Court, and by the same party, that this is not to be dealt with as a patent for an improvement? But, the truth is, it has been treated in this case as a patent for both the machine and the improvement, so as to give the plaintiff the full benefit of either construction. The real aim of the argument is to maintain, [* 394] * that a patent for the whole may be expounded as a patent for each of the parts, and legally covering as many as the patentee may be able to prove he has invented; that it may be a patent in words for one thing, and in law for another; that it may have a sort of elastic ambiguity, capable of contraction, if not of expansion, so as to adapt itself to whatever it may be found convenient at any given time to embrace. This is against all settled principles; it is against good policy; and it is against the words and the spirit of the Act of Congress.

Such being unquestionably the established law upon the subject of patents in general, it remains only to inquire, whether the case of Oliver Evans is on any account an exception. And it is insisted here, that the special act for his

¹ 3 Wheat. Rep. 486, 502, *ante*, 258, 272.

² 3 Wheat. Rep. 517, *ante*, 284.

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relief makes it an exception. The history of that act is sufficient to show, that its only object was, to authorize a new patent to be issued, by reason of the first having been declared void for irregularity of form attributable to the officers of the government. This gave an equitable title to relief. The appropriate relief was an extension of the time, so that the inventor might enjoy the privileges of a patent for the same time that he would have enjoyed them if the irregularity had not occurred, that is to say, the same privileges. This was sufficiently liberal, for the first patent had actually expired before the new one was granted. The new patent, too, was made retrospective, and gave to Oliver Evans an exclusive right for eight-and-twenty years, double the usual period ; yet it was contended, formerly, that this special act, liberal as it * confessedly was, went the [* 395] further length of dispensing altogether with the necessity of proving he was the inventor, and even precluded all right to question the invention, which was in effect to say, that the exclusive privilege was secured to him, whether he was the inventor or not. That was overruled by this Court, upon the plainest grounds.¹ And the whole scope of the opinion then delivered distinctly establishes, that except the extension of time, and the union of different inventions in the same patent, which otherwise perhaps could not be regularly joined, the patent to be issued, was to be in all respects conformable to the general law, and subject to the same regulations as other patents. Such was the interpretation of the plaintiff himself: he applied in the usual manner by petition, with a specification and oath. Such was the interpretation of the officers of government: the patent underwent the usual examination, and is in the usual form. Such is at this moment the interpretation: for it is upon the adoption of the

¹ 3 Wheat. Rep. 513, *ante*, 281.

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general law by reference, that the jurisdiction of the Federal Courts in cases growing out of this patent entirely rests. If that law be not applicable, this Court has no power to adjudicate the cause. It is needless to pursue this further, being already decided by the former decision of this Court. For the terms and conditions upon which the patent was to be granted — the jurisdiction to attach to it — the rules to govern it — the special act makes no provision, but [* 396] by reference to the existing laws ; and * but for this reference, we could not advance a single step in the inquiry.

All that has been said of the Act of the Legislature of Pennsylvania, passed in the year 1787, may be disposed of in a single word. What its provisions were does not appear, and if it did, the right they conferred, whatever it may have been, was surrendered by accepting a patent under the law of the United States. The seventh section of the Act of Congress is express.

In conclusion, then, it is confidently submitted, that the patent of Oliver Evans must be considered as a patent either for the machine or for the improvement.

That if it be for the machine, it is void ; because it is fully proved that he was not the original inventor, but the machine was known and used before.

That if it be for an improvement, it is void ; because it is broader than his invention, and does not specify in what his improvement consists, so as to distinguish it from what was known and used before.

The learned counsel also argued the points of evidence in this and the next following case, (*Evans v. Hettich*,) but as they are so fully noticed in the opinion of the Court, it is not thought necessary to report that part of his argument.

Mr. Harper, in reply, observed, that, in the opinion of the

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Circuit Court, two propositions were distinctly affirmed : (1.) That Evans's patent of the hopper-boy was a patent for an improvement, and not for an original invention or discovery : and (2.) * That being for an improve- [* 397] ment, it was void, because the specification did not in terms distinguish the improvements from the original machine, called the Stouffer hopper-boy. Both these propositions were indispensable for supporting the judgment below. He denied them both, and should endeavor to show that they were equally void of foundation. If he could succeed in overthrowing either, the judgment of the Circuit Court must be reversed, and the patent-right of the plaintiff supported ; but he believed, and should endeavor to show, that both were wholly unfounded.

And first, is the patent of Oliver Evans a patent for an improvement, or for an original invention ? The decisions of the Circuit Court maintained the former. He should endeavor to demonstrate the latter.

In the outset of this investigation it would be proper to remark, that the specification makes part of the patent ; and he had the authority of this Court, in the former decision in this case,¹ for saying, that in order to ascertain what Oliver Evans obtained by his patent, one of the proper points of inquiry was, what did he ask for ? what was it his wish and intention to obtain ? This question may be satisfactorily answered, by referring to that part of his specification which relates to the hopper-boy. This specification is printed at length in a note to 3 Wheat. Rep., and the part of it now in question is found at p. 468. The description of the machine is very full, * minute, and clear ; and it [* 398] concludes with this declaration : " I claim as my

¹ 3 Wheat. Rep. 507, *ante*, 276.

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invention the peculiar properties or principles which this machine possesses: namely, the spreading, turning, and gathering the meal at one operation, and the using and lowering its arms by its motion, to accommodate itself to any quantity of meal it has to operate on."

This was what he claimed as his invention. For this he asked a patent. Not for the machine which he had thus improved, but for the principle on which it was made to operate. He has not very accurately expressed himself, or distinguished between the object to be obtained, and the mode of proceeding for its attainment; between the end and the means; the result and the *modus operandi* by which it is produced. But still his meaning is obvious. The object, the end to be obtained, the result, was the "spreading, turning, and gathering the meal, at one operation." The principle of the machine, the *modus operandi* by which the object was to be accomplished, in a new and better way, was the power of the machine to raise and lower its arms by its own motion, so as to accommodate itself to any greater or less quantity of flour on which it may have to operate. This, then, is his invention or discovery, which he claims as his own, and for which he demands a patent. His demand is complied with. He gets what he asked. This is what the grantors intended to give him; and I appeal again to the former decision for the doctrine, that in order to ascertain what is given, we must look to the request of the receiver, and the intention of the giver.

[* 399] * It is, then, a patent for the peculiar principle of his machine, for its new mode of operating, that Oliver Evans asked for and received. That a new *modus operandi*, by a new combination of old instruments or machines, so as to produce either a new effect, or an old effect in a new way, is the proper subject-matter of a patent, appears from numerous authorities, and may be considered as

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a settled principle of the Patent Law. It was on this principle that Watt's patent for his improvements on the steam-engine, which made so much noise in Westminster Hall, and produced such important effects, was finally supported and established.

The English law of patents, though different from ours in its origin, was probably the same in its principles. Indeed, our Act of Congress was a mere enactment of the principles and system which the English Courts had established. That system grew out of the ancient prerogative of the crown in England, to grant monopolies. This power, long and often most oppressively exercised, was abolished in the early part of James the First's reign, by an Act of Parliament, which was one of the earliest fruits of the increase of knowledge, the progress of correct ideas, and the improvement in the condition of society, which, at that time, had begun to appear. But, for the encouragement of industry and ingenuity, a proviso was introduced into the statute, that the king might still grant a monopoly "of any manner of new manufactures," to the first inventors, for any term not exceeding fourteen years.¹ Upon this short proviso, this * ap- [* 400] parently scanty foundation, the whole structure of the English Patent Law was raised by the English Government and Courts. The system which they thus established was adopted by our Act of Congress. This system required a specification. Nothing is said of it by the statute; but the government required it, by an express clause of every patent. The principle on which it was required, was this: The statute conferred a benefit on the inventor, by giving him a monopoly of his invention for a limited time. For this benefit

¹ See the case of *Hornblower v. Boulton*. 8 T. R. 105. The opinion of Mr. Justice Lawrence.

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conferred on the patentee by the community, it was thought just that he should make a return. That return consisted in the knowledge and free use of his invention, which, by his specification, he should enable the community to obtain, after the expiration of his monopoly. This principle enables us not only to understand the origin and object of the specification, but also its nature and character, as its object was to put the public in possession of the invention, after the monopoly had ceased, so as to enable all persons to use it beneficially ; it was indispensable that the invention should be so fully and clearly explained, as to enable persons skilled in the same art to make and use it. This was all that was to be effected by the specification, and consequently all that it was required to contain. The very same certainty of description which would enable persons skilled in the art to make and use the invention, after the monopoly should expire, would enable them to avoid making and using it, so as to subject themselves to penalties or loss, during the continuance of the monopoly.

[* 401] * In the same manner it was established, that improvements in old machines or processes, might be combined as "new manufactures," and become the subject of patents. This principle was also incorporated into our Act of Congress, in express terms. And here the same rule was adopted with respect to the specification. The "new manufacture," whether it consisted in a machine or process entirely new, or in the improvement of an old one, was to be described with such certainty, as to enable persons skilled in the art to make and use the invention, after the monopoly should expire, and to avoid it while the monopoly should exist. The principle and object were the same in both cases, and the same rule was adopted in both, by our Act of Congress, as well as by the English decisions.

We shall now be able to perceive the application of the

case of Watt's patent,¹ to the point under consideration; which, let it be considered, is to ascertain how far the discovery of a new *modus operandi*, so as to produce a new effect, or an old one in a new way, is the proper subject of a patent, as a useful invention, and not as an improvement.

The expansive power of steam had been many years before discovered by the Marquis of Winchester, who applied it, though very imperfectly, to various mechanical purposes. Among the rest, he employed it to put machines in motion, by communicating to them the movement which the steam was made to produce in beams and levers. Thus was laid the foundation of that wonderful invention, the *steam-engine. Various machines of this kind, [*402] more or less perfect, were, from time to time, brought into use; and at length Newcomen made a steam-engine, which was long considered as having attained the utmost point of perfection. It consisted of a cylinder or large tube of iron, made perfectly smooth and uniform within, and completely closed at the bottom, but open at the top. Inside of this cylinder was placed, horizontally, a thick strong plate of iron, so fitted at the edges to the inner surface of the cylinder, as to be air tight, and yet to play easily up and down. Into the centre of this plate was fitted a strong upright stem of iron, of the length required; and the stem and plate together made what is called the piston. The upper end of the piston stem was fastened by a joint to a horizontal beam, which was made fast by a joint, near the centre or at the farthest end, so as to allow its near end to play up and down with the piston to which it is attached. At the bottom of the cylinder, under the piston, was introduced a pipe or tube, leading from the boiler, where the steam was

¹ 8 T. R. 95.

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generated, into the cylinder, and furnished with a valve. When this valve was opened, it let the steam through the pipe into the lower part of the cylinder, under the piston, which was thus raised up by the explosive power of the steam, and raised with it the end of the horizontal beam to which it was attached. When the piston, and with it the beam, had been raised as high as was intended, the valve in the steam pipe was shut by the motion of the machine, and, at the same moment, a valve was opened, by the [* 403] same means, in a pipe, which connected the * cylinder with a vessel of cold water. A quantity of this water was then introduced into the cylinder, under the piston, where it condensed the steam more or less completely, and created a vacuum more or less perfect ; in consequence of which the piston was pressed down by the weight of the atmospheric air resting upon it, and carried down with it the end of the horizontal beam to which it was attached. When it had subsided as low as was desired, it opened the steam valve, and let in the steam under the piston, which was raised as before, and again pressed down by the weight of the air, on the steam being again condensed by the introduction of cold water. This operation went on continually, and thus an ascending and descending motion was produced, which was communicated by the horizontal beam to the whole machinery.

The defect of this engine at length began to be observed. It consisted in the cooling of the cylinder by the cold water let in to condense the steam. The cylinder being thus rendered colder than steam, a considerable portion of the steam introduced was condensed by this coldness, while the piston was rising ; and was thus destroyed before it had done its office. This rendered a greater generation of steam necessary, and of course a greater consumption of fuel. The steam, too, was not suddenly or perfectly condensed, so as to

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let the piston descend with sufficient rapidity or force ; by which the power and effect of the machine were diminished. The water, also, into which the steam had been converted by condensation, remained in the bottom of the cylinder, * and further impeded the descent of the piston. [* 404] These defects were seriously felt in a country where fuel was dear, and became continually more and more so. At length they threatened to render the engine entirely useless, by creating a greater expense in fuel than could be compensated by the labor-saving power of the machine.

Then Watt arose, who, after long reflection and many experiments, conceived the happy idea of condensing the steam in a vessel different from that in which it was to perform its office. This he effected by connecting with the machine another vessel called a connector, which was connected with the cylinder by a pipe with a valve in it. This valve being opened by the motion of the machine, at the same moment when the piston had ascended - to its greatest height, the steam rushed through it into the conductor, where it met a stream of cold water, introduced by the same means which had been before employed for letting it into the cylinder. This cold water condensed it as fast as it came in ; and a pump was also contrived, to work by the motion of the machine, and drew out of the conductor all the steam that remained uncondensed and all the water produced by the condensation. Thus a most perfect vacuum was created in the condenser, and consequently in the cylinder connected with it ; the piston descended with freedom, rapidity, and force ; and the cylinder, not being touched or affected by the cold water, retained a heat equal to that of steam : so that no portion of the steam introduced into it, was condensed too soon.

This was the great improvement ; but others were * employed to increase its effect. The cylinder - [* 405]

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der was surrounded by a case the best calculated to retain heat, and the space between this case and the cylinder was kept full of steam or boiling water. Thus the cylinder was kept in the hottest possible state; the state best adapted to the preservation of the steam while performing its office: and as steam thus preserved was found to be more effectual than atmospheric air in bringing down the piston, the top of the cylinder was closed, and steam was introduced above the piston as well as below it. This stream was conducted into the condenser, and there condensed and pumped out, in the same manner with that introduced below: and thus the piston being alternately pressed up and down, by the elastic power of steam, in its most efficacious condition, gave a most powerful, steady, and uniform motion to the engine. Oily substances were employed instead of water, in keeping the vessels air tight; especially the top of the cylinder, where the steam of the piston played through it. Thus the machine was rendered as perfect as it seems capable of becoming.

Now, in what does this machine differ from the steam-engine of Newcomen, which was in use before? Both had a boiler to produce the steam, and a cylinder to receive it. The piston was the same in both, and connected in the same manner with the horizontal beam, for the purpose of communicating the motion to the rest of the machinery. In both the piston was raised by the expansive power of the steam; this steam, after its office had been performed, was [* 406] condensed by cold water, so as to create a * vacuum in the cylinder, and permit the piston to descend; and in both pipes and valves of the same construction were used, for introducing alternately the steam and the cold water. In what, then, did they differ? Merely in a new *modus operandi*, by which, with the addition of another vessel, the cold water was prevented from cooling the cylinder,

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while it conducted the steam ; and the steam was made to operate in forcing the piston down, as well as in forcing it up. In this new *modus operandi*, produced by a different arrangement and construction of the old machines, with the addition of one new vessel, to receive and condense the steam, consisted the great invention of Watt ; for which he obtained his patent, avowedly as for a new invention, or in the language of the British statute, a "new manufacture," and not for an improvement. His specification is inserted at length in 8 T. R. 96, note (a) where it will appear that he speaks of his discovery as a new invention, and not as an improvement, and never once mentions or alludes to the old machine.

In what did this new discovery consist ? I answer with the two judges of the Common Pleas in England, who were in favor of this patent, and one of whom was Lord Chief Justice Eyre,¹ and with the four judges of the King's Bench, who were unanimous on the point,² that it consisted in the new principle on which the steam was condensed, and which was carried into effect by a new combination of the old machinery, with the addition of one new instrument.

*The word "principle," as used in relation to [* 407] this subject, is not taken in its general philosophical sense, where it means a law of motion or a property of matter ; but in what may be termed its mechanical sense, in which it signifies a method of doing a thing, or of effecting a purpose, in other words, a *modus operandi*.

It is therefore established by this solemn and elaborate decision of six English judges against two, after repeated arguments and great consideration, that a new principle, or *modus operandi* carried into practical and useful effect by

1 Boulton v. Bull, 2 H. Bl. 468.

2 8 T. R. 95.

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the use of new instruments, or by a new combination of old ones, with or without the addition of one or more new ones, is an original invention for which a patent may be supported, without reference to any former invention or machine, for performing the same or a similar operation. This may be taken as a maxim which the cases referred to will be found fully to support.

Let us now apply this maxim to the patent of Oliver Evans. We shall soon see that, according to the doctrine thus established, his discovery was not a mere "improvement," as the Court below pronounced it to be, but an original invention.

The learned counsel here produced two models, one of Evans's hopper-boy, and one of Stouffer's, and explained minutely the difference between their principles, or *modus operandi*, which consisted in this: that in Stouffer's hopper-boy, the arms through a square mortice in which the square upright post was made to pass, were carried round by means of the upright post pressing upon the sides of the [* 408] square * mortice, which renders it impossible for the arms to rise and fall of themselves, as the meal under them might increase or diminish; while in the hopper-boy of Evans, the upright post is round, and it passes loosely through a round hole in the arms, which are carried round by two pieces of timber of the proper length, called leaders, which are inserted firmly into the upper part of the post, and attached at their ends by lines or small cords, to the corresponding ends of the arms. These lines and leaders being put in motion by the upright post, trail round the arms, which at the same time play loosely on the post, and rise and fall of themselves, as the meal under them increases or diminishes in quantity. And to make them press more lightly on the meal, and rise and fall with more facility, as occasion may require, a weight a little lighter than themselves, is attached

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to them by a cord which passes over a pulley in the upper part of the post. This weight nearly balances the arms, and enables them to play up and down much more easily and effectually.

The counsel also produced a drawing of Evans's machine from the Patent-Office, to show that his model was correct, and referred to the facts of the evidence in the record where the machine of Stouffer is described, and its properties and defects explained.

He then proceeded to remark that the machine of Evans was obviously constructed upon a new principle; that the *modus operandi* was entirely new. The great object of both machines was to conduct the meal into the bolting chest, and to stir, turn, * dry, and cool it on [* 409] its way thither. The essential agents in this operation were the arms, which if they remained stationary on the post, as they must of necessity do in Stouffer's machine, could not possibly perform this operation to advantage. They might sink down on the meal, as its quantity decreased, but could not possibly rise when it was increased; consequently, when new meal was placed on the floor, the machine must be stopt, and the arms lifted up. Hence, its motion was unequal, and its operation necessarily very irregular and imperfect. It also required a hand constantly, or frequently, to be present, and thus increased the expense.

Thus the condensation of the steam within the cylinder itself, in Newcomen's steam-engine, cooled the cylinder improperly, wasted steam, made more fuel necessary, and rendered the operation of the machine imperfect, and too expensive. Here the similarity of imperfection is complete.

Evans removed the imperfection of the hopper-boy, not by merely adding to its parts, but by introducing a totally new principle and *modus operandi*. He detached the arms from the upright post entirely, and carried them round by means

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of the leaders and lines which have been described, leaving them to play freely up and down on the post, so as to accommodate themselves to the decreasing or increasing quantity of meal under them; and their movement up and down, he facilitated, regulated, and rendered perfect, by means of the weight and pulley. The *modus operandi* of the two machines, consisted in the manner of carrying round the arms.

[* 410] This was *the principle of both machines. That of Evans was new, and infinitely superior.

So Watt remedied the defects of Newcomen's steam-engine, by condensing the steam in a different vessel from the cylinder, and increased the effect by introducing the steam above the piston as well as below it. This was a new principle; and here again the resemblance between the two cases is complete.

It being then clear that Evans had made a new invention as to the hopper-boy, and not merely what the law on this subject calls an improvement, and the cases showing that such an invention is the subject-matter of a patent for an original invention, it follows that he might have obtained a patent for his invention, as an original invention, and not merely as an improvement. This leads to the inquiry, for what was this patent granted? Was it for an original invention of his own, or for an improvement on Stouffer's invention?

We have the authority of this Court, in its former decision in this case,¹ for saying that when we inquire what was granted, it is proper in the first place to ascertain what the grantee wished to obtain, and next, what the grantor had the intention and the power to give. What Evans wished to obtain, is fully and most explicitly stated in the concluding sentence of his specification.² After describing, most fully and

¹ 3 Wheat. Rep. 454, *ante*, 243.

² *Ib.* 468, *note, ante*, 246.

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clearly, the structure, principle, and operation of his hopper-boy, he concludes thus, "I claim as * my [* 411] invention, the peculiar properties which this machine possesses, namely, the spreading, turning and gathering the meal at one operation, *and the rising and lowering its arms by the motion, to accommodate itself to any quantity of meal it has to operate on.*" Here it is manifest, that he describes the effect intended to be produced, which was the same in both machines, namely, the spreading, turning, and gathering the meal at one operation; and his *modus operandi*, for producing this effect, which was entirely new, namely, the rising and lowering of the arms of the machine, by its own motion, so as to accommodate itself to the increasing or diminishing quantity of meal. For this *modus operandi*, this property or principle, he claims a patent.

It is equally clear that the grantor of the patent intended to give what he thus asked for; that is, a patent for this new principle. This appears from the special Act of Congress, on which the patent is founded, and to which it refers; from the terms of the patent itself; and from the specification which is expressly incorporated into it, as one of its constituent parts.

As a further illustration of this position, the most celebrated and important invention of modern times may be referred to, an invention which was destined to produce more important effects than any other single effort of the human mind. He alluded to the steamboat — that sublime conception, which had conferred so much glory on its author and his country. What was a steamboat, but a new combination of these well-known machines, a boat, a steam-engine, * and [* 412] a flutter-wheel, machines most familiar to all who knew any thing of such subjects. But they were so combined as to produce a new and most surprising effect, by a new *modus operandi*. This method consisted in attaching

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a steam-engine and two flutter-wheels to a boat of proper dimensions and strength, and arranging them in such a manner, that the flutter-wheels were set in motion by the steam-engine, and struck against the water, instead of being struck by it, as they are in a common saw-mill. Thus striking against the water, they act as oars, or rather as paddles, and propel the boat forward. Now, what was there new in this machine? Not the instruments, but the manner of combining them, and their manner of operating produced by this combination; and yet no one has denied to the author of this beautiful and sublime idea the merit of an original invention, or called in question his patent, as a patent for an original invention. He, however, merely combined old machines, changing their forms and proportions so as to suit his new purpose. Evans not only combined old machines, but added new and essential parts, and by means of both produced a *modus operandi* altogether new, and highly useful. Upon what ground, then, can it be said that he is not an original inventor, when Watt was solemnly adjudged, and Fulton unanimously allowed to be so?

I therefore contend, that Evans was an original inventor, and not an improver merely; and that his patent is for an original invention, and not for an improvement. If [* 413] so, the decision of the Circuit * Court in these two cases¹ must be reversed, and the patent of my client is established.

But if it be not a patent for an original invention, but merely for an improvement, the decision below was erroneous, in declaring that the specification is defective. This defect consists, according to the decision below, in the omission to

¹ The present case, and the subsequent case of Evans v. Hettich.

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state particularly in what the improvement consists, and to distinguish it in terms from the preëxistent machine.

Here a very familiar maxim is applicable : *quod neminem ad vana aut ad impossibilia lex cogit*. The law requires nobody to do that which would be useless if done, or it is impossible to do. And *cui bono* make this discrimination ; how can it be made ; and by what provision of the law is it required ? On the answer to these three questions the case must depend. If it can be shown that such a discrimination would be useless if made, or is impracticable, and that it is not expressly or positively required by the Act of Congress, it will follow that the judgment below must be reversed.

And (1.) *cui bono* make the discrimination ? What good would it, or could it, do to any body ? In order to answer these questions, we must revert again to the object and uses of the specification.

The Patent Law confers a benefit on the discoverer of any artful invention, which consists in a monopoly of his invention for a limited time. The consideration which it requires him to pay for this benefit, is to put the public in possession of his invention ; so as to enable all to use it, after this monopoly shall * expire ; and all to avoid in- [* 414] volving themselves in controversies and difficulties, by inadvertently infringing it while it continues. Hence the necessity of a specification ; and here we find its uses, its extent, and its limitations. The British statute said nothing of a specification ; but it was introduced by the executive government, as a condition of every patent, and its character, objects, and properties have been accurately settled by judicial decisions in England. From those decisions it was borrowed by our Act of Congress, and incorporated into its positive enactments. In both systems, its objects and uses, and, consequently, its nature and properties, are the same. Its object and all is to enable the public to enjoy the invention

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beneficially and fully, after the monopoly shall have expired, and to avoid interference with it, while it shall continue. Now what is necessary for attaining this object? certainly nothing more than this, that the invention should be so described in the specification, by writing, and, where the nature of the subject will permit, by drawings and models, as that any one competently skilled in the art or science to which it relates, may be enabled to understand, make, and use it. This is what the English decisions have established as the necessary properties of the specification; and what our statute expressly and in terms requires.

Now it is obvious that, in the case of an improvement, the principle is exactly the same as in that of an original invention. The invention, that is, the thing in its improved state, must be accurately and fully described; by writing always, and by drawings and models where the nature of [* 415] the case will * permit. When this is done, it is manifest that any one who can understand the improved thing, so as to make and use it, may, in every possible case, distinguish the improvement from any and every original or antecedent thing of the same sort. Take these two hopper-boys as an example, and inspect the models which I hold in my hands. Cannot any man, who has sufficient mechanical skill to make a hopper-boy, and understand its use, see at one glance in what these two machines differ from each other? Does not the Court see it? Cannot any such mechanic, therefore, make and use the hopper-boy of Stouffer, if he should think proper, and avoid all interference with the improvement of Evans? It cannot be doubted that he may. And so may a person sufficiently skilled in the art or science to which an improvement relates, in every possible case. When he has the improvement, or the improved thing sufficiently described, as the hopper-boy of Evans is admitted to be, and is informed of any preëxisting machine, or thing of

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the same general nature which he wishes to make, sell, or use, he can look at that thing, compare it with the improved machine, or with the description, drawings, and models in the Patent-Office; see the difference, and make and use the original or old one, without the least danger of interfering with the improvement. Where, then, is the use of describing the original, or the old invention, in the specification of the improvement; and of discriminating, in terms, between them? It is manifest that such a description would be perfectly useless and vain; and *neminem ad vana lex cogit*.

* 2. But admitting that it might be of some [*416] use, would it be possible? This is the next head of inquiry; and I contend that it would not.

And here let it be remembered, that this doctrine of discrimination is not confined to such inventions as are express or avowed improvements on particular inventions. It extends necessarily to all inventions which improve any thing that existed before. In the present case there happened, so far at least as is now known, to be but one hopper-boy, that of Stouffer, in use before Evans's. But suppose there had been twenty, of as many different kinds; would they not all have been original with respect to Evans's, or antecedent to it? Undoubtedly; and every man, notwithstanding Evans's patent, would have had a right to use them all, or any of them. What reason or principle could require the description of one in the specification of Evans, which would not equally apply to all? There certainly is none. Let us take the example of a patent for an improved stove, for increasing the heat, or for any other object. How many millions of stoves, of what an endless variety of constructions, are used in the world. Must the patentee of this improved stove, or of this improvement on stoves, describe them all in his specification, and point out in terms the difference between each of them, and his invention? It is manifest that he must, according to the doctrine of the Circuit Court; and it is equally

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manifest, that he could not possibly do it. His specification would constitute a library of itself, which no man would or could read, and which the Patent-Office could hardly [* 417] contain. So also *improved chimneys, improved carriages, and all the multitude of other improvements, real or imaginary, on things in general use, for which patents are obtained, having preëxistent things of the same nature, and used for the same general purpose, must be described in each specification; which, if it were possible to write it, as it would very seldom be, would be far too voluminous to be understood or read.

Thus, it is manifest, that the discrimination contended for, would be impossible as well as useless, in relation to improvements on unpatented machines. Where, indeed, a machine is already patented, it is very easy to describe it in the specification of the improvement, and point out all the particulars in which they differ from each other. The original specification is in the Patent-Office, and may be referred to; the drawings and model are there, and may be seen. Here the rule requiring a discrimination in terms between the original invention, and the improvement, would not be unreasonable: and it might be useful; by tending to prevent disputes between the different patentees. The mistake of which we complain, has probably arisen from not discriminating between improvements on patented and unpatented inventions. In the latter, the discrimination is manifestly impossible, as well as useless. In the former, it would be easy, and might be of some use. It might be proper to require it in one case, whether the law positively enjoins it or not. To require it in the other, would be to make the law require what is both useless and impossible. This can never be done by the construction merely of a statute, which must *always [* 418] be reasonable. But it may be said that the statute positively enjoins it. If so, we must submit. When the

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legislature has clearly expressed its will, the Court have no duty but to obey. This brings us to the question, what has the legislature enjoined on this subject?

3. All that can be supposed to relate to it is contained in the 2d and 3d sections. The second speaks of improvements; the third of specifications. It points out the object of the specification, and directs what shall be done for its attainment. The object is to put the public in complete possession of the invention, whether an improvement or an original discovery; so that interference with it may be avoided while the patent continues, and its benefits may be fully enjoyed by the public, after the patent expires. To this end it enjoins that the applicant for a patent "shall deliver a written description of his invention, and of the manner of using, or process of compounding the same; in such full, clear, and exact terms, as to distinguish the same from all other things before known; and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same." This is the directory part. The thing is to be described "so as to distinguish it from all other things before known." How distinguish it? By describing all the things before known, and pointing out in terms in what it differs from them all? Certainly not; but by giving a description of it so complete and accurate, as "to enable any person skilled in the art, &c., to make, compound, and use *the same." Is the [*419] discrimination contended for, but not mentioned in the statute, necessary for this purpose? By no means. Any person skilled in the art or science, in order to make, compound, and use the new invention, has but to look to the description of the invention itself. He need not know how nearly it resembles, or how widely it differs, from any other thing before known. With these he has no concern. And if, on the other hand, he wishes to use nothing before used

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and known, and to avoid interfering with the patented invention, or improvement, he has only to compare the thing which he so wishes to make or use, with the description of the patented invention, or improvement contained in the specification; and he will immediately see wherein they differ, and be enabled to avoid the latter, while he uses the former.

This section (the 3d) further directs, with a view to the same objects, that the applicant, the inventor, "in case of any machine," shall "fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions." Here, as in the rest of the section, nothing is said about improvements, as distinguished from original discoveries. They are all treated equally as "inventions," and are placed precisely on the same ground. They are all to be so described, as that they may be distinguished in their principles and *modus operandi*, as well as in their construction and composition, from other inventions; and this is to be effected by means, not of a formal discrimina-

tion, in terms, between them, and any other thing
 [* 420] * or things of the same general nature; but of a full and accurate verbal description, aided by drawings, models, and specimens, where the matter is of such a nature as to admit their use. In all this, nothing is said or hinted about "improvements," as contra-distinguished from "original discoveries." All are treated alike as "inventions," and the same means of enabling all concerned, to distinguish them from things before used or known, are provided in relation to both.

In fact, what is an "improvement," but a new invention? Every thing that is made better is improved; and every thing that makes another better, or does it in a better way, is an improvement. If it be new, it is an invention so far as it goes. The greater the improvement, the greater is the in-

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vention ; and any improvement differs from any other, or from an original discovery, if there be any such thing, not in nature but in degree. They may be greater inventions or less ; more or less ingenious ; or more or less useful ; but as far as they are, so they are all inventions, and are treated precisely alike by this portion of the Patent Law ; which, I again repeat, makes no mention, and gives no hint of a discrimination, in the specification of an improvement, between the improvement, or the thing as improved, and the original thing on which the improvement is made. Treating them all alike as "inventions," it requires, with respect to all, that they shall be so described as clearly to distinguish them, that is, as to enable all concerned to distinguish them from all other things of the same * nature, before in use or [* 421] known. To construe the statute, so as to make it require a description not only of the new invention, but of all things of the same general nature before known, and a discrimination in terms between them, would be as unreasonable in the case of an improvement, as of an original discovery, and would be perfectly unreasonable in either. It would make the statute do that which its terms do not indicate, and which the law can never be presumed to intend. It would make it require what it is not only impossible in a great variety of cases to do, but what, if done, would in every case be wholly useless and vain. This it cannot be so construed as to require ; for *neminem ad vana aut ad impossibilia lex cogit*.

The counsel then adverted to the 2d section, where it was supposed, he said, that something might be found to support this doctrine of discrimination. That section spoke particularly of improvements, as to which the third was wholly silent. It said nothing whatever of the specification, its objects or motive. It made two provisions, both useful as declarations of the law, to put persons on their guard and prevent mistakes,

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but both undoubtedly law, without any such declaration. The first was, that the discoverer and patentee of an improvement in any thing before patented, should not be entitled to make, use, or vend the original; nor the inventor and patentee of the original to make, use, or vend the improvement. Here again they were both considered as inventors, and both put on the same footing. It was declared, for general information, and to prevent doubts and [* 422] * mistakes, that one should not be entitled to the invention of the other; but nothing was said about the manner of distinguishing these inventions one from the other. That was left to the third section; where it was done without the least mention or hint of the formal discrimination, in terms, contended for in the judgment below. It was manifest that this discrimination could derive no countenance from this branch of the second section. It obviously could derive none from the other branch, which merely, for giving information to the public, and preventing mistakes, declared "that simply changing the form or proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery." This merely amounts to saying, what would clearly have been the construction of the law without any such declaration, that to constitute a patentable discovery, either original or by improvement, there must be a new principle or *modus operandi*, and not merely a change of form or proportion. If the change of form or proportion should be such as to produce a new principle or *modus operandi*, then it would be a discovery or invention, whether it amounts to an original or an improvement only; and here again improvements were treated as inventions, equally with original discoveries; the distinction between them being not in nature, but merely in degree.

But the point under consideration has been expressly settled, by the former decision in this case; the same objection,

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for want of this discrimination, was made in the Court below, on the first trial; and the same doctrine on the subject expressly laid down *by the Circuit Court; [* 423] this doctrine formed one of the grounds of objection, distinctly stated in the argument of the former case in this Court, and was distinctly noticed by the Court; and with this part of the opinion below, and the objection to it, distinctly in view, this Court decided this patent on this same specification to be valid, notwithstanding its want of a discrimination in terms between the improvement and the original invention; which was an express decision on this point, in favor of the plaintiff in error. He referred to various parts of the report of the former case of *Evans v. Eaton*,¹ to support these positions; remarking, that although the Court certainly was not bound absolutely by its own decisions, and ought to overrule them, when satisfied of their incorrectness, yet they were the great landmarks of the law, and ought not to be overturned or shaken, without the strongest and clearest reasons.

The learned counsel also cited the authorities cited in the margin, as to the objection to the charge of the Court below, upon the ground that it had invaded the proper province of the jury, in respect to the sufficiency of the specification, and to the nature of the patentee's invention, as an improvement or an original discovery.²

Mr. Justice Story delivered the opinion of the Court.

This is the same case which was formerly before * this Court, and is reported in 3 Wheat. [* 424] Rep. 454, and by a reference to that report, the

¹ 3 Wheat. Rep. 454, *ante*, 215.

² 12 H. Bl. 478, 484, 497; 8 T. R. 99, 101, 103; 1 Gallis. 481; 1 Mason, 189, 191, *ante*, 137, 139.

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form of the patent, the nature of the action, and the subsequent proceedings, will fully appear. The cause now comes before us upon a writ of error to the judgment of the Circuit Court, rendered upon the new trial, had in pursuance of the mandate of this Court.

Upon the new trial several exceptions were taken by the counsel for the plaintiff. The first was to the admission of a Mr. Frederick, as a witness for the defendant. It is to be observed, that the sole controversy between the parties at the new trial was, whether the plaintiff was entitled to recover for an alleged breach of his patent by the defendant in using the improved hopper-boy. Frederick, in his examination on the *voir dire*, denied that he had any interest in the cause, or that he was bound to contribute to the expenses of it. He said he had not a hopper-boy in his mill at present, it being then in Court; that it was in his mill about three weeks ago, when he gave it to a person to bring down to Philadelphia; and that his hopper-boy spreads and turns the meal, cools it some, dries it, and gathers it to the bolting chest. Upon this evidence the plaintiff's counsel contended that Frederick was not a competent witness, but the objection was overruled by the Court. It does not appear from this examination whether the hopper-boy used by Frederick was that improved by the plaintiff, or not; but assuming it was, we are of [* 425] opinion that the witness was *rightly admitted. It

is perfectly clear, that a person having an interest only in the question, and not in the event of the suit, is a competent witness; and, in general, the liability of a witness to a like action, or his standing in the same predicament with the party sued, if the verdict cannot be given in evidence for or against him, is an interest in the question, and does not exclude him. If nothing had been in controversy in this case, as to the validity of the patent itself, and the general issue only had been pleaded, the present objection would have

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fallen within the general rule. But the special notice in this case asserts matter, which if true, and found specially by the jury, might authorize the Court to adjudge the patent void, and it is supposed that this constitutes such an interest in Frederick in the event of the cause, that he is thereby rendered incompetent. But in this respect, Frederick stands in the same situation as every other person in the community. If the patent is declared void, the invention may be used by the whole community, and all persons may be said to have an interest in making it public property. But this results from a general principle of law, that a party can take nothing by a void patent; and so far as such an interest goes, we think it is to the credit and not to the competency of the witness. It is clear that the verdict in this case, if given for Evans, would not be evidence in a suit against Frederick, but Frederick would be entitled to contest every step in the cause, in the same manner as if no such suit had existed. *Non constat*, that Frederick himself will ever be sued by the plaintiff, or that if *sued, any recovery can be had against him, [* 426] even if the plaintiff's patent should not be avoided in this suit. It therefore rests in remote contingencies, whether Frederic will, under any circumstances, have an interest in the event of this suit, and the law adjudges the party incompetent only when he has a certain, and not a contingent interest. It has been the inclination of Courts of law in modern times, generally, to lean against exceptions to testimony. This is a case which may be considered somewhat anomalous; and we think it safest to admit the testimony, leaving its credibility to the jury.

Another exception was to the refusal of the Court to allow a deposition to be read by the plaintiff, which had been taken according to a prevalent practice of the State Courts. It is not pretended that the deposition was admissible according to the positive rules of law, or the rules of the Circuit Court;

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and it is not now produced, so that we can see what were the circumstances under which it was taken. No practice, however convenient, can give validity to depositions which are not taken according to law, or the rules of the Circuit Court, unless the parties expressly waive the objection, or by previous consent, agree to have them taken and made evidence. This objection, therefore, may at once be dismissed.

The principal arguments, however, at the bar, have been urged against the charge given by the Circuit Court in summing up the cause to the jury. The charge is spread *in extenso* upon the record, a practice which is unnecessary and inconvenient, and may give rise to minute criticisms and observations upon points incidentally introduced, for purposes of argument or illustration, and by no means essential to the merits of the cause. In causes of this nature we think the substance only of the charge is to be examined; and if it appears, upon the whole, that the law was justly expounded to the jury, general expressions, which may need and would receive qualification, if they were the direct point in judgment, are to be understood in such restricted sense.

It has been already stated, that the whole controversy at the trial turned upon the use of the plaintiff's hopper-boy; and no other of the inventions, included in his patent, was asserted or supposed to be pirated by the defendant.

The plaintiff, with a view to the maintenance of his suit, contended, that his patent, so far as respected the hopper-boy, had a double aspect. 1. That it was to be as a patent for the whole of the improved hopper-boy, that is, of the whole machine, as his own invention. 2. That if not susceptible of this construction, it was for an improvement upon the hopper-boy, and he was entitled to recover against the defendant for using his improvement. The defendant admitted

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that he used the improved hopper-boy, and put his defence upon two grounds. 1. That if the patent was for the whole machine, that is, the improved hopper-boy, the plaintiff was not the inventor of the improved hopper-boy so patented; 2. That if the patent was for an improvement only upon the hopper-boy, the specification did not describe the nature and extent of the improvement; * and if it [* 428] did, still the patent comprehended the whole machine, and was broader than the invention. To the examination of these points, and summing up the evidence, the attention of the Circuit Court was exclusively directed; and the question is, whether the charge, in respect to the matters of law involved in these points, was erroneous to the injury of the plaintiff.

We will consider the points in the same order in which they were reviewed by the Circuit Court. Was the patent of the plaintiff, so far as respects his improved hopper-boy, a patent for the whole machine, as his own invention? It is not disputed that the specification does contain a good and sufficient description of the improved hopper-boy, and of the manner of constructing it; and if there had been any dispute on this subject, it would have been matter of fact for the jury, and not of law for the decision of the Court. The plaintiff, in his specification, after describing his hopper-boy, its structure and use, sums up his invention as follows: "I claim as my invention, the peculiar properties or principles which this machine possesses, in the spreading, turning, and gathering the meal at one operation, and the raising and lowering of its arms by its motion, to accommodate itself to any quantity of meal it has to operate upon." From this manner of stating his invention, without any other qualification, it is apparent that it is just such a claim as would be made use of by the plaintiff, if the whole machine was substantially in its structure and combinations, new. The plaintiff does not

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[* 429] state * it to be a specific improvement upon an existing machine, confining his claim to that improvement, but as an invention substantially original. In short, he claims the machine as substantially new in its properties and principles, that is to say, in the *modus operandi*. If this be true, and this has been the construction strongly and earnestly pressed upon this Court by the plaintiff's counsel, in the argument at the present term, what are the legal principles that flow from this doctrine? The Patent Act of the 21st of February, 1793, ch. 11, upon which the validity of our patents generally depends, authorizes a patent to the inventor, for his invention or improvement in any new and useful art, machine, manufacture, or composition of matter not known or used before the application. It also gives to any inventor of an improvement in the principle of any machine, or in the process of any composition of matter which has been patented, an exclusive right to a patent for his improvement ; but he is not to be at liberty to use the original discovery, nor is the first inventor at liberty to use the improvement. It also declares that simply changing the form or the proportion of any machine or composition of matter, in any degree, shall not be deemed a discovery. It farther provides, that on any trial for a violation of the patent, the party may give in evidence, having given due notice thereof, any special matter tending to prove that the plaintiff's specification does not contain the whole truth relative to his discovery, or contains more than is necessary to produce the effect, (where the addition or concealment shall appear [* 430 to have been to * deceive the public,) or that the thing secured by the patent was not originally discovered by the patentee, but had been in use, or had been described in some public work anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a person's invention ; and provides that in either of these

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cases judgment shall be rendered for the plaintiff, with costs, and the patent shall be declared void. It farther requires, that every inventor, before he can receive a patent, shall swear or affirm to the truth of his invention, "and shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same; and in the case of any machine, he shall fully explain the several modes in which he has contemplated the application of the principle or character by which it may be distinguished from other inventions."

From this enumeration of the provisions of the act, it is clear that the party cannot entitle himself to a patent for more than his own invention; and if his patent includes things before known, or before in use, as his invention, he is not entitled to recover, for his patent is broader than his invention. If, therefore, the patent be for the whole of a machine, the party can maintain a title to it only by establishing that it is substantially new in its structure and mode of operation. If the same combinations existed before

* in machines of the same nature, up to a certain [* 431] point, and the party's invention consists in adding some new machinery, or some improved mode of operation, to the old, the patent should be limited to such improvement; for if it includes the whole machinery, it includes more than his invention, and therefore cannot be supported. This is the view of the law on this point, which was taken by the Circuit Court. That Court went into a full examination of the testimony, and also of the structure of Evans's hopper-boy, and Stouffer's hopper-boy, and left it to the jury to decide, whether, up to a certain point, the two machines were or were not the same in principle. If they were the

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same in principle, and merely differed in form and proportion, then it was declared that the plaintiff was not entitled to recover; or, to use the language of the Court, if the jury were of opinion that the plaintiff was not the inventor of the hopper-boy, he was not entitled to recover, unless his was a case excepted from the general operation of the act. We perceive no reason to be dissatisfied with this part of the charge; it left the fact open for the jury, and instructed them correctly as to the law. And the verdict of the jury negatived the right of the plaintiff, as the inventor of the whole machine. The next inquiry before the Circuit Court was, whether the plaintiff's case was excepted from the general operation of the act. Upon that it is unnecessary to say more than that the point was expressly decided by this Court in the negative, upon the former writ of error. And we think

the opinion of this Court, delivered on that occasion, is correctly understood *and expounded by the Circuit Court. It could never have been intended by this Court to declare, in direct opposition to the very terms of the Patent Act, that a party was entitled to recover, although he should be proved not to have been the inventor of the machine patented; or that he should be entitled to recover, notwithstanding the machine patented was in use prior to his alleged discovery. There is undoubtedly a slight error in drawing up the judgment of the Court upon the former writ of error; but it is immediately corrected by an attentive perusal of the opinion itself. And we do not think that it can be better stated or explained than in the manner in which the Circuit Court has expounded it.

We are then led to the examination of the other point of view in which the plaintiff's counsel have attempted to maintain this patent. That is, by considering it, not as a patent for the whole of the machine or improved hopper-boy, but as an improvement of the hopper-boy. Considered under this

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aspect, the point presents itself which was urged by the defendant's counsel, namely, that if it be a patent for an improvement, it is void, because the nature and extent of the improvement is not stated in the specification. The Circuit Court went into an elaborate examination of the law applicable to this point, and into a construction of the terms of the patent itself, and came to the conclusion that no distinct improvement was specified in the patent; that such specification was necessary in a patent for an improvement, and that for this defect, the plaintiff was not entitled to recover, supposing his patent to be for an *improve- [* 433] ment only of an existing machine. It may be justly doubted, whether this point at all arises in the cause; for the very terms of the patent, as they have been already considered, and as they have been construed at the bar by the plaintiff's counsel, at the present argument, seem almost conclusively to establish, that the patent is for the whole machine, that is, for the whole of the improved hopper-boy, and not for a mere improvement upon the old hopper-boy. But, waiving this point, can the doctrine asserted at the bar be maintained, that no specification of an improvement is necessary in the patent; and that it is sufficient if it be made out and shown at the trial, or may be established by comparing the machine specified in the patent with former machines in use? That there is no specification of any distinct improvement in the present patent, is not denied; that the patent is good without it, is the subject of inquiry. Let this be decided by reference to the Patent Act.

The third section of the Patent Act requires, as has been already stated, that the party "shall deliver a written description of his invention, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science, &c., &c., to make, compound, and use the same." The specifi-

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cation, then, has two objects: one is to make known the manner of constructing the machine (if the invention is of a machine) so as to enable artizans to make and use it, and thus to give the public the full benefit of the discovery after the expiration of the patent. It is not pretended that the plaintiff's patent is not in this respect sufficiently exact and minute in the description. But whether it be so or not, is not material to the present inquiry. The other object of the specification is, to put the public in possession of what the party claims as his own invention, so as to ascertain if he claim any thing that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented. It is, therefore, for the purpose of warning an innocent purchaser or other person using a machine, of his infringement of the patent; and at the same time of taking from the inventor the means of practising upon the credulity or the fears of other persons, by pretending that his invention is more than what it really is, or different from its ostensible objects, that the patentee is required to distinguish his invention in his specification. Nothing can be more direct than the very words of the act. The specification must describe the invention "in such full, clear, and distinct terms, as to distinguish the same *from all other things before known.*" How can that be a sufficient specification of an improvement in a machine, which does not distinguish what the improvement is, nor state in what it consists, nor how far the invention extends;— which describes the machine fully and accurately, as a whole, mixing up the new and old, but does not in the slightest degree explain what is the nature or limit of the improvement which the party claims as his own? It seems to us perfectly clear that such a specification is indispensable. We do not say that the party is bound to

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describe the old machine ; but we are of opinion that he ought to describe what his own improvement is, and to limit his patent to such improvement. For another purpose, indeed, with the view of enabling artizans to construct the machine, it may become necessary for him to state so much of the old machine as will make his specification of the structure intelligible. But the law is sufficiently complied with in relation to the other point, by distinguishing, in full, clear, and exact terms, the nature and extent of his improvement only.

We do not consider that the opinion of the Circuit Court differs, in any material respect, from this exposition of the Patent Act on this point ; and if the plaintiff's patent is to be considered as a patent for an improvement upon an existing hopper-boy, it is defective in not specifying that improvement, and therefore the plaintiff ought not to recover.

Upon the whole, it is the opinion of the majority of the Court, that the judgment of the Circuit Court ought to be affirmed with costs.

Mr. Justice LIVINGSTON dissented. At this late period, when the patentee is in his grave, and his patent has expired a natural death, we are called on to say, whether his patent ever had a legal existence, and it may seem not very important to the representatives of the patentee what may be the decision of this Court. But understanding that many other actions are pending for a violation of this part of the patent-right, and that infractions have taken place for which actions may yet be commenced, and believing that the *decision we are about to make will have a very [* 436] extensive, if not a disastrous bearing on many other patents for improvements, and will in fact amount to a repeal of many of them, I have thought proper to assign my reasons for dissenting from the opinion just delivered.

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In doing this, my remarks will be confined principally to the charge of the Court, so far as it applies to the claim of Evans for an improvement on a hopper-boy.

I was much struck with the argument of the plaintiff's counsel in favor of the patent being for an original invention, and not for an improvement; nor would it in my opinion be a forced construction, to regard it as a patent for a combination of machines to produce certain results, and not for any of the machines, nor the different parts of which the whole is composed.

But considering it as a patent for an improvement on a hopper-boy, in which light it had been regarded as well by the Circuit as by this Court, when this cause was here before, I proceed to examine the charge, so far as it relates to this part of the subject.

The Court, after stating in what particulars the plaintiff's counsel contended that his improvement consists, which is unnecessary to repeat here, proceeds —

“The plaintiff has laid before you strong evidence to prove that his hopper-boy is a more useful machine than the one which is alleged to have been previously discovered and in use. If, then, you are satisfied of this fact, the [*437] point of law which has been *raised by the defendant's counsel remains to be considered, which is, that the plaintiff's patent for an improvement is *void because the nature and extent of his improvement is not stated in the specification.*

“The patent is for an improved hopper-boy, as described in the specification, which is referred to and made part of the patent. How does the specification express in what his improvement consists? It states all and each of the parts of the entire machine, its use and mode of operating; and claims as his invention, the peculiar properties or principles of the machine, namely, the spreading, turning, and gather-

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ing the meal, and the raising and lowering of its arms by its motion, to accommodate itself to the meal under it. But does this description designate the improvement, or in what it consists? Where shall we find the *original hopper-boy described*, either as to its construction, operation, or use, or by reference to any thing by which a knowledge of it may be obtained? Where are the improvements on such originals stated? The undoubted truth is, that the specification communicates no information whatever upon any of these points." And after some farther reasoning on the subject, and showing that the plaintiff's case is not excepted from the general rule of law, by the act which was passed for his relief, the Court declares that for this imperfection or omission in the specification, the "plaintiff is not entitled to recover for an alleged infringement of his patent for the improvement on the hopper-boy." This was equivalent to saying that for this defect in the specification, the patent for the improved hopper-boy was void, and, * of course, that no ac- [*438] tion at all, whatever might be the state of the evidence, could be maintained for the use of it. It left nothing, as it regarded the improved hopper-boy, for the jury to decide. Such is the charge, and it is delivered in terms too plain to be misunderstood.

The objections to it are now to be considered. In doing this it will be shown,

1st. That the specification is not defective, and that although it does not discriminate in what particulars the machine in question does differ from other hopper-boys in use, yet, if from the whole of the description taken together, the machine is specified so minutely, and so accurately, as to be directly and easily distinguished from all other hopper-boys antecedently known, every thing has been done which the law requires, and the patent is good.

2d. That if the specification be vicious in the points men-

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tioned, the patent ought not to be considered as absolutely void ; but it is enough, and the public interest is sufficiently guarded, if care be taken that it shall not be extended to create a monopoly in any other machine, which may or may not be mentioned in the patent, which was previously known or in use. And,

3d. That if a patent must be set aside for such defect in the specification, it should be left to the jury, on the evidence before them, to decide whether the improvement patented be not set forth with all necessary precision.

. 1. I have said the specification is not defective.

In determining this question, it would seem but [*439] * natural and just that the validity of a patent granted under a particular Act of Congress, should be tested by the terms there used, and by the decisions of our own Courts, so far as they are of authority, and that we should be extremely cautious in adopting the rules which have been introduced into other countries, and under laws not in every respect like our own, however respectable the tribunals may be which may have prescribed those rules ; and this the more especially, as most of the decisions in England, which are generally cited, and seem to have been implicitly followed in this country, are of a date long subsequent to the revolution, and many of them posterior to the passage of the Patent Laws in this country, and which could not therefore have been in the contemplation of Congress at the time. Besides, there is somewhat of hardship in constantly applying to a patentee in this country, adjudications made on a British Act of Parliament very unlike our own, and with which decisions he has no means of becoming acquainted until long after a knowledge of them can be of any service. Already have we extended to patents for improvements on old machines, several recent decisions in England, although it was long doubted in that country, and as late as the year 1776,

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whether by the Act of the 21 James I. c. 3, there could be a patent for an addition only. When the English Courts decided in favor of such patents, they also made rules for their construction, as cases arose ; there being no direct provisions in the statute on the subject. As we have provided by law, not only for the security of inventions entirely new, but also for the * protection of those who may dis- [* 440] cover any new and useful improvement on any art, machine, &c., not known or used before, and have prescribed the terms on which patents under it may be obtained, it would seem, if all those terms are complied with, and the invention be really new and useful, that no Court can have a right to add any other terms, or to require of a patentee any thing more than what the law has enjoined on him. Let us now try the patent before us by this rule : — The Act of the 21st February, 1793, c. 11, after stating in what cases letters-patent for inventions may issue, and how they are to be obtained, requires, *inter alia*, that the inventor, before he receives his patent, shall take a certain oath, and shall deliver a written description of his invention, and of the manner of using the same, in such full, clear, and exact terms, as *to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make and use the same.* And in the case of a machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle, or character by which it may be distinguished from other inventions ; and he is to accompany the whole with drawings and written references, where the nature of the case admits of it ; and a model of his machine, if required by the Secretary of State, is also to be delivered.

In the present case, the patent is for an improved hopper-boy ; a particular description of which, and its uses,

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[* 441] will be found in 3 Wheat. Rep. 466. It is * not pretended that this machine, if made in conformity with the description given by Mr. Evans, could not in fact be distinguished from every thing else before known, when brought into comparison with it, nor that a skilful person, from its description, would not be able to make one like it; which would seem to satisfy every requisition of the law. But the defendant's counsel say this is not enough. It should not only in its organization and aggregate be different from every thing else, but every respect in which it differs in its construction or operation from other machines, should be minutely stated in the specification; or, in other words, that other machines heretofore used for similar purposes, should be either described or referred to therein, and the differences between the patented machines and those in former use, be carefully designated.

The answer to this is, that the law does not require it — that it is impracticable, and would be of no use.

We have seen already that the law prescribes no precise form of specification, which would have been impracticable, and imposes no obligation to describe, in any particular mode, the machine in question. Not a word is said as to showing in what particulars the improvement patented differs from all other machines for the same purpose then in use. If, on the whole description taken together, the machine of the plaintiff can be distinguished from other machines, when compared with his, the words and the object of the law are satisfied. The law appears to have nothing else in view, in requiring a specification, than the instruction of the [* 442] * public; that is, to guard them against a violation of the patented improvement, and to enable them, when the letters-patent expire, from the specification filed, to make a machine similar to the one which had been patented. The only inquiry, therefore, ought to be, whether

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this obvious intention of the legislature has been answered by the particular specification which may be the subject of litigation; and if enough appears, either to prevent a person from encroaching on the right of the patentee, or to enable a skilful person to make a machine which shall not only resemble the one patented, but produce the like effect; more ought not to be required. Whether these ends be attained by a particular description of every part of the improved machine, or by describing in what respect it differs from other machines, can make no difference. The information to the public is as valuable and intelligible, if not more so, in the former case, than in the latter. If it be, taken altogether, an improved machine, for the purpose of producing certain results, and so described that it may be distinguished from other machines, and that others may be made on the same model, it is a literal compliance with all that the law requires. If the different parts of the machine, and their combination, or connection, be accurately described, or intelligibly set forth, why should it not be supported, although no reference be made to other machines dissimilar in their construction, and which, although applied for the same purpose, are inferior in the beneficial results produced by them? To the objection, that it does not precisely appear in *what [*443] the patent hopper-boy differs from those antecedently in use, the answer is, and it ought to be conclusive, that the patentee does not mean to abridge or restrain the public from using those or any other machines, so that they differ from the one described by him; and that any mechanic, on having his specification before him, can avoid an interference with his invention. To confine our examination to the only hopper-boy which was produced on this trial, and which was called Stouffer's hopper-boy, and of which a model has been exhibited to the Court, together with a model of Evans's improved hopper-boy, can a doubt be entertained

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for an instant, that they are very dissimilar, and that any mechanic would not, in a moment, point out the distinctions between them, either from the specification or the model — or that he would not be able to make a Stouffer hopper-boy, or the improved hopper-boy of Evans, as he might be directed; and in like manner he would be able, when brought together, to discriminate between any other hopper-boy and that of Evans, provided they were different, so that those who were desirous of having a hopper-boy, on an old construction, and of not interfering with the rights of Mr. Evans, would labor under no difficulty whatever? But inasmuch as Evans himself has not discriminated or exhibited in his specification all the points of difference between his and other hopper-boys, it is supposed that his patent is for some hopper-boy already in use, as well as for his improvement thereon. The very terms of his specification pre-
[* 444] cluded every supposition of that kind. If there were a thousand of those machines, on different constructions, in use before the date of his patent, he leaves to the public the undisturbed enjoyment of them. He meddles not, nor does he pretend to interfere with any of them, until they make or use one constructed, in all its parts, upon his model. That form, and that form alone, he claims as his invention or improvement. It would not have been difficult, even from British authorities, to show that this specification was sufficient; but I prefer recurring to our own law as the only proper criterion of the validity or invalidity of the specification in question. My opinion is, that it has all the certainty which is required by law.

Such a specification as is required by the Circuit Court, is not only not prescribed by law, but, to me, it appears to be one extremely difficult, if not impracticable.

If the inventor of an improved hopper-boy is to discriminate, in his specification, between his improvements and any

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particular hopper-boy, which may be produced on the trial, and is to be non-suited for not having done so, however correct and distinguishing it may be in every other respect, he must do the like as to all other hopper-boys ; and if he must describe any, he must describe all others with which he may be acquainted ; and, after all, some one may be introduced at the trial, of which he had never heard, or which he had never seen ; and inasmuch as he had not stated in what respects it was improved by his machine, although this would immediately be seen on inspection, he must not only fail

* of recovering damages for a manifest violation of [* 445] his right, but must have his patent declared void by the Court, without a trial by jury, and be deprived of the fruits of a most valuable improvement, not because he was not the *bonâ fide* inventor — not because he had not described his improvement with sufficient certainty, according to the Act of Congress — but because something more was required of him, of which he had no means of information. The only hopper-boy which made its appearance on this trial, except the plaintiff's, was that known by the name of the Stouffer hopper-boy ; but *non constat*, that there may not have been a hundred different kinds in use, and some entirely unknown to the plaintiff. If he could have described them all, which would not have been an easy task, and stated in what particulars his hopper-boy differed from them all, his specification would have extended to an immoderate length, and, after all, have been less intelligible and satisfactory than a full description, such as is given here, of all the parts of which his consisted, and of the manner in which they are put together. There may be cases in which an improvement may be so simple as to describe it at once by reference to the thing or machine improved, as in the case of an improvement of this kind on a common watch. But even in the case of a watch, if the improvement pervades the whole machine, it

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would be a compliance with the terms of the law, if the patentee described every part of his improved watch, with its principle, without discriminating particularly in what respect his different wheels, &c., varied from all other [* 446] watches * then in use. Many patents have been obtained for improvements on stoves, locks, &c.; but has it ever been required of the patentee, in such cases, not only to describe in what manner his stove or lock is constructed, and the benefits resulting from such construction, but to point out every particular in which they differ from those already in use? This, to say the least, would be a work of great labor, and of little or no use to the public, who would be at liberty to use a stove or lock of any construction, not interfering with the one described in the specification of the patentee.

A few observations will show that such a description as the defendant's counsel contend for, would be of no greater use than the one which Mr. Evans has adopted. After all the pains to discriminate had been taken, the question would still recur, how is the improved hopper-boy to be constructed? and if, from the specification, that could not be ascertained, then, and then only, ought it to be pronounced defective. But if, from the description, the improved hopper-boy could be made by a skilful mechanic, then the public is informed, not only of what has been patented, but of what still remains common as before, and if an action be brought for a violation of the patented right, and it should appear that the hopper-boy used is not of such construction, the plaintiff must fail in his suit. It cannot be said, with any justice, that if the discrimination be not made, the patent includes not only the improvement, but the old machine on which the [* 447] improvement is ingrafted. * The old machine still remains public property; may be used by every one; nor can any person be considered as infringing on the

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patent-right, until he adds to the machine already in use, the improvements of the patentee, or, in other words, until he makes a machine resembling, in all its parts, the one which is described in the specification.

2d. But if the specification be defective in the points which have been mentioned, is the patent therefore necessarily void? This is a question of vital importance to every patentee.

I am aware that it has been said in England, that the patent must not be more extensive than the invention; therefore, if the invention consists in an improvement only, and the patent is for the whole machine, it is void. But I am not aware that it has ever been decided there, that when a patent is for an "improved machine," and is taken out *only* for the machine *thus* improved, and not for the machine as before used, that such patent is void. But whatever may have been some of the late decisions in that country, I prefer, and think it the better course, to consider this question also under our own act, which, in this respect, is different from the English statute, and will therefore afford us more light, and be a safer guide than either that statute or the judgment on it. In what part, then, of our act, may it be asked, is an authority given to the Federal Courts to declare a patent void for a defective specification, however innocently made, and which in its consequences can injure no one? I state the question in this way, not because I think it necessary to show that if injurious consequences * might flow [* 448] from an imperfect specification, a patent must necessarily be declared void, but because I think it must be admitted that there is no evidence whatever in this cause, to induce any one to believe that Mr. Evans either intended to take, or that he did receive a patent for any thing beyond his invention, which was the hopper-boy in the improved condition in which he describes it. To declare a patent for a highly useful improvement absolutely void, merely for a de-

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fective specification, if this be one, is a very high penalty, and should not be lightly inflicted, unless rendered absolutely necessary by law ; the more especially as, without recurring to so harsh a measure, a Court and jury will always be able to confine a remedy on the patent to violations of the improvement actually secured, and if the patentee should be so foolish or ill-advised as to attempt to bring within its reach the machine in its unimproved state, or any other machine before common, he would do it, not only with no prospect of success, but with the certainty of a defeat, attended with a very heavy expense. As long, therefore, as he could maintain no action, but for his improvement, it is not perceived why he should be visited with so heavy a denunciation as the forfeiture of his improvement, merely because, by some construction of his specification, which might after all be a mistaken one, he had included in his invention, something of ever so trifling a nature, which was already known. But if such be the law, and such the frail tenure on which these

rights are held, however hard it may apply in particular cases, it must have its course. But * I cannot

think it our duty, or that we have any right to pronounce a patent void on this account ; but that this important office is exclusively confided to a jury. Whether we have this right or not, will now be examined. If such summary authority were intended to have been conferred on the Federal Courts, the Patent Law ought to have been, and would have been, explicit. This is so far from being the case, that in the Patent Law, a provision, but of a different kind, is inserted on this very subject, which is not the case in the statute of James. It was foreseen, that it must sometimes happen, either from the imperfection of language, or the ignorance of a patentee, that defective specifications would be made ; it was also foreseen, that an imperfect specification might be made from design, and with a view of deceiving the

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public. We accordingly find it provided by law, that among other matters which the defendant may rely on in an action for infringing a patent-right, is, "that the specification filed does not contain the *whole* truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment, or addition, must *fully* appear to have been made for the purpose of *deceiving* the public." If judgment is rendered for the defendant on this ground, the patent is to be declared void. This section applies as well to patents for an improvement on an existing machine, as for an invention entirely new ; and was intended to protect the patent in either case against an avoidance for an imperfect and innocent specification of the invention patented. If, therefore, the defect which is alleged, *really exist in the specification of the patented [* 450] improvement, the Court is not authorized, on its mere inspection, to declare it imperfect, and the patent on that account void. Both questions are clearly questions of fact, and are so treated by the legislature. The party has a right to insist with the jury, not only that his specification is perfect, but that if it be otherwise, no deception was intended on the public ; and on either ground, they may find a verdict in his favor. So if, on the allegation, that the thing secured by patent was not originally discovered by the patentee, a verdict passes against the plaintiff, he loses his patent. In like manner, in this case, if it had appeared that the "improved hopper-boy," which was the thing secured by patent, had not been originally discovered by Mr. Evans, and a verdict had passed against him on that ground, there would have been an end of his patent. From the tenth section, also, an argument may be drawn against the right of a Court to declare a patent void on mere inspection, for redundancy or deficiency in a specification. This section provides a mode of proceeding before the District Court, where there may be

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reason to believe a patent was obtained surreptitiously, or upon false suggestions; and if, on such proceeding, it shall appear that the patentee was not the *true inventor*, judgment shall be rendered by such Court for a repeal of the patent. This is the only case in which a power is conferred on a Court, to vacate a patent, without the intervention of a jury. If a proceeding of this kind had been instituted before the proper tribunal against Mr. Evans, the Court would [* 451] * have examined witnesses, and have formed its opinion on their testimony; and it is not clear that even in this case a jury might not have been called in. This section has been taken notice of, to show that it could never have been the intention of the legislature, that a patent should be avoided, on any account whatever, on the opinion of the Court alone, without some examination other than that of the specification, whatever might be its excess, or poverty of description. If it had been intended to vest so important a power in the Court, it would not have been left to mere implication, but would have been conferred in terms admitting of no doubt. My opinion, therefore, on this part of the charge is, that the Court erred in taking upon itself to pronounce the patent void, even if the specification had been defective, or imperfect, in not particularly describing what the improvements of the patentee were; this being a power expressly delegated to a jury, who, under all the circumstances of the case, are to decide both questions of fact; that is, whether the specification be deficient, or superfluous, and the *intention* with which it was made so. I repeat once more that, whatever may have been the decisions in England, which are not admitted to be contrary to the view which has here been taken of the subject, they are not of authority, and are upon an act so very different in its structure from our own, as to afford little or no useful information upon the subject. One great and important difference in the two laws is, that

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the statute of James I. has not prescribed a mode in which a patent for a vicious specification is to be set aside.

* The patent is granted on condition that a speci- [* 452] fication be enrolled.

I give no opinion on the questions which arise from the admission of certain witnesses, who were supposed to be disqualified, on the score of being interested; for if the patent for the hopper-boy be void, for a defect in its specification, and that question is not to be referred to the jury, and such I understand to be the opinion of four of the judges, it is very unimportant whether any error was committed in this respect by the Court before which the cause was tried; as a verdict must ever be rendered against the representatives of the patentee, on this ground, whatever may be the state of the evidence.

Mr. Justice JOHNSON, and Mr. Justice DUVALL, also dissented.

Judgment affirmed with costs.

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[7 Wheat. 453.]

It is no objection to the competency of a witness in a patent cause that he is sued in another action for an infringement of the same patent.

The 6th section of the Patent Act of 1793, c. 156, which requires a notice of the special matter to be given in evidence by the defendant under the general issue, does not include all the matters of defence which the defendant may be legally entitled to make. And where the witness was asked, whether the machine used by the defendant was like the model exhibited in Court of the plaintiff's patented machine, *held*, that no notice was necessary to authorize the inquiry.

Where a deposition has once been read in evidence without opposition, it cannot be afterwards objected to as being irregularly taken.

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It is no objection to the competency or credibility of a witness, that he is subject to fits of derangement, if he is sane at the time of giving his testimony.

ERROR to the Circuit Court of Pennsylvania.

This was an action for the infringement of the same patent as in the preceding case of *Evans v. Eaton*, and was argued by the same counsel. The points involved will be found to be fully discussed in the argument of that case, to which the learned reader is referred. The following is the charge delivered to the jury in the Court below, which it is thought necessary here to insert.

After stating the evidence on both sides, Mr. Justice WASHINGTON proceeded as follows:

The facts intended to be proved by the evidence given in this cause, may be arranged under the following heads:

[* 454] *(1.) Such as respect the value of the plaintiff's hopper-boy. (2.) The time of its discovery. (3.) The kind of machine used by the defendant. (4.) The time of its discovery and use.

1st. As to the first, the Court has no observations to make, except that if you should find a verdict for the plaintiff, you will give the actual damages which the plaintiff has sustained, by reason of the defendant's use of his invention, which the Court will treble.

2d. The evidence applicable to this head, if believed by the jury, proves, that, in 1783, Oliver Evans commenced his investigation of the subject of an improvement in the manufactory of flour; and in the summer of the same year, he declared that he had accomplished it. In 1784, he made a model of his hopper-boy, which had no cords, weight, or pulley; and consequently the lower arm was, for the sake of the experiment, turned by the hand. In 1785, it was in operation in a mill, in as perfect a state as it now is.

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3d. If the witness who was called to prove the kind of machine used by the defendant is believed by the jury, it consists of an upright square shaft, with a cog that turns it, and which is moved by the water power of the mill. This shaft is inserted into a square mortice, in an arm or board somewhat resembling an S, with strips of wood fixed on its under side, and so arranged as to turn the meal below it, cool, dry, and conduct it to the bolting chest. This arm slips, with ease, up and down the shaft, and must be raised by hand, and kept suspended * until the meal is put [* 455] under it. It has no upper arm, pulley, weight, or leading lines ; and the strips below the arm are like the rake, as it is called, in the plaintiff's hopper-boy. This machine has acquired the name of the S, or the Stouffer hopper-boy.

4th. The witnesses examined to prove the originality, and use of the defendant's hopper-boy, if believed by the jury, date it as early as about the year 1765 ; and its erection and actual use in mills, in 1775 and 1778 ; and progressively to later periods. Objections have been made, on both sides, to the credit of some of the witnesses who have been examined, not on the ground of want of veracity, or of character, but of interest, short of that which can affect their competency. These objections have been pressed so far beyond their just limits, as to require from the Court an explanation of their real value. Where the evidence of witnesses opposed by other witnesses is relied upon, by either side, to prove a particular fact, the jury must necessarily weigh their credit, in order to satisfy their own minds on which side the truth is most likely to be ; and in making this inquiry, every circumstance which can affect the veracity of the witnesses, whether it concerns their moral character, or whether it arises from some interest which they may have in the question, or from feelings favorable to one or the other of the parties, should be

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taken into the calculation. But if the fact in controversy may exist, without a violation of probability, and the proof is by witnesses exclusively on that side, there is nothing to put into the opposite scale, against which to weigh the credit [* 456] of those witnesses ; * and if the objection to their credit be worth any thing, it must be to the full extent of rejecting their testimony altogether, or else it is worth nothing. The jury cannot compromise the matter, or halt between two opinions ; — they must decide that the fact is so, or is not so ; and if the latter be cause of objection to the credit of the witnesses, it would amount to the confounding of the questions of competency, and credibility ; for the effect would be the same, whether the Court refused to permit the witnesses to testify on the ground of incompetency, or the jury should reject their testimony, when given, on that of want of credibility. I have thought it proper to submit these general observations to the consideration of the jury.

We come now to the question of law, which arises out of these facts, which is,

What are *the things* in which the plaintiff alleges, and has proved, he has an exclusive property, which he asserts the defendant has used, and which the defendant denies ?

The first claim is for an improved hopper-boy, which the plaintiff insists is granted by his patent, which has received the sanction of the Supreme Court ; and which the defendant acknowledges. This being, then, conceded ground, the Court will proceed to examine it ; and the inquiry will be, whether the plaintiff is entitled to a verdict for an infringement of his patent for his improved hopper-boy. The objection relied upon by the defendant is, that the plaintiff has not set forth in his specification what are the improvements of which [* 457] he * claims to be the inventor, so that a person skilled in the art might comprehend distinctly in

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what they consist. This objection, in point of fact, is fully supported. Neither the specification, nor any other document connected with the patent, states, or even alludes to, any specific improvement in the hopper-boy. Taking this as true, how stands the law? The 3d section of the Patent Law declares, that "before an inventor can receive a patent, he shall deliver a written description of his *invention*, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable a person skilled in the art, &c., of which it is a branch, &c., to make and use the same."

What, then, is the plaintiff's invention, as asserted by his counsel, conceded by the defendant, and sanctioned by the Supreme Court in the case of *Evans v. Eaton*? The answer is, an improvement of the hopper-boy, or an improved hopper-boy, which that Court has declared to be substantially the same. If this be so, then the above section of the law has declared, that he must specify this improvement in full, clear, and exact terms. If he has not done so, he has no valid patent on which he can recover.

The English decisions correspond with the injunctions of our law. *Boulter v. Bull*, *Boville v. Moor*, *M'Farlane v. Price*, *Harmen v. Playne*.¹ The American decisions, so far as we have any reports of them, maintain the same doctrine. Mr. Justice *Story*, in the case of *Lovel v. Lewis*, lays it down, * "that if the patent be for an *improve-* [* 458] *ment* in an existing machine, the patentee must, in his specification, distinguish the new from the old, and confine his patent to such parts only as are new; for if both are mixed together, and a patent taken for the whole, it is void." What is the reason for all this?

¹See 3 Wheat. Rep. App. 21, ante, 288.

In the first place, it is to enable the public to enjoy the full benefit of the discovery, when the patentee's monopoly is expired, by having it so described on record, that any person skilled in the art, of which the invention is a branch, may be able to construct it. The next reason is, to put every citizen upon his guard, that he may not, through ignorance, violate the law, by infringing the rights of the patentee, and subjecting himself to the consequences of litigation. The inventor of the original machine, if he has obtained a patent for it, and all persons claiming under him, may lawfully enjoy all the benefits of that discovery, notwithstanding the improvement made upon it by a subsequent discoverer. If he has not chosen to ask for a monopoly, but abandoned it to the public, then it becomes public property, and any person has a right to use it. The inventor of an improvement may also obtain a patent for his discovery, which cannot legally be invaded by the inventor of the original machine, or by any other person. These rights of each are secured by law, and there is no incompatibility between them. But if a man, wishing to use the original discovery, and honestly disposed to avoid an infraction of the improver's right, is unable to discover, from any certain and known standard, when the original [* 459] invention ends, and * the improvement commences, how is it possible for him to exercise his own acknowledged right, freed from the danger of invading that of another? And to what acts of oppression might not this lead? Might not the patentee of this mysterious improvement obtain from the ignorant, the timid, and even the prudent members of society, who wish to use only the original discovery, the price he chooses to ask for a license to use his improvement, and in this way compel them to purchase it, rather than incur expenses and inconveniences far greater than the sum demanded? If this may happen, then the improver enjoys, in a degree, the benefit of a discoverer, both of the original

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machine, and also of the improvement. In short, the patentee of the improvement may, to a certain extent, keep men at arm's length as to the use of the original invention, or make them pay him for it, in derogation of the rights of the inventor of the original machine. If the law, as applicable to cases in general, be rightly laid down, the next inquiry is, is the present an excepted case? The plaintiff's counsel have not directly asserted it to be so; but they have referred, with some emphasis, to what is said by the Supreme Court, in the case of *Evans v. Eaton*.¹ The expressions are, "In all cases where the plaintiff's claim is for an improvement on a machine, it will be incumbent on him to show the extent of his improvement, so that a person understanding the subject, may comprehend distinctly in what it consists."

This decision does not state in what way the *extent of the plaintiff's improvement is to be [* 460] proved; nor did the case require that the Supreme Court should be more explicit. The obvious conclusion is, that the Court left that matter undecided, and meant that the extent of the plaintiff's improvement should be shown according to rules of law. A contrary construction would be most unfair and unwarranted.

Is it possible to believe, that if the Supreme Court intended to decide contrary to the provisions of the 3d section of the Patent Law, and of the English and American decisions, that this was a case without the influence of that law, and those decisions, that such intention would have been expressed in such general terms? This cannot be admitted; neither can the private Act for the relief of Oliver Evans warrant the argument, that this case is freed from the restrictions contained in the 3d section of the Patent Law; because,

¹ 3 Wheat. Rep. 518, *ante*, 285.

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except as to the extent of the grant, it refers to, and the Supreme Court in the before-mentioned case, considers it as within, the provisions of that law.

Is it likely that the Supreme Court could have meant that the plaintiff might cure the defects of his specification by *proving to the jury* in what his improvement consisted? If so, then, as to the present defendant, such an explanation would be unavailing to save him from the consequences of an error, against which the sagacity of man could not have guarded him. He has sinned already, if he has invaded the plaintiff's right, and it is too late to convince him of his error, if he must be a victim of it, for the want of that light, which is now shed upon the act long after his supposed transgression.

[* 461] But of * what avail would that explanation be, after the expiration of the plaintiff's monopoly? The parol evidence given in a court of justice being seldom recollected with accuracy, it affords the most unsafe notice of facts, particularly when they respect matters of art, that can well be supposed. What man, who wishes not to invade the plaintiff's patent, would venture to erect a hopper-boy merely upon the information which he could gather from this trial? He could obtain none upon which he could safely rely; nor could any artist, after the expiration of the plaintiff's right, be enabled from such a source, to know how to construct the improved hopper-boy. But even if the extent of the improvement could be proved in this way, the plaintiff has not attempted to prove it, and what is more, his counsel, though repeatedly called upon to point it out, have not been able to do it.

Can the jury, without evidence, and without the aid of the plaintiff, or his counsel, say in what those improvements consist? If they had never seen another hopper-boy, supposed to be the original, this would be impossible. If, having seen the Stouffer hopper-boy, they can do by so comparing with it the plaintiff's improved hopper-boy, then the consequence

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seems almost to be inevitable, that the Stouffer hopper-boy is the original one; the point, which under the next head, is denied by the plaintiff. But if the specification had stated in what the plaintiff's improvement consisted, still he is not entitled to a verdict for a violation of his patent, unless he has proved, to your satisfaction, that the defendant has infringed it.

* Upon the whole, then, this patent, so far as [* 462] it is for an improvement, cannot be supported; and as to any claim founded on this right, the plaintiff is not entitled to your verdict.

2. The plaintiff contends that he is the original inventor, not only of the improved hopper-boy, but of the whole machine; that his patent grants him the exclusive right for both; and that this claim has received the sanction of the Supreme Court. Whether, in point of fact, he is the original inventor of the hopper-boy, will be attended to hereafter. Neither shall I stop to inquire whether the plaintiff's patent grants him the right, because if the Supreme Court has sanctioned the claim, that is law to this Court. The part of the decision of that Court, relied upon by the plaintiff's counsel, is found in 3 Wheat. Rep. 517, where the Chief Justice says, "The opinion of the Court, then, is, that Oliver Evans may claim under his patent the exclusive use of his inventions and improvements in the art of manufacturing flour and meal, and in the several machines which he has invented, and in his improvements on machines previously discovered.

It would seem almost impossible to misunderstand this positive declaration of the Court. It appears to be the result of the previous reasoning. It states that the plaintiff may claim, (1.) The exclusive use of improvements, and inventions, in the art of manufacturing flour. (2.) In the *several machines* which he has invented. (3.) In his *improvements* on machines previously discovered. As to the 1st, there is no dispute

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[* 463] * in the cause. The 3d has been already disposed of, and the 2d will now be examined. It is contended by the defendant's counsel, that this is not the correct construction of the above sentence of the Court, because it is inconsistent with the pretensions of the plaintiff's counsel, and with the argument of the Chief Justice, throughout the opinion, which led to the above conclusion. This supposed inconsistency may, in the opinion of this Court, be explained by the following observations :

The exceptions taken to the charge of this Court, in the case of *Evans v. Eaton*, were, 1st. that Oliver Evans's patent was only for the combined effect of all the machines mentioned in his patent, and, 2d. in directing the jury to find for the defendant, if they should be of opinion that the hopper-boy was in use prior to the improvement alleged to be made by Oliver Evans. These were the only questions presented to the view of the Supreme Court, upon which it was deemed proper by that Court to give an opinion. The reasoning of the Chief Justice, therefore, is intended to prove, and correct these errors in the charge, by showing that Oliver Evans was entitled, by his patent, and the accompanying documents, not only to the general combination of the different machines, but to an *improvement* on the hopper-boy, one of the machines used in combination. If he had a right to an improvement on the hopper-boy, then this Court was clearly wrong in directing the jury to find a verdict for the defendant, if they should be of opinion that the hopper-boy was in use prior to the plaintiff's improvement ; because it was un-

[* 464] important who was * the original discoverer of the hopper-boy, provided the plaintiff had a patent for an improved hopper-boy, and the defendant used that improvement, and the charge precluded that inquiry. But whilst the Chief Justice aims to prove that Oliver Evans was entitled to this double claim, he does not exclude any other

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claim. There is an expression relied upon by the defendant's counsel, as having this appearance ; but it is more likely that the word relied on is a typographical error, than that the Court should both deny and affirm the plaintiff's right, as an original inventor of the hopper-boy. When the Court came to state, definitively, what were the plaintiff's claims under this patent, the whole are distinctly stated. The Act for the relief of Oliver Evans authorizes a grant to him of his improvement, in the art of manufacturing flour, and in the several machines which he has invented, and in his improvements, &c. The Court says, that "the application is for a patent coextensive with the act," &c.¹

If, then, in this enumeration of the plaintiff's rights under the patent, those to the machines had been omitted, it might have been supposed that it was not recognized by that Court, and it is consequently introduced, in order to prevent a conclusion against its validity, although it had not been brought into view in the previous argument ; because a matter not in dispute. This course of reasoning is, we think, strongly fortified, by what the Court says, p. 518. "In all cases where his claim is for an *improvement*," &c. Now, if his claim was confined to an improvement, * produced [* 465] by the combined operation of all the machines, and if an improvement in the separate machines, why should the Court have stated, hypothetically, that which was to be proved in case the plaintiff claims for an improvement ? The sentence following immediately that which has been relied on by the defendant's counsel seems to explain it, and to fortify the construction which we have given to it. Upon the whole, we are of opinion, that the question, who is the original inventor of the hopper-boy ? is left open by the Supreme Court,

¹ 8 Wheat. Rep. 508, *ante*, 277.

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and is now to be decided by the jury. If, then, the jury should be of opinion upon the evidence, that the hopper-boy which the defendant uses, was invented, and was in use prior to the discovery of Oliver Evans, then your verdict ought to be for the defendant. But to this construction there are objections made, which it is proper to notice.

1. It is contended, that the *judgment* of the Supreme Court in *Evans v. Eaton*,¹ where it is said that there is error in the proceedings below, in this, that in the charge the opinion is expressed, "that Oliver Evans was not entitled to recover if the hopper-boy *in his declaration mentioned* had been in use previous to his alleged discovery," entitles the plaintiff to a verdict, although the jury should be of opinion that he is not the original inventor of the hopper-boy. That the Court did not mean this is most obvious, from what is said in page 517, that Oliver Evans may claim the exclusive use in the several machines *which he has invented*.

[* 466] Could the Supreme Court * intend to say, immediately after, that he is entitled to a verdict for a machine which he has not invented? Can it be supposed that the Court meant to ride over the 3d section of the Patent Law, and set up a different rule, to govern this case, without having stated the reasons for so extraordinary a distinction? This is altogether inadmissible. It is also worthy of remark, that the words, "in his declaration mentioned," in the judgment of the Supreme Court, are not in the charge of the Circuit Court, as stated by the Chief Justice; and it is the insertion of those words in the judgment which produces all the difficulty. Leave them out, and then the judgment is consistent with the whole reasoning of the Chief Justice, which condemned the charge of the Circuit Court, because it

13 Wheat. Rep. 519, ante, 286.

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precluded Oliver Evans from obtaining a verdict for his *improvement*, if he was not the original inventor of the elementary parts of this machine. Retain them, and it follows, that if Oliver Evans was proved not to be the inventor of the hopper-boy in his declaration mentioned, still the defendant was not entitled to a verdict. This would be in such direct opposition to the 6th section of the Patent Law, that we cannot suppose this was the meaning of the Supreme Court.

2. The next objection to the construction is, that the Act of the Legislature of Pennsylvania, of 1787, conveyed to Oliver Evans the original hopper-boy, and consequently the existence and use of the Stouffer hopper-boy, at a period prior to the plaintiff's discovery, cannot now be urged to invalidate his patent. It is by no means to be admitted that the act operates to make such a * transfer. But if it [* 467] did, still the plaintiff cannot recover, if he appears not to be the first or original discoverer of the hopper-boy. His claim is not derivative either from the State or from an individual. His suit is founded on his patent, and unless he was himself the original inventor of the hopper-boy, he cannot recover.

Another objection stated by the plaintiff's counsel is, that the Stouffer hopper-boy, although the jury should believe it was in use in many mills before the plaintiff's discovery, had fallen into disuse, and therefore cannot be urged to invalidate the plaintiff's right of recovery. The answer to this is, that whether it fell into disuse or not, if it was used before the plaintiff's discovery, the plaintiff could not obtain a patent for it, so as to exclude the defendant from using it, if he chose to do so.

4. The last objection is, that the use of the Stouffer machine cannot affect the plaintiff's patent, unless it was public. Whether that hopper-boy was in public use or not, the jury will judge from the evidence. It was erected and used in

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four or five mills, if the defendant's witnesses are believed. But this argument has no foundation in the Act of Congress, which does not speak of public use. It is material whether the patentee had notice of the prior invention or not. If it was in actual use in any part of the world, however unlikely or impossible that the fact could come to the knowledge of the patentee, his patent for the same machine cannot be supported.

[* 468] * A verdict was rendered for the defendant, and exceptions being taken to the above charge, the cause was brought by a writ of error before this Court.

Mr. Justice STORY delivered the opinion of the Court.

This case is an action for an infringement of the same patent as in *Evans v. Eaton* ;¹ and many of the remarks in that case are applicable to this ; and therefore the opinion now delivered will refer to such points only as are not completely disposed of by the opinion already delivered. The evidence in this case does not establish that the defendant used the plaintiff's improved hopper-boy ; but the hopper-boy used by the defendant is asserted to be Stouffer's hopper-boy. At the new trial, a Mr. Aby was offered as a witness by the defendant, to prove the nature and character of the hopper-boy used by the defendant ; the plaintiff objected to his testimony, as incompetent, because he was sued by the plaintiff for an infringement of his patent-right, under circumstances similar to those alleged in proof against the defendant. The Court overruled the objection ; and the witness was then sworn on the *voir dire*, as to his interest in the suit ; but upon a full examination, it did not appear that he was really interested ;

¹ *Ante*, p. 336.

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and the Court therefore permitted him to be sworn in chief. The plaintiff took an exception to this decision of the Court. The objection to the competency of Aby, so far as he has an interest from being sued, cannot * be dis- [* 469] tinguished, in principle, from that already overruled in the case of Evans v. Eaton. There is this additional circumstance in this case, that Aby was not called as a general witness, but to establish a single fact, namely, the nature of the hopper-boy used by the defendant. The other objection upon his answers on the *voir dire*, is disposed of by the single remark, that he purged himself of any real interest in the event of the suit. A question was asked of this witness, on his examination in chief, whether the hopper-boy in the defendant's mill was like the model exhibited in Court of the plaintiff's patented hopper-boy; the plaintiff objected to the question, because such testimony could not be given in this case, for want of notice thereof. But the objection was overruled by the Court; and, in our judgment, with perfect correctness. No notice was necessary to authorize the inquiry; and if the plaintiff meant to rely on the notice required by the sixth section of the Patent Act, in certain cases, it is only necessary to say, that this was not within the provision of that class of cases. The question was perfectly proper under the general issue. Similar objections were taken to other witnesses; but it is unnecessary to remark on them.

An inquiry was proposed by the plaintiff, to one of the witnesses, whether one Peter Stouffer had paid the plaintiff for a license for his mill; but the Court refused to allow the question to be asked; and we see no reason why it should have been allowed, for it merely referred to an act among strangers, which ought not to prejudice the defendant. A * similar question was proposed to be asked [* 470] of the same witness, whether the executors of Jacob

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Stouffer had paid the plaintiff for a license for the mill of Jacob; the Court overruled the question; and for the same reason, it was rightly overruled.

The deposition of one John Shetter was read in evidence by the defendant, without opposition, and afterwards the plaintiff moved to have the same rejected, because not taken according to the rules of the Court; but the Court refused to reject it; and in our judgment rightly, because it having been once introduced with the acquiescence and consent of the plaintiff, he could not afterwards avail himself of the objection.

The plaintiff then proposed to ask a question of a witness, whether Daniel Stouffer was subject to fits of derangement, and whether the witness had said so; but the Court overruled the question. It does not appear distinctly in the record, that Daniel Stouffer was a witness in the cause; but if he was so, the question was properly overruled, because a person being subject to fits of derangement, is no objection either to his competency or credibility, if he is sane at the time of giving his testimony.

The next objection of the plaintiff's counsel, is to the charge of the Court, in summing up the cause to the jury; but the points on which that charge materially depends, have been so fully discussed in the opinion just delivered in *Evans v. Eaton*, that it is unnecessary to examine them at large.

Upon the whole, it is the opinion of the majority of the Court, that the judgment ought to be affirmed with costs.

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LANGDON v. DE GROOT ET AL.

[1 Paine, 203.]

An invention or improvement for which a patent has been obtained, must be useful within the meaning of the Patent Law, or the patent is void.

Whether the usefulness of an invention be matter of fact to be left to the jury, or whether the Court are to decide it as matter of law? *Quære.*

But, *it seems*, that if on the plaintiff's own showing, the invention appears to be useless, and an imposition on the public, the Court should so direct the jury.

An invention of an ornamental mode of putting-up thread, which gave it no additional value, but merely made it sell more readily at retail, and for a larger price, was held not useful, within the meaning of the Patent Law.

Specification held bad for uncertainty.

THIS was a motion to set aside the verdict in this cause for misdirection of the Court.

The declaration was for a breach of a patent-right. •

It appeared at the trial, that the plaintiff had obtained letters-patent from the President of the United States, for "an improvement in preparing and packing cotton and other threads, and floss cotton for retailing." The specification was as * follows: — "This improvement [* 204] consists in folding the thread and floss cotton into skeins or hanks of a convenient quantity for retailing, with a sealed wrapper round the same, and a label containing the number and description of the article."

The Court charged the jury, that this invention was not a useful one within the meaning of the Patent Law, and that the plaintiff was not, of course, entitled to recover any damages for a breach of the patent he had obtained for it.

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R. Sedgwick for the plaintiff.

W. Slosson for the defendants.

LIVINGSTON, J. On the trial of this cause the jury gave a verdict for the defendants. A motion is now made to set aside, for misdirection of the Court, in telling the jury that the plaintiff's invention was not a useful one, within the meaning of the Patent Law. This opinion is not only considered erroneous, but it is said, that the question of utility should have been left to the jury.

The opinion of the Court, on the point of utility, has undergone no change. To what extent an invention must be useful, to render it the subject of a patent, will depend on the particular circumstances of each case, and for which no general rule can be given; but all will agree, that it must in some small measure at least be beneficial to the community; and when it becomes a matter of inquiry whether its benefits are of sufficient consequence to be protected by the arm of government, it may be proper to leave such question with the jury.

But when the objection raised is, that the invention, on the plaintiff's own showing, is not only of no use, but an imposition on the public, it may be doubted whether a Court transcends its prescribed limits, in taking upon itself, as was done here, a decision of it. If a patent were obtained, [* 205] for a new * discovery in the composition of drugs, and it should appear, by the plaintiff's own testimony, that of twenty patients, to whom the medicine had been administered, not one had survived, would a Court hesitate in telling a jury that the plaintiff had no right to recover? and if they disregarded such direction, would it find any difficulty in awarding a new trial? Now, although the present invention endangered neither the health nor the lives of others,

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it was quite palpable, and that without the examination of any witnesses by the defendants, that it was only a mean of obtaining a much larger sum for an article of very extensive use, than it could be purchased for at any other stores in the city.

The invention is for folding the thread and floss cotton in a manner a little different from the ordinary mode, in which form the cotton will sell quicker, and higher by 25 per cent. than the same cotton put up in the common way. The cotton thus folded is imported from the factory of Holt, in England. The article itself undergoes no change; and the whole of the improvement — for it is a patent for an improvement — consists in putting up skeins of it, perhaps of the same size in which they are imported, decorated with a label and wrapper; thus rendering their appearance somewhat more attractive, and inducing the unwary, not only to give it a preference to other cotton of the same fabric, quality, and texture, but to pay an extravagant premium for it. When stripped of these appendages, which must be done before it is used, the cotton is no better in any one respect than that of Holt's retailed in the way put up by him. All this came out on the plaintiff's own testimony.

Now, that such a contrivance — for with what propriety can it be termed an useful art within the meaning of the constitution? — may be beneficial to a patentee, if he can exclude from the market all other retailers of the very same article, will not * be denied; and if to protect the inte- [* 206] rest of a patentee, however frivolous, useless, or deceptive his invention may be, were the sole object of the law, it must be admitted that the plaintiff has made out a satisfactory title to his patent.

But if the utility of an invention is also to be tested by the advantages which the public are to derive from it, it is not perceived how this part of his title is in any way whatever

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established. Is the cotton manufactured by himself which is put up in this way? The very label declares it to be that of another man. Is any thing done to alter its texture, or to render it better or more portable, or more convenient for use? Nothing of this kind is pretended. Does the consumer get it for less than in its imported condition? The only ground on which the expectation of a recovery is built is, that he pays an enormous additional price, for which he literally receives no consideration.

It was said that many ornamental things are bought, of no intrinsic value, to gratify the whim, taste, or extravagance of a purchaser, and that for many of these articles patents are obtained. This may be so. But in such cases there is no deception, no false appearances; and the article is bought to be used with all its decorations and ornaments, which may have been the principal inducement to the purchase, and which will last as long as the article itself. In this the sight or pride of the party is gratified. But here it is the cotton alone which it is intended to buy, and the little label and wrapper appended to it, and which constitute the whole of the improvement, however showy, are stripped off and thrown away before it can be used. And when that is done, which may be at the very moment of its purchase, the cotton is no better, whatever the buyer at the time may think, than when it first left the factory.

When Congress shall pass a law, if they have the [* 207] right so * to do, to encourage discoveries by which an article, without any amelioration of it, may be put off for a great deal more than it is worth, and is actually selling for, it will be time enough for Courts to extend their protection to such inventions — among which this may be very fairly classed.

But a complaint is made that this question should have been submitted to the jury. It may be that the Court expressed

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itself in terms too strong, and should have let the jury pass on this point on the evidence before them; and were this the only difficulty in the cause, I should not object to giving the plaintiffs an opportunity of obtaining such an opinion, by awarding a new trial; being never very desirous of treating mere questions of fact, if this be of that description, as questions of law.

But an objection is made to the specification, which, in the judgment of the Court, is conclusive.

It is said, and with truth, that it does not appear with sufficient precision, in what respects the method of putting up cotton in the plaintiff's way differs from that followed by Holt. It is certain that in two of the particulars in which the improvement is alleged to consist, Holt had anticipated him; that is, in folding the cotton into skeins of a convenient quantity for retailing, and in putting a label on them.

The only remaining direction in the specification is, that these skeins must be furnished with a sealed wrapper. Now, admitting this wrapper to be of the plaintiff's invention, and an improvement on Holt's mode of preparing his cotton for retailing, yet as he has not distinguished between the methods already in use and his own, but has taken a patent for all of them, it is void, in conformity with the decision in Evans and Eaton.

If the patent in its present form be good, he may sue any one who retails cotton put up in the form previously practised * by Holt; nor would so trifling a deviation from the specification, as the omission of a wrapper, furnish any defence to such an action, any more than changing the form or proportions of a machine would be regarded a discovery.

The rule to show cause why there should not be a new trial is discharged, and judgment must be entered on the verdict.

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Ex parte WOOD & BRUNDAGE.

[9 Wheat. 603.]

Under the 10th section of the Patent Act of the 21st of February, 1793, ch. 11, upon granting a rule, by the judge of the District Court, upon the patentee, to show cause why process should not issue to repeal the patent, the patent is not repealed, *de facto*, by making the rule absolute; but the process to be awarded is in the nature of a *scire facias* at common law, to the patentee to show cause why the patent should not be repealed, with costs of suit; and upon the return of such process, duly served, the judge is to proceed to stay the cause, upon the pleadings filed by the parties, and the issue joined thereon. If the issue be an issue of fact, the trial thereof is to be by a jury; if an issue of law, by the Court, as in other cases.

In such a case, a record is to be made of the proceedings, antecedent to the rule to show cause why process should not issue to repeal the patent, and upon which the rule is founded

THIS cause was argued by *Mr. Haines*,¹ in support of the rule, and by *Mr. Emmett*,² against it.

Mr. Justice STORY delivered the opinion of the Court.

The District Judge of the southern district of New York, under the 10th section of the Patent Act, of the 21st of February, 1793, chapter 11, granted a rule upon [* 604] Charles Wood and Gilbert * Brundage, at the instance and complaint of Jethro Wood, to show cause why process should not issue against them, to repeal a patent granted to them for a certain invention, in due form

¹ He cited *Stearns v. Barrett*, 1 Mason's Rep. 153, *ante* 97; 8 Mod. 28; 1 Salk. 144.

² He cited 1 U. S. Law Journal, 88; *Ex parte* O'Rielly, 1 Ves. jun. 112; *Ex parte* Fox, 1 Ves. & Beames, 67; *Jefferson's Case*, 2 Saund. 15.

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of law ; and upon hearing the parties, no sufficient cause being, in his judgment, shown to the contrary, he, on the 2d day of July, 1823, passed an order, that the said rule be made absolute, and that the said patent be repealed ; and that process issue to repeal the said patent, and for the costs of the complainant. The patentees, by their counsel, moved the Court to direct a record to be made of the whole proceedings, and that process, in the nature of a *scire facias*, should be issued, to try the validity of the patent. The Court denied the motion, upon the ground that these were summary proceedings, and that the patent was repealed *de facto*, by making the rule absolute ; and that the process to be issued, was not in the nature of a *scire facias*, to try the validity of the patent, but merely process repealing the patent.

A motion was made, on a former day of this term, in behalf of the patentees, for a rule upon the district judge, to show cause why a mandamus should not issue from this Court, directing him to make a record of the proceedings in the cause, and to issue a *scire facias*, for the purpose of trying the validity of the patent. The rule having been granted, and due service had, the case has since been argued by counsel, for and against the rule ; and the opinion of this Court is now to be delivered.

Two objections have been urged at the bar, * against the making this rule absolute. The first [* 605] is, that these proceedings, being summary, are not properly matters of record. The second, that this is not a case in which, by law, a *scire facias*, or process in the nature of a *scire facias*, can be awarded, to try the validity of the patent.

Both of these objections are founded upon the provisions of the 10th section of the Patent Act, and must be decided by a careful examination of those provisions. The words

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are, "that upon oath or affirmation being made, before the judge of the District Court, where the patentee, his executors, &c., reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or upon false suggestion, and motion made to the said Court within three years after issuing the said patent, but not afterwards, it shall and may be lawful for the judge of the said District Court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee, or his executor, &c., show cause why process should not issue against him, to repeal such patent; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute; and thereupon, the judge shall order process to be issued against such patentee, or his executors, &c., *with costs of suit*. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such Court for the repeal of the said patent. And if the party at whose complaint the process issued, shall have judgment given against [* 606] him, he shall pay all * such costs as the defendant shall be put to in defending the suit, to be taxed by the Court, and recovered in due course of law."

Upon the slightest inspection of this section, it will be at once perceived, that however summary the proceedings may be, they are of vast importance to the parties, and involve the whole right and interest of the patentee. The jurisdiction given to the Court, is not general and unlimited, but is confined to cases where the patent was obtained surreptitiously, or upon false suggestions; where the patentee resides within the district; and where the application is made within three years after the issuing of the patent. It is, therefore, certainly necessary, that all these facts, which are indispensable to found the jurisdiction, should be stated in the motion and

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accompanying affidavits ; and without them, the Court cannot be justified in awarding the rule. It follows, of course, that in any record that is to be made of the proceedings, they constitute the preliminary part, and ought not be omitted. In the present case, they have been wholly omitted, and the record is, in this respect, incomplete and inaccurate.

But it is said that, technically speaking, these proceedings are not matters of record. They are certainly proceedings of a Court of record, for such are all the Courts of the United States, in virtue of their organization, both upon principles of the common law, and the express intendment of Congress. In general, the interlocutory proceedings in suits are not entered of record, as they are deemed merely collateral incidents. But where *a special jurisdiction [* 607] is given to a Court, as in the present instance, it appears to us that, in conformity to the course of decisions in this Court, upon the subject of jurisdiction, all the preliminary proceedings required to found that jurisdiction should appear of record, as they constitute an essential part of the case. In general, motions and rules made in the course of suits, over which the Court has an acknowledged jurisdiction, are not entered of record. But where a rule is the sole foundation of the suit, and the first step in its progress, that rule can only be granted under special circumstances prescribed by law ; it is not sufficient to show that the rule itself was granted, but it must also appear, by the proceedings, that it was rightfully granted.

But the more material question is, whether the proceedings, so far as the rights of the patentees are concerned, terminated with the rule being made absolute, so that, *ipso facto*, the patent was repealed, and the process to be issued was only process to enforce or declare the repeal ; or whether the process was in the nature of a *scire facias* at common law, to

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repeal the patent, if upon a future trial, the same should be found invalid.

This question must be decided by the terms of the section in controversy ; but in the interpretation of those terms, if their meaning is somewhat equivocal, that construction ought certainly to be adopted, which, not departing from the sense, is most congenial to our institutions, and is most convenient in the administration of public justice. The securing [* 608] ing *to inventors of an exclusive right to their inventions, was deemed of so much importance, as a means of promoting the progress of science and the useful arts, that the constitution has expressly delegated to Congress the power to secure such rights to them for a limited period. The inventor has, during this period, a property in his inventions ; a property which is often of very great value, and of which the law intended to give him the absolute enjoyment and possession. In suits at common law, where the value in controversy exceeds twenty dollars, the constitution has secured to the citizens a trial by jury. In causes of equity and admiralty jurisdiction, they have the security of a regular and settled course of proceedings, where the rules of evidence and the principles of decision are well established. And in all these cases, there is the farther benefit conferred by our laws, of revising the judgments of the inferior Courts, by the exercise of appellate jurisdiction. It is not lightly to be presumed, therefore, that Congress, in a class of cases placed peculiarly within its patronage and protection, involving some of the dearest and most valuable rights which society acknowledges, and the constitution itself means to favor, would institute a new and summary process, which should finally adjudge upon those rights, without a trial by jury, without a right of appeal, and without any of those guards with which, in equity suits, it has fenced round the general administration of justice. The Patent Acts have given to the patentee a

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right to sue at common law, for damages for any violation of his *invention ; and have given him a [* 609] farther right to claim the interference of a Court of equity, by way of injunction, to protect the enjoyment of his patent. It would be somewhat surprising if, after such anxious legislation, there should exist in the act a clause which, in a summary manner, enables any person to repeal his patent, and thus sweep away his exclusive property, without interposing any guards by way of appeal, or any regular proceedings, by which the validity of titles, in ordinary cases, is examined and contested.

With these considerations in view, let the 10th section of the act be examined. Its object is to provide some means to repeal patents which have been obtained surreptitiously, or upon false suggestions ; the very cases for which a *scire facias* issues at the common law. As the patents are not enrolled in the records of any Court, but among the rolls of the Department of State, it was necessary to give some directions as to the correct time and manner of instituting proceedings to repeal them. It accordingly directs, that the District Judge may, upon proper evidence, under oath, and motion made to the Court, in his discretion, "grant a rule that the patentee, &c., show cause why process should not issue against him, to repeal such patent ; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the judge shall order process to be issued against such patentee, &c., with costs of suit." It is obvious, from the language of this clause, that the rule is a rule not to repeal the patent, if it is made absolute, but a * rule [* 610] for process to issue to repeal the patent. It is not then the rule, but the process contemplated by the act, that repeals the patent. It is not a mere form, but it is of the essence of the proceedings, without which, the rule has no efficacy. Is the process to be issued a process which, *per se*,

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repeals the patent, or are the words "to repeal such patent," to be construed as merely descriptive of the nature of the process, and of the effect of it, if judgment shall be finally pronounced in support of it? In other words, is it a process in the nature of an execution, or a judicial process in the nature of a *scire facias*, calling for further proceedings? If the words of the section had stopped at the clause already referred to, it would, perhaps, have been difficult to find a sufficient explanation of the legislative will, to have led the Court to the conclusion, that judicial process, in the nature of a *scire facias*, was certainly intended, there would have been some reason for hesitation; but, even then, an interpretation against such process would not have been without serious embarrassments. It could not be arrived at, without leaving much of questionable reasoning behind. But the section does not stop here. It goes on to make further provisions, which, if the process absolutely repealed the patent, could have no operation, and no intelligible meaning. On the other hand, if the process was to be in the nature of a *scire facias*, all the words are sensible and operative, and describe the proper progress and proceedings upon such a writ. The clause is in

[* 611] these words: "And, in case no *sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such Court for the repeal of the patent." These words follow after the clause awarding the process, and, of course, suppose the process already issued. The party is supposed to be called upon to show cause, which is precisely what a *scire facias* requires in its official mandate; and if no sufficient cause is shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, then the patent is to be repealed. If the process is merely to repeal the patent, and not to institute a trial, how can the party show cause? how can it judicially appear

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that the patentee is not the inventor? These provisions are intelligible in a *scire facias*, for that authorizes subsequent inquiry into the law and the facts. But, farther, "judgment" is to be rendered. Now, it is not necessary to lay any particular stress on this word, as a known juridical phrase, expressive of the final decision of the Court; but if the making the rule absolute repealed the patent, and the process is merely an execution, how could any subsequent judgment be rendered in the case? It would be contrary to all analogy, to all rules of judicial interpretation, to suppose that judgment is to succeed, and not to precede, the writ of execution. The clause goes on, "and if the party, at whose complaint the process issued, shall have judgment against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed *by the Court, and recovered [* 612] in due course of law." The language is here still more distinct and persuasive. It imports, in a clear manner, that some proceedings were to be had after the process issued, by which the case might be farther investigated; and if upon such investigation judgment should be against the complainant, the patentee should recover his costs. The language is, that the party, at whose complaint the *process issued*, not the rule issued, shall have judgment against him. Upon what? the rule? Certainly not; but upon the *process issued*. He shall pay the costs to which the defendant is put in defending the suit. What suit is here intended? We think it is clear that it means the suit upon the process, that is, upon the *scire facias*; for the proceedings upon the rule are not, in a technical, or in any accurate sense, a suit. The costs of *defending* the suit are to be paid. But how can any costs arise from a defence upon a process which is final and absolute? It appears to the Court, that to give the construction contended for by the counsel against the rule, would be to reject the plain and obvious purport of the whole of the last

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clauses of the section, and make them a perfect nullity. In the other view, they have the entire effect, and are as reasonable and just, in themselves, as they are promotive of the security of vested rights and property.

Nor does the occurrence of the words "costs of suit," in the preceding part of the section, where it is said that "the process shall be issued, &c., with costs of suit," in [* 613] the slightest degree impugn * this interpretation.

The true meaning of these words in this connection, is not that costs of suit, already incurred, shall be paid and collected, but that the process shall be, to show cause why the patent shall not be repealed, and costs of suit given to the complainant. In this view, it fortifies the construction already asserted by the Court. That this is the true exposition of the words, is made apparent by examining the 5th section of the Patent Act of 1790, ch. 34, which is exactly similar in terms to the 10th section of the present act, except that it omits, in this place, the words "costs of suit." These words, therefore, were not intended to change, and cannot be admitted to change, the natural meaning of other parts of the section. And if the other words used in this connection are descriptive of the nature of the process, these words are merely explanatory of the legislative intent, that the costs of the suit should follow upon the final judgment in favor of the complainant. Without this provision, as the other clause, giving costs, applies to the patentee only, the complainant, although he should prevail in the suit, would not be entitled to any costs. This was a real defect in the first act, and is cured by the insertion of the words under consideration.

Nor are there any public mischiefs which will result from the view which the Court takes of this section. On the contrary, it will subserve the purposes of general justice. If a patent has been fraudulently obtained, or upon false suggestions, it may be repealed within three years, if a jury

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*upon a trial, shall be satisfied of the fact. If [*614] such a repeal be not had, still the public have a perfect security. They may violate the patent with impunity, and if sued for the violation, any person may show the same facts in his defence, and they will constitute a complete bar to the suit, by the express provisions of the 6th section of the Patent-Act. Here, also, the trial will be ordinarily by a jury, and if the verdict is found, upon such facts, in favor of the defendant, the law expressly declares that "judgment shall be rendered for the defendant, with costs, and the patent shall be declared void." Many patents, under this section, have already, in such suits, been adjudged void; so that the danger of extensive imposition or injury is wholly chimerical. On the other hand, if, by any accident or mistake, the patentee should neglect to appear to oppose the rule, upon the argument on the other side, he may be remediless. But, upon the exposition of the statute adopted by the Court, he will still be entitled to appear to the *scire facias*, and have a more deliberate opportunity to defend his right.

Upon the whole, it is the opinion of the Court, that the rule ought to be made absolute, and that a peremptory mandamus issue to the Judge of the District Court, directing him to enter upon record the proceedings in this cause, antecedent to the granting of the rule, and upon which it was founded; that he awarded a process, in the nature of a *scire facias*, to the patentees, to show cause why the patent should not be repealed, with costs of suit; that upon such process being returned, *duly executed, he proceed [*615] to try the same cause, upon the pleadings filed by the parties, and the issue joined thereon; and that, if the issue so joined be an issue of fact, then the trial thereof to be by a jury; if an issue of law, then by the Court, as in other cases.

Mandamus accordingly.

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JUDGMENT. Upon the hearing of this cause upon the rule to show cause, heretofore awarded by this Court, and on consideration of the arguments of counsel for and against making the same rule absolute, it is ORDERED and ADJUDGED by the Court, that the same rule be, and hereby is, made absolute. And it is further ORDERED by the Court, that a peremptory mandamus issue to the District Judge of the Southern District of New York, commanding him to enter upon record the proceedings in this cause, antecedent to the granting by him of the rule to show cause why process should not issue to repeal the patent in the proceedings mentioned, and upon which the said rule was founded; that the said judge do award a process, in the nature of a *scire facias*, to the patentees, to show cause why the said patent should not be repealed, with costs of suit; that upon the return of such process, as duly served, the said judge do proceed to try the cause upon the pleadings filed by the parties, and the issue joined thereon; and that if the issue be an issue of fact, the trial thereof be by a jury; if an issue of law, then by the Court, as in other cases.

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[1 Paine, 348. April T. 1824.]

The first section of the Patent Law of 1793, construed in connection with the other sections of the act, means that the invention should not be known or used as the invention of any other person than the patentee before the application for a patent.

If the invention have got into use while the inventor was practising upon it with a view to improve it before applying for a patent, such use does not invalidate the patent; and the motive for the delay is a question for the jury.

One who has patented his invention cannot take out a new patent for the same invention, until the first is surrendered, repealed, or declared void.

The obstacle of an invalid patent may be removed by having it declared void after a verdict against it, or by having a *vacatur* entered *ex parte* in the Department of State on a surrender of the patent. But the provisions of the

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6th section of the act, do not enable a patentee to declare his own patent void, and a verdict in a suit on the second patent in favor of such patent, does not avoid the first patent.

It seems that on surrendering a patent and taking out a new one, the latter should be for only the unexpired part of the fourteen years since obtaining the first patent.

Whether a new patent can be taken out where a patent has been declared void under the 6th section of the act? *Quære.*

THIS was an action on the case, brought by the plaintiff against the defendant, for infringements by him of a patent issued to the plaintiff in May, 1822, for an improvement in the stopcock.

The specification of the patent contained a clear description of the instrument, so that artists could make it from such description, and at its close, the improvements claimed under the patent were particularized.

Evidence was given by the plaintiff showing the time of the invention to be September, 1815; that the plaintiff was the inventor; that the invention was useful; and that the defendant had made and sold instruments which were infringements of the patent.

On a cross-examination of the plaintiff's witnesses, it appeared * that the plaintiff had taken out a patent in 1816, for an improved block-tin stopcock, the specification of which was proved by the witness to describe the same instrument as the one described in the specification of the patent of 1822, with this difference, that in the former the particular improvements claimed were not stated. It appeared in evidence on the part of the plaintiff, that certain parts of the instrument, described generally as part of the instrument in both patents, but not claimed in the patent of 1822, as improvements of the patentee, had been in use prior to the patent of 1815.

Upon this evidence,

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C. D. COLDEN, G. GRIFFEN, and G. W. STRONG for the defendant, moved for a nonsuit,¹ on two grounds.

1. That it appeared that the instrument had gone into use before the date of the patent of 1822, and

2. That the patentee had a prior patent for the same thing, which had not been repealed, surrendered, nor declared void.

Under the first point it was contended — That by the words of the first section of the Patent Act, the invention must not have been used before the application for a patent: That the other sections of the Patent Law, the phraseology of which was indefinite, should be construed in subordination to the first section: That this construction was fortified by the words of the first section of the law of 1800, extending the Patent Act to aliens. That the instrument having gone into use or knowledge of the public, the inventor had no secret to disclose as a consideration for the grant by the [* 350] * public. That in England the law was unquestionably settled to this effect — and that the English decisions should be adopted here, inasmuch as they were founded in the nature of the subject, and as our Courts had adopted English decisions on English statutes as applicable to the construction of statutes in this country, where there was much more difference in the phraseology, than existed between our Patent Law and the English statute. That the point in question had never been decided in this country under our present patent, before the decision of Judge Van Ness, which was in point in their favor. That very injurious consequences would result if inventors might lie by, and after the public had got into the use of a thing, claim it by a patent.

¹ Opinion of Van Ness, J., 4 No. U. S. Law Journal; Whittemore v. Cutter, Gall. R. 482, *ante*, 43; Odiorne v. Amesbury Nail Factory, 2 Mas. R. 28, *ante*, 300; Moody v. Fisk, 2 Mas. R. 115, *ante*, 315; Collin on Patents, 70 or 170; Godson on do. 200; Fessenden on do. 50, 173.

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On the second point it was contended, that the patent of 1815, was an estoppel to the plaintiff to take out another patent for the same thing, before the repeal or surrender of such prior patent. That the prior patent was not on its face void, but was voidable only, and that not by the plaintiff himself, but only by third persons. That to allow the plaintiff to allege his first patent to be void, would be embarrassing the Court with the trial of two issues, in which it would be inconsistently thrown on the defendant to prove that the first patent was good and the second bad. That at any rate the plaintiff should have surrendered the first patent before taking out the second — the course in England being so. He should also in such case have taken out the second patent, not for fourteen years from its date, but for the residue of the time, computing from the date of the first patent. That on the plaintiff's grounds, patentees would, by taking out patents, insidiously defective, secure to themselves a perpetuity. That the acts in favor of Oliver Evans were a legislative decision on the subject; and that the case of *Odiorne v. Amesbury Nail factory*,¹ was in point and decisive.

* *T. A. Emmet, S. P. Staples, and D. Lord*, for [* 351] the plaintiff,—

In reply,² contended on the first objection, that the 6th, 7th, and other sections of the act showed that reference was to be had to the time of invention in considering the question of prior use. That the general phraseology of the act was inconsistent with a literal construction of the first

¹ 2 Mas. Rep. 28, *ante*, 300.

² *Barrett v. Hall*, 1 Mas. R. 474, *ante*, 235; *Goodyear v. Mathews*, *ante*, 50; *Woodcock v. Parker*, 1 Gall. R. 438, *ante*, 37; *Davies on Pat.* 448; *Evans v. Weiss*, 3 Am. Law Journal, 180, same case, *ante*, 10.

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section. That a literal construction of that section was *felo de se*, and it must therefore be construed in subordination to the rest of the act. That the policy of the Patent Act, in England, and its words, differed from our law. That in England it went on the ground of a bounty from the crown; in this country on the ground of protecting the common-law right of the inventor to his invention. That the point in question had been directly decided in *Evans v. Weiss*,¹ and in the case of *Goodyear v. Mathews*.²

On the second point — that the doctrine of estoppel did not apply; the grant was void, so as to prevent any right from vesting. That the prior patent, on the state of the evidence, was void, not voidable; voidable implies that the thing is capable of confirmation, which the first patent is not. That a surrender of the first patent could not be made, there being no provision in the law to authorize it; as is the case in England, by the inherent power of the Chancellor. That as the patentee had enjoyed no legal protection under the first patent, it should not be computed against him as part of the fourteen years; at any rate that the question of an extra extension of time could not properly arise until the lapse of fourteen years from the date of the first patent.

[* 352] * THOMPSON, J., charged the jury as follows:

The questions presented by the facts in this cause are of great importance, and not unattended with difficulty, and deserve a more deliberate consideration than can be given them in the course of a trial.

The first question is, whether the fact that the invention was introduced into use by the patentee himself, as his inven-

¹ 3 Am. Law Journal, same case, *ante*, 10.

² *Ante*, 50.

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tion, prior to the application for the patent, rendered the patent invalid.

It appears to be settled law in England, that if an invention had been introduced into use by the patentee himself, and known and used by others before the date of the patent, such disclosure and use will destroy the patent. There is, however, a difference between the English law and the Acts of Congress on this subject. In the English statute it is stated precisely from what period the fourteen years are to commence; they are to run from the date of the patent. But there is no such phraseology in the Act of Congress. The English statute speaks of the invention to be patented, being such as others, before the date of the patent, shall not use; and consequently if a patentee in England have so disclosed his invention as that it be put in use before the date of the patent, he is not entitled to the patent. Our act does not contain these provisions.

There is some incongruity in the phraseology of our Patent Law of 1793, and it is inartificially drawn in several parts. A correct interpretation of it requires that the general scope and object of the law and all its clauses should be taken into view together. Were no other part of the act than the first section to be read, it would seem to preclude a patent for any invention used before the application for a patent. But taking a general view of the clauses of the act, and of its object, it seems to me that this section must be controlled by the other parts of the act. As it respects the patentee, the great object of the law is to secure to inventors the benefit of their *invention for fourteen years. The [*353] third section, prescribing the oath to be taken, only speaks of the applicant's being the true inventor. It says nothing about the invention's not having been in use before the application. So also the sixth section, which specifies the causes for which a patent may be declared void, shows the

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great object of the inquiry to be whether there has been a prior use of the improvement. Prior to what? Prior to the invention of the patentee. The same remarks are applicable to the 10th section, and indeed such seems the fair import of all the sections of the Act of 1793, but the first. I therefore think that the first section should be construed in connection with the other parts of the act, to mean that the improvement or discovery should be unknown and not used as the invention of any other than the patentee, before the application for a patent.

The objection drawn by the defendant's counsel from the first section of the Act of 1800, placing aliens on the same grounds, in certain respects, as citizens, is not a substantial one. This section first proceeds to extend the benefits of the Patent Law to aliens, equally as they are enjoyed by citizens, and under the same limitations. Aliens must take the same oath as to being the inventors, &c. Then comes the proviso requiring them to swear that the invention has not been known or used in this or any foreign country. This proviso is a limitation on the enacting clause according to the general rule of construction, and is to be construed as limiting and restraining the grant to which it is applied. It puts the alien on grounds somewhat different from those of a citizen, requiring an oath of something more than is required of a citizen; and this view strengthens the construction given above to the first section of the Act of 1793. Then the close of the proviso goes on to state, that if it shall appear that the thing patented was known or used previous to the application for a patent, the patent shall be void. It seems reasonable [* 354] able to * restrict an alien in this manner from taking out a patent, for what has been in use abroad, inasmuch as our own citizens cannot patent a foreign invention.

Evils may undoubtedly exist under this construction of the law. Expensive machines may be made before a patent is

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taken out ; and persons who have in this way innocently incurred expenses, may be stopped short in their undertakings. But I am inclined to think that under such circumstances, a patent should not be permitted to operate to the prejudice of persons thus situated, on the principle that innocent third persons are not to be injured by relation back, so as to deprive them of a right lawfully acquired. And if a person knowing of an invention proceeds to put it in use, the inventor not having secured his right by patent, the latter ought not be permitted to take away that which was previously lawfully made. No man is to be permitted to lie by for years, and then take out a patent. If he has been practising his invention with a view of improving it, and thereby rendering it a greater benefit to the public before taking out a patent, that ought not to prejudice him. But it should always be a question submitted to the jury, what was the intent of the delay of the patent, and whether the allowing the invention to be used without a patent, should not be considered an abandonment or present of it to the public.

The next question is, whether it is not a valid objection to the second patent that the patentee has a prior patent for the same thing not surrendered, repealed, or declared void.

I think this objection insurmountable. A prior patent must be got rid of before a second can be taken out. Why should a second patent be taken out before a prior one is avoided, although invalid, if the patentee is enjoying the full benefit of it? It is objected, that the patentee is in difficulty as to getting the first patent out of the way. But if the patentee should sue on the first patent, and the defendant * should succeed in the suit, the patent [* 355] could be declared void ; and if the patentee had a right to the thing patented, the objection of a prior patent would be removed.

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Besides, I see no insuperable objection to entering a *vacatur* of the patent of record in the Department of State, if taken out inadvertently and by mistake. All the proceedings in that department on the subject of patents are *ex parte*, except in the case of interfering applications. The department acts rather ministerially than judicially, and upon the representation of the applicant, without entering into an examination of the question of right ; and there seems to be no good reason why, on a like *ex parte* application, the patent may not be surrendered and cancelled of record, if no misconduct be imputable to the patentee in taking it out. And in such case as the exclusive right is not to exceed fourteen years, the second patent may be limited according to circumstances, and thereby secure both to the patentee and the public their respective rights. The only record evidence of the patent is that in the Department of State, and in the letters-patent in the hands of the patentee ; and if the letters-patent were surrendered and cancelled of record, the invention would be open to public use without hazard, so far as depends on such patent. And if the patentee does not choose to do this, he must have the patent made void in some other way by adversary proceedings.

The provisions of the 6th section of the Act of 1793, do not apply here so as to enable the plaintiff to treat his patent as void. The proceedings under this section are the acts of the defendant only, and the plaintiff from this section has no right to set up a defect in his own patent. This Court cannot enter a *vacatur* on the first patent, and that patent is not void on the face of it.

The plaintiff's difficulty here is, that the prior patent is too broad. This is good ground for the defendant to [*356] take according *to the decision of the Supreme Court of the United States. For the patentee must take his patent for the improvement only. But I do not

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see how the verdict of the jury in this suit on the second patent, can avoid the first; that must be a subject of litigation and proof in every case which is tried under the second patent.

It is objectionable on general principles to allow a patentee in a Court of Law, to show his own patent void. It being issued on his own representation and according to his own specification, as to the extent of the right claimed, he is estopped by his own act. He certainly is not to be permitted to allege, that he obtained his patent fraudulently, or that there was any concealment or addition with respect to his specification with a view to deceive the public, or to set up his own misconduct in any other respect. And should he allege, that he had innocently and in ignorance of the law, procured a patent broader than his invention, he is not without the answer, that he is chargeable with a knowledge of the law, and cannot set up his ignorance of it to avoid his own act.

Whether, after the first patent has been declared void, after verdict under the 6th section, in a case free of fraud, a new patent can be taken out, is a question which does not here arise. But I am inclined to think that a surrender of the prior patent might be made, and that the Secretary of State might grant a new one, under a statement of the circumstances, although not for the period of fourteen years from the date of the second patent, as the patentee has enjoyed the exclusive right for a part of the fourteen years. This construction, as to the effect of a prior patent, seems necessary to prevent a patentee from enjoying his exclusive right for a period longer than fourteen years, and indeed for an indefinite period.

As to the argument that fourteen years from the date of the first patent have not yet expired, so that the objection * cannot be made, it appears to me untenable. [* 357] The second patent is for fourteen years, and

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that being within the time limited by the Act of Congress, it is good upon the face of it. And the objection, that the patentee has enjoyed the benefit of the invention for a part of the fourteen years under a prior patent, not being amongst any of the objections which by the Acts of Congress may be set up by third persons to avoid the patent, the objection cannot be made after the expiration of the fourteen years, and so in this case the patentee would have the benefit of his patent-right for twenty years instead of fourteen.

On the whole I am of opinion that the second objection is fatal, and that a nonsuit must be ordered.

But the counsel of the plaintiff suggesting that it had been doubted whether a writ of error returnable in the Supreme Court would lie on a judgment of nonsuit, and praying the Court to charge the jury on the points discussed, the Court accordingly directed a verdict for the defendant, with liberty to the plaintiff to move for a new trial on the points of law.

KEPLINGER v. DE YOUNG.

[10 Wheat. 358. March T. 1825.]

A having obtained a patent for a new and useful improvement, to wit, a machine for making watch-chains, brought an action, under the 3d section of the Patent Act of 1800, c. 179, [xxvi.] for a violation of his patent-right against B; and on the trial, an agreement was proved, made by the defendant with C, to purchase of him all the watch-chains, not exceeding five gross a week, which he might be able to manufacture within six months, and an agreement on the part of C to devote his whole time and attention to the manufacture of the watch-chains, and not to sell or dispose of any of them, so as to interfere with the exclusive privilege secured to the defendant of purchasing the whole quantity which it might be practicable for C to make. And it was proved that the machine used by C, with the knowledge and consent of the defendant, in the manufacture, was the same with that invented by the plain-

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tiff, and that all the watch-chains thus made by C were delivered to the defendant according to the contract:—

Held, that if the contract was real and not colorable, and if the defendant had no other connection with C than that which grew out of the contract, it did not amount to a breach of the plaintiff's patent-right.

* Such a contract, connected with evidence from which the jury might [* 359] legally infer, either that the machine which was to be employed in the manufacture of the patented article was owned wholly or in part by the defendant, or that it was hired to the defendant for six months, under color of a sale of the articles to be manufactured with it, and with intent to invade the plaintiff's patent-right, would amount to a breach of his right.

ERROR to the Circuit Court of Maryland.

This cause was argued by *Mr. Webster* and *Mr. Sergeant*, for the plaintiff, and by the *Attorney-General*, for the defendant.

Mr. Justice WASHINGTON delivered the opinion of the Court.

This was a suit commenced by the plaintiff, Keplinger, in the Fourth Circuit for the District of Maryland, against the defendant, for the violation of the plaintiff's patent-right, secured to him according to law, in a certain new and useful improvement, to wit, a machine for making watch chains, &c. The third count in the declaration, upon which alone this cause has been argued, is in the usual form, charging the defendant with having unlawfully used the said improvement, without the consent of the plaintiff first had and obtained in writing. The defendant pleaded general issue, and gave notice to the plaintiff that he should deny that the exclusive right of using the improvement mentioned in the declaration, was vested in the plaintiff, or that he was the original and first inventor of the said improvement, and that he should give evidence to establish those facts.

* At the trial, the plaintiff read in evidence the let- [* 360]

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ters-patent, duly granted, bearing date the 4th of May, 1820, and proved that he was the true and original inventor of the machine specified in the patent, and that the defendant, together with John Hatch and John C. Kirkner, did use the said machine in the making of watch-chains from steel, from the 4th of May till some time in the month of December, 1820.

The defendant, in order to prove that any concern or connection which he had with the said Hatch and Kirkner, in the making of watch-chains, by means of the said machine, was merely as a purchaser of watch-chains from them under the following contract, produced and gave the same in evidence. The agreement referred to, bearing date the 3d of May, 1820, is between M. De Young, and J. Hatch, and J. Kirkner, and witnesses, "that the said Hatch and Kirkner do hereby engage and obligate themselves to manufacture and deliver to M. De Young, or at his store in said city, not less than three gross, but as many as five gross, of wire watch-chains, agreeably to a sample to be deposited with T. Barly, (if practicable to manufacture so many,) in each week, from the date hereof, for the term of six months, one half of which number to be with turned slides, and the other half wire slides; the whole number to be four strands, if the said De Young so choose; but he is to have the privilege of directing the description to be furnished, that is to say, what number of

[* 361] four, five, six, or eight strands; the prices of * which to be as follows: four strands, two dollars per dozen; six strands, two dollars sixty-six cents and two thirds per dozen, and eight strands at the rate of three dollars thirty-three cents per dozen; said Hatch & Kirkner to devote their whole time and attention to said manufactory, and neither to sell, barter, nor dispose of, in any manner, or way, or means whatever, of any goods of the description hereinbefore described, or which may, in any manner or way whatsoever, interfere with the exclusive privilege hereinbefore granted,

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but will faithfully manufacture for said De Young, and none other, as far as five gross of chains per week, if practicable, and not less than three gross per week, at the prices hereinbefore stipulated, and payable as follows: one half in cash at the end of every week, for the total number delivered within the week, and the other half in said De Young's promissory note, payable at sixty days from the date thereof. And the said De Young, on his part, doth hereby promise to receive from the said Hatch & Kirkner, such quantity of watch-chains answering the description of the sample, as it may be in their power to manufacture, not exceeding five gross per week, reserving to himself the privilege of directing what proportion thereof shall be four, six, or eight strands, and pay for the same weekly in the following manner, namely, the one half amount of the week's delivery in cash, the other half in a note at sixty days, the same to be settled for weekly, in manner aforesaid, if required."

The defendant also gave evidence to prove * that [* 362] all the connection he ever had with the said Hatch & Kirkner, relative to watch-chains made by them with the said machine or otherwise, was merely as a purchaser of such chains from them, under and in pursuance of the said contract.

The plaintiff then proved, that, at the time of making the said contract, the defendant was fully apprised of the existence of the machine described and specified in the patent, and of its prior and original invention by the plaintiff, and of the intention of the plaintiff to obtain the said patent; and that the said contract was made with a view to the employment by the said Hatch & Kirkner, in the manufacture of watch-chains, of a machine precisely similar to that invented by the plaintiff, after the plaintiff should have obtained his patent; and that a machine precisely similar to that invented by the plaintiff was employed by the said Hatch & Kirkner

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in the manufacture of watch-chains by them under the said contract, and with the knowledge and consent of the defendant during the whole period aforesaid, he and they having received notice, on the 5th of May, 1820, of the plaintiff's patent; and that the watch-chains so manufactured by Hatch & Kirkner, during the whole of the said period, were delivered by them to the defendant, and by him received, under and in conformity with the said contract.

Upon this evidence, the Court, at the request of the defendant's counsel, instructed the jury, that the plaintiff was not entitled to a verdict on the first and second counts [* 363] in his declaration, *because the acts which they charge, if true, constitute no offence against the plaintiff's patent. And that, if the jury should be of opinion, on the evidence, that the plaintiff is the sole and original inventor of the whole machine; and that the defendant had no other connection with Hatch & Kirkner with regard to these chains, than that which arose from his said contract with them, under which he procured the chains to be made by Hatch & Kirkner, and sold them when so made; and that the said contract is a real contract; then these acts constituted no breach of the plaintiff's patent-right on the part of De Young, and that the verdict must be for the defendant; and that this legal aspect would not be changed, although the defendant may, on any occasion, have supplied, at the cost of Hatch & Kirkner, the wire from which the chains so manufactured were made.

To this instruction the plaintiff's counsel took a bill of exceptions, and a verdict and judgment having been rendered for the defendant, the cause was brought into this Court by a writ of error.

The only question which is presented by the bill of exceptions to the consideration of this Court is, whether the Court below erred in the instruction given to the jury; and this

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must depend upon the correct construction of the 3d section of the Act of Congress, of the 17th of April, 1800, c. 179, which enacts, "that where any patent shall be granted, pursuant to * the Act of the 21st February, [* 364] 1793, c. 156, and any person without the consent of the patentee, his executors, &c., first obtained in writing, shall make, devise, *use*, or sell, the thing whereof the exclusive right is secured to the said patentee, by such patent, such person so offending shall profit and pay to the said patentee, a sum equal to three times the actual damage sustained by such patentee," &c.

The contract, taken in connection with the whole of the evidence stated in the bill of exceptions, if the same were believed by the jury, formed most certainly a strong case against the defendant, sufficient to have warranted the jury in inferring, either that the machine which was to be employed in the manufacture of the watch-chains was owned in the whole or in part by the defendant, or that it was hired to the defendant for six months, under the color of a sale of the articles which might be manufactured with it, and with intent to invade the plaintiff's patent-right. Whether the contract, taken in connection with the whole of the evidence, does or does not amount to a hiring by the defendant of the machine, or the use of it for six months, is a point which is not to be considered as being decided either way by the Court. The bill of exceptions does not call for an opinion upon it.

But the contract taken by itself, amounted to no more than an agreement by the defendant to purchase, at a fixed price, all the watch-chains, not exceeding five gross a week, which Hatch * & Kirkner might be able to [* 365] manufacture in the course of six months, with any machine they might choose to employ; and an agreement on the part of Hatch & Kirkner, to devote their whole time and attention to the manufacture of the chains, and not to sell or

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dispose of any of them, so as to interfere with the exclusive privilege secured to the defendant, of purchasing the whole quantity which it might be practicable for them to make..

If this contract was real, and not colorable, which is the obvious meaning of the instruction, and the defendant had no other connection with H. & K. in regard to these chains than what grew out of it, it would, in the opinion of the Court, be an extravagant construction of the Patent-Law, to pronounce that it amounted to a breach of the plaintiff's patent-right, by fixing upon the defendant the charge of having *used* the plaintiff's machine. Such a construction would be highly inconvenient and unjust to the rest of the community, since it might subject any man who might innocently contract with a manufacturer to purchase all the articles which he might be able to make within a limited period, to the heavy penalty inflicted by the act, although he might have been ignorant of the plaintiff's patent, or that a violation of it would be the necessary consequence of the contract. It might possibly extend farther, and affect contracts express or implied, though of a more limited character, but equally innocent, as to which,

however, it is not the intention of the Court to ex-
[* 366] press *any opinion, as this case does not call for it.

This cause was argued by the plaintiff's counsel as if the opinion of the Court below had been given upon the whole of the evidence. But this was not the case. No instruction was asked for but by the defendant's counsel, and that was confined to a single part of the case, the connection between the defendant and H. & K. in regard to the watch-chains which the latter bound themselves, by their contract, to manufacture and deliver to the former. If the jury had been of opinion, upon the whole of the evidence, that the contract was not a real one, or that that instrument did not constitute the sole connection between those parties, or that the transaction was

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merely colorable, with a view to evade the law, the jury were not precluded by the instruction from considering the plaintiff's patent-right as violated, and finding a verdict accordingly.

Had the plaintiff's counsel thought proper to call upon the Court for an opinion and instruction to the jury, upon any points arising out of the whole, or any part of the evidence, it would have been their duty to give an opinion upon such points, leaving the conclusion of fact from the evidence to be drawn by the jury. But this course not having been pursued, this Court can take no notice of the evidence, although spread upon the record, except so far as it is connected with the single point upon which the opinion, which is excepted to, was given. As to the residue of that opinion, that "the legal aspect of the *case would not be changed, [* 367] although the defendant might, on any occasion, have supplied, at the cost of H. & K., the wire from which the chains so manufactured were made," it is quite as free from the objection as the preceding part of it, since it stands upon precisely the same principle.

Judgment affirmed, with costs.

ROGERS v. ABBOTT.

[4 Wash. 514. April T. 1825.]

Terms imposed, and an affidavit required, on granting an injunction to restrain the defendant from making and vending a machine, for which plaintiff had obtained a patent.

UPON a motion for an injunction to restrain the defendant from making and vending the plaintiff's improvement for which he had obtained a patent, the Court required the plaintiff to subjoin to his bill a special affidavit of the truth of the

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allegations of the same ; and that he is, to the best of his knowledge and belief, the true and original inventor and discoverer of the improvement for which he had obtained his patent ; and that the same had not, to his knowledge or belief been in use, or been described in any public work, anterior to his said invention and discovery.

The injunction was granted until answer and further order ; and the plaintiff is required to institute a suit at law against the defendant, the writ to be returnable to the first Court, to try his right to the said improvement, and to speed the same to trial.

Gordon, for plaintiff.

PENNOCK AND SELLERS v. DIALOGUE.

[4 Wash. 538. October T. 1825.]

In an action for a violation of a patent-right, proof that the plaintiffs at a particular time made a specimen of the thing patented, which had not been before seen or heard of by the witness, is *prima facie* evidence that it was invented by the patentee.

It is unimportant whether the experiment or use of the thing invented and patented was first made by the inventor, or by any other person.

If old materials and old principles be used in a state of combination to produce a new result, the inventor may obtain a valid patent for such result.

It is for the jury to say whether the thing patented, and any other thing resembling it, be the same in principle. If they be, still if that other, asserted by the defendant to have preceded the plaintiffs' alleged discovery, be the same in principle, it will not avoid the plaintiffs' patent ; unless it is proved that it was in use.

Suggestions made by the mechanic to construct the machine, as to its form or proportions, are not sufficient to invalidate the patent ; although they may be incorporated in the specification.

If an inventor, before he obtains a patent, makes his discovery public, and permits the free use of it by others without objection, or assertion of claim to the invention, of which the public might take notice, he abandons his right

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to the discovery ; and a patent can give him no title to the monopoly ; and it makes no difference, that the article so made and publicly used, was made by a particular person, by the permission of the inventor.

Minutes of a hose company, of which the plaintiffs were members, and at whose instigation and expense the hose, the subject of the patent, was asserted to have been invented, may be read on the part of the defendant, to prove the plaintiffs were not the inventors.

But other entries made at other times in the same books, cannot be read to prove that the company acknowledged the plaintiffs to be the inventors, (the defendant * not having been a member of the company ;) [* 539] or to show that the company were not the inventors ; the defendant's counsel disavowing any intention to impute the invention to the company.

A report made to the hose company, in which the rivet hose, the invention patented, is described, cannot be read in evidence to bring the case within the sixth section of the Patent Law, as that is not a public work.

The minutes of other hose companies, of which plaintiffs were not members, cannot be read in evidence by the defendant for any purpose.

THIS was an action on the case for the infringement of a patent-right. The declaration states that the plaintiffs were the true and original inventors and discoverers of a certain new and useful improvement, in the art of making leather tubes or hose for conveying air, water, and other fluids ; which improvement had not been known or used before the said invention by the plaintiffs. It then proceeds to state the steps taken to obtain a patent, as prescribed in the first section of the Patent Law, and the granting of the patent on the 6th of July, 1818. Upon the plea of not guilty, the defendant gave a written notice to the plaintiffs, that he should, at the trial, offer evidence tending to prove that the plaintiffs were not the original inventors of the thing patented, but that the same was known and in use before the supposed discovery of the plaintiffs.

The specification sets forth that "the ordinary method of constructing leather tubes or hose, is by securing the two edges together by sewing or stitching. The improvement consists in lapping the edges of the leather so as to form a

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double thickness in that part, and then connecting them with metallic rivets and burs. The leather near both edges being perforated, rivets, having heads on one end, are inserted in the holes so formed along one edge first; the other edge of the leather is then lapped over and driven on the projected rivets. The rivets then being made through both edges, or thicknesses of the leather, burs of metal about the size and shape of the heads of the rivets, are then forcibly driven on their projecting ends, and secured there by hammering or compressing the ends so as to form heads. The rivets are inserted near each other in one or more rows as occasion may require, and the bars are so forcibly driven, as to bring the parts of the leather into complete and close contact, forming a durable, flexible, and water-tight seam; the pressure of the fluid upon the inner lap or edge of the leather, increasing the tightness of the seam. In order to connect several pieces of leather, so as to form a tube or hose of any extent, the ends are cut in an oblique form, and are secured together by rivets and burs in the manner above described."

The defendant's counsel admitted that the defendant had made and used the rivet hose, as described in the specification, since the date of the plaintiffs' patent, and that the invention was useful. They then gave evidence, tending [* 540] to prove that the first specimen of hose * was procured by the zeal and public spirit, and at the expense of the Philadelphia Hose Company in the year 1811; and that the plaintiffs were not only members of that company, but were on the experimental committees who were charged with the duty of inquiring into and procuring some improved mode of making them. That in that year, a certain quantity of hose was made by order of the committee for that company, by a certain Samuel Jenkins; who stated upon his examination, that he was taught by the plaintiffs in 1811 to make hose, and that by their permission, he made about thir-

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teen thousand feet of hose for different hose companies, from the year 1811 to the time when the patent was granted. They also gave evidence that more than thirty years ago, one Andrews used harness, the parts of which were fastened by metallic rivets and bars. That in the year 1811, an Indian scabbard, used for containing a large knife, was brought to Philadelphia, and was shown to the president of the Philadelphia Hose Company. It was made of sole leather, the edges of which were united and fastened by lead rivets. That before the year 1811, Mr. Bedford made a specimen of hose, in all respects resembling that claimed by the plaintiffs, except that the edges, which were lapped, were fastened by nails with the heads on the inner side, and clinched on the other. This specimen was placed in a domestic warehouse for public examination. Evidence was also given by John Anderson, that in the year 1799, he, being one of the ship's company of the ship *Samuel Smith*, made six or seven pieces of hose with scupper leather, and fastened with rivets and burs, which he applied to the scuppers of that ship to convey off the water from the deck ; and that in the year 1802, he made another piece of hose in like manner, which he applied to a small fire-engine for washing windows, as a substitute for a goose neck, and which was used frequently for the purpose for which it was designed, by the person for whom it was made, and by others.

Upon this evidence the defendant's counsel contended,

1. That the plaintiffs were not the true and original inventors of the improvement in question, but that the same was known and in use before their alleged discovery in 1811 ; the harness, the scabbard, and the hose constructed by Bedford, and by Anderson, being in principle the same as the patented improvement. That independent of this evidence, the specimen made by one of the plaintiffs was not the effect of the suggestions of either of the plaintiffs, but was brought into

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existence by the exertions, and at the expense, of the Philadelphia Hose Company ; nor was the merit of the invention at any time asserted by the plaintiffs, or either of them.

2. That the patent covers two rows of rivets, whereas it is proved that another person suggested to the plaintiffs the two rows.

3. That the use of the improvement by the plaintiffs and others, prior to the *application for the patent*, avoids it under the first section of the Patent Law ; which author-
[* 541] izes the granting of a patent to * the true and original inventor of a machine, manufacture, &c., not known or used prior to *his application* ; and that these expressions are not controlled by those to be found in the 6th section. . 3 Inst. 183 ; 5 Bac. 591, 592 ; Godson on Patents, 60, 61, 64 ; Wood v. Zimer, 1 Holt's N. P. Rep. 58 ; Thomas v. Knight, decided by Judge Van Nesse, Law Journal, published in Connecticut.

4. That the use by the public of this invention, from 1811 to the time when this patent was applied for, without opposition by the plaintiffs, amounted to an abandonment of their right, and a gift of their discovery to the public. 1 Gall. 482 ; Evans v. Eaton, 1 Peters, 348 ; also, Pettibone v. Derringer, in this Court.

These points were all controverted with great ability by the plaintiffs' counsel ; who, upon the last point, insisted, that an abandonment was not to be presumed in this case, inasmuch as it appeared that every foot of hose which had been made prior to the date of the patent, was made by Jenkins, under the permission of the plaintiffs, who thereby retained their control over their discovery.

WASHINGTON, J. The patent being *prima facie* evidence, and no more, of the right of the patentee to the subject

patented ; the one in question is objected to upon the following grounds :

1. That the plaintiffs are not the true and original discoverers of the improvement mentioned in the patent, but that the same was in use prior to their supposed discovery. Evidence having been given that the improvement was in use prior to the date of the patent, the plaintiffs insist that they made the discovery some time in the year 1811, and to establish that fact, they have given the following evidence : three witnesses, Mr. Haines, Mr. Vaux, and Mr. Wainright, have stated that the first specimen of rivet hose they ever saw or heard of, was shown to them by one of the plaintiffs, in the year 1811 ; and Mr. Robins, another witness, who gives the same testimony, has further deposed, that he saw one of the plaintiffs engaged in making the first specimen he had ever seen or heard of, which was completed, and an experiment made of it, in the year 1811.

To the weight and effect of this evidence certain objections have been made by the defendant's counsel, which it is proper we should notice.

It is insisted, first, that the evidence proves no more than that one of the plaintiffs made a specimen of hose in the year 1811, but not that he was the author of the invention, and entitled to the merit of the discovery. The objection does not appear to the Court to be well founded ; because the fact of making or exhibiting an article, never before seen or heard of by the witnesses who prove the fact, is at least *prima facie* evidence of invention, until other evidence is given to prove that the same article was invented, known, or in use, at an antecedent period of time, and that the patentee had only embodied * the conceptions and the discovery of [* 542] some other person. No evidence of this kind has been given, unless it may be considered as being so by the witnesses whose testimony will be hereafter noticed.

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2. It is next objected that the plaintiffs made no experiment of the piece of hose made by them in 1811, but that it was first made by the Philadelphia Hose Company, with a specimen laid before them by the experimental committee. In answer to this objection, it may, in the first place, be remarked, that Mr. Robins has stated that he saw Mr. Pennock try the first specimen made by him; and it may be added, that it is in the highest degree improbable that an inventor should not anxiously seek an opportunity to test by experiment the success and practical utility of the article he has invented, before it is exhibited to the public. But be this as it may, it is clearly immaterial whether the experiment be made by himself, or by others; the only question being, is he the original inventor of an art not before known or used. The hose company do not pretend that they were the inventors; and consequently, the experiment, if first made by them, cannot detract from the merit of plaintiffs, if, in point of fact, they or either of them, was the original inventor.

3. It is insisted that the Philadelphia Hose Company, by their zeal, public spirit, and their money, caused the discovery to be made. This may be admitted; and further, that but for the laudable exertions of that body, the discovery might probably not have been made, either by the plaintiffs, or by any other person, to the present moment. But what has this to do with the question of original discovery? The conduct of the company may entitle them to every kind of merit except that of inventors, but cannot deprive the plaintiffs of that merit, if they were in fact the inventors. Lastly, it is insisted, that the absence of any proof that the plaintiffs or either of them, at any time, to the company, or to their associate members of the experimental committee, or to any other person, claimed to be the inventors of this improvement, is sufficient to outweigh all the evidence of original invention which they have given. It must be admitted that, as an

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argument upon the weight of evidence, this is fairly urged. It has before been observed, that the making, or exhibiting the first specimen of hose ever seen or heard of by the witnesses of that fact, is *prima facie* evidence of the plaintiffs' invention. It is fair then to oppose to that evidence, the total silence of the plaintiffs, or of Mr. Pennock, as to their or his claim of original invention, and to urge the probability, from that circumstance, that they did no more than give form and substance to the invention of some other person. But whether the circumstance is sufficient to outweigh the evidence to which it is opposed, is for the jury to decide.

The defendant has given evidence for the purpose of showing that the improvement in question was invented and in use long before the year 1811; and to enable you to understand and apply this evidence, *it will be [* 543] necessary for you constantly to keep in mind what the improvement is which is patented, the mode of constructing it, and the use and design of it. It is for an improvement in making leather hose or tubes for conveying water and other fluids; and they are constructed by lapping their edges over, and fastening them by metallic rivets and burs, so as to be rendered water-proof, and capable of resisting a heavy pressure of that fluid. Now, it is for the jury to say whether the harness, the parts of which were fastened by metallic rivets, or the Indian scabbard, which was intended as a covering for a knife, not lapped, but their edges united by lead rivets, is in form, structure, or principle, the same thing as the hose for which this patent was granted? It is true that, in the construction of those articles, leather, and metallic rivets were employed; but it is clear law, that if old materials, and old principles in mechanics, or otherwise, are used in a state of combination, so as to produce a new result, the inventor of the article so produced is entitled to apply for, and may obtain a valid patent.

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The hose invented by Mr. Bedford more nearly resembles that which the plaintiffs have patented. It was made of leather, the edges of which were lapped and fastened by nails, having their heads on the inside, and their points clinched on the outside ; and its use was, to convey water. Now you have to decide upon the evidence, first, whether a hose made with clinched nails, and one made with rivets and burs, are, in principle, the same ; to prove, and to controvert which fact, specimens of each have been exhibited, and some witnesses examined ; and secondly, whether there is any proof that the hose invented by Mr. Bedford was ever in use ? If they are the same in principle, but Mr. Bedford's was never in use before the plaintiffs' invention, then it cannot impeach the validity of their patent. If it was the same in principle, and had been so used, the plaintiffs cannot recover in this action.

The last invention relied upon by the defendant's counsel is that of John Anderson. He swears that, in 1799, he made six or seven pieces of hose on board the Samuel Smith, for conveying water from her deck, and fastened them to her scuppers — that he made them with scupper-leather, and fastened them with iron rivets and burs. That, in the year 1802, he made a small fire-engine for Mr. M'Callister, with whom he lived, for the purpose of washing his windows ; and, as a substitute for a goose neck, he made a piece of hose about eighteen inches long, and fastened the edges with metallic rivets and burs ; that it was in common use, whilst he lived with that gentleman, by his family and by his neighbor. The seams, he states, were water-tight, but he does not state in his deposition whether the edges were lapped over, or merely united. One of the witnesses, who was examined, stated, that the pressure of the water on the inner lap gave to it the character and utility of a valve ; and it is for you therefore to say, whether the hose described by Anderson, and that patented, are the same in principle.

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* To contradict this witness in part, six of the [* 544] crew of the Samuel Smith, in 1799, have been examined, who state, that they never saw the hose spoken of by this witness — that if it had been made and fixed to the scuppers, it could not have escaped their observation ; and finally, that hose would not have answered the purpose of scuppers. The character of this witness for veracity, has also been attacked and defended. As to all this, the jury must decide for themselves.

2. The next objection made to this patent is, that it is broader than the discovery, it being proved that the double row of rivets was adopted upon the suggestion of another person. If this be a valid objection, very few patents could be supported ; as, in most cases, it might probably be shown, that, whilst the thing patented was constructing, or before it was brought to perfection, many improvements in the form or proportions were adopted in consequence of the suggestions of the mechanic employed to make the specimen, or of others. But these are not inventions or improvements for which a patent could be obtained, nor can they invalidate the patent for the thing to which they were applied.

3. The next objection is, that the hose, having been known and used prior to the *application* of the plaintiffs for a patent, the patent is void by the terms of the first section of the Patent Law. Upon this point, which certainly involves much difficulty, we think it unnecessary to give a decision ; because we are clearly of opinion, that, if an inventor makes his discovery public, looks on, and permits others freely to use it, without objection, or assertion of claim to the invention, of which the public might take notice, he abandons the inchoate right to the exclusive use of the invention to which a patent would have entitled him, had it been applied for before such use ; and we think it makes no difference in the principle, that the article so publicly used, and afterwards patented, was

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made by a particular individual, who did so by the private permission of the inventor. As long as an inventor keeps to himself the subject of his discovery, the public cannot be injured; and even if it be made public, but accompanied by an assertion of the inventor's claim to the discovery, those who should make, or use the subject of the invention, would at least be put upon their guard. But if the public, with the knowledge, and the tacit consent of the inventor, is permitted to use the invention, without opposition, it is a fraud upon that public afterwards to take out a patent. It is possible that the inventor may not have intended to give the benefit of his discovery to the public; and may have supposed that, by giving permission to a particular individual to construct for others the thing patented, he could not be presumed to have done so. But it is not a question of intention which is involved in the principle which we have laid down, but of legal inference, resulting from the conduct of the inventor, and affecting the interests of the public. It is for the jury to say [* 545] * whether the evidence brought this case within the principle which has been stated. If it does, the Court is opinion that the plaintiffs are not entitled to a verdict.¹

Verdict for defendant.

Chauncey and Binney for plaintiffs.

J. R. Ingersoll and John Sergeant, for defendant.

The following points of evidence were ruled in this case :

1. That the minutes of the Philadelphia Hose Company, of which the

¹ Affirmed by the Supreme Court upon a writ of error at the January term, 1829. 2 Peters, 1.

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plaintiffs were members, (as they also were of the committee appointed to make inquiries respecting the best method of constructing hose,) might be read by the defendant's counsel to prove that the plaintiffs were not the original inventors of the rivet hose, but that they were in use before their alleged invention in 1811; but not to prove that the plaintiffs had surreptitiously obtained a patent for the invention of another person, that forming no part of the notice to the plaintiffs.

2. That the minutes being read for those purposes, the plaintiff cannot read other entries made in the minute-book, to show that the company, at a subsequent period, acknowledged the plaintiffs to be the original inventors of these hose; the defendant not being a member of that company. The written declarations of the company were good against the plaintiffs, but not for them, unless they should be necessary to explain such parts of the transactions and declarations as shall have been read. If part of a statement be read by one side, the other side may insist upon having the whole read. But a subsequent declaration or statement made by the company, does not come within this exception. Neither can the plaintiffs read other parts of the minutes in order to show that that company were not the inventors, or that the invention was not made at their expense; the defendant's counsel having disavowed any intention to claim for the company the merit of the invention; and the latter subject being totally irrelevant to the cause, and we shall so instruct the jury.

3. A report of this company, in which the rivet hose is described, cannot be read to bring it within the sixth section of the Patent Law; because first, the book containing the minutes, is a private and not a public work; and if it were, then secondly, no notice of such a defence has been given to the plaintiffs.

4. The minutes of other hose companies, of which the plaintiffs were not members, cannot be read by the defendant against them for any purpose.

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[1 Paine, 441. September T. 1825.]

On an application for an injunction to restrain the infringement of a patent-right, it should be stated in the bill, or by affidavit, that the complainant is

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the inventor: and the bill must be sworn to. It is not sufficient that he swore to this fact when he obtained his patent.

To obtain the injunction, the case should be such as to leave little if any doubt in the minds of the Court, as to the validity of the patent; especially if it rests upon the complainant's own showing without any opposing testimony. The Act of the 15th of February, 1819, does not alter the principles on which injunctions are granted, but merely extends the jurisdiction of the Circuit Courts to parties not before falling within it.

The established rules which govern Courts of Equity, on such applications are, that where there has been an exclusive possession of some duration, under the patent, an injunction will be granted without putting the party previously to establish the validity of his patent at law. But where the patent is recent, and it is attempted to be shown that the specification is bad, or otherwise that the patent ought not to have been granted, the Court will not take the decision upon itself, but will send the party to establish his patent at law.

A patent for an improvement should describe the machine in use, that it may be known in what the improvement consists.

One had patented, "a new and useful improvement in the steam tow-boat," but the specification did not mention the invention as an improvement, but simply described a tow-boat: *Held*, that the specification was broader than the patent, and therefore bad.

[* 442] * The invention should be so clearly described, as to enable the public to put it in use.

The specification described the invention as "consisting essentially in attaching the packet to the steamboat, with ropes, chains, or spars, so as to communicate the power of the engine from the towing vessel to the vessel taken in tow, and kept always at convenient distance, the manner of applying the power, varying with the circumstances in some measure:" held bad for uncertainty, and as describing a well-known natural power, and not an invention.

THIS was an application for an injunction against the violation of a patent-right.

The complainant stated in his bill, that having ascertained by a course of experiments, that the resistance of the water against the bow or head of a vessel, when moving, is greatly diminished by keeping her as close in the wake after another vessel as possible with convenience, and perceiving the result to be favorable to a new and useful application of steam to the conveying of passengers in a separate boat from the en-

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gine, he, on the 4th of December, 1816, obtained a patent "for a new and useful improvement in the steam tow-boat," the specification of which was as follows: "I claim as my invention, the application of steam-engine power, placed in one vessel, to the towing or drawing after her another vessel, for the purpose of conveying thereon passengers or merchandise, or either of them, being a new application of a known power. The manner in which this application may be made, varies with the circumstances in some measure, but essentially consists in attaching the packet to the steamboat, with ropes, chains, or spars, so as to communicate the power of the engine from the towing vessels to vessels taken in tow, and kept always at convenient distance. The advantages attending this improvement are, that lighter and less expensive vessels may be used; the steam-engine boat may be of a smaller size, and the engine may rest on a frame bearing on her * whole extent, but constructed separately [* 443] from the boat; that any kind of steam-engine may be used and applied, especially those of high pressure and lighter construction, without exposing the passengers and merchandise to danger; and there will be more comfort, quiet, and safety in the packet-boat; and it is obvious there may be, by means of two or more boats, a convenient separation of the passengers, paying different prices. John L. Sullivan."

The bill further stated, that the complainant endeavored to introduce his invention into use as soon as possible, by putting it into practice, and otherwise deriving a revenue therefrom; and particularly, that on his proposal a company was formed and incorporated in the State of Georgia, to navigate the River Savannah with steam tow-boats, to whom a prolongation of the time of the patent, or exclusive privilege for such navigation, was granted by the State of South Carolina, and that the company purchased complainant's patent-

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right, paying him 5,000 dollars. That the success of the company was so great as to induce the formation of other companies in other States ; that the State of Massachusetts granted him an extension of his term to encourage the introduction of tow-boats on Connecticut river ; and that he continued his experiments on Merrimac and Charles rivers, for the purpose of improving in the art.

The bill further stated, that the exclusive privilege of Livingston and Fulton had prevented the complainant from introducing his invention in this State, which he had ever been desirous of doing, until the late decision of the Supreme Court, declaring those privileges unconstitutional ; such a decision as complainant had spent much time and money in endeavoring to procure, but without success. That as soon as possible after this decision, he tried to introduce his invention into New York, by offering it for sale, and endeavoring to form companies, and by publications in the newspapers.

[* 444] *The bill then charged, that the defendant and others had associated for the purpose of building and running the steam tow-boat, Commerce, and safety barge Lady Clinton, for the express purpose of separating the passengers from the boat carrying the engine, in the mode devised by complainant, and for which he had an exclusive right ; and that those boats had in June last, been put in use between New York and Albany, under the command of the defendant Seymour, who had thus usurped complainant's privilege, intercepting and preventing the emoluments thereof, which late disastrous accidents on board of steamboats on the common plan, had rendered more sure, valuable, and important.

The bill concluded with a prayer that the defendants might be restrained by injunction from using said boats.

The motion was argued on the matters contained in the bill only.

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H. D. Sedgwick and *R. Sedgwick* for the complainant.

C. D. Colden and *S. P. Staples* for the defendants.

THOMPSON, J. The application in this case is for an injunction to restrain the defendants and their associates from navigating the steamboat Commerce and safety-barge Lady Clinton, which the bill alleges they are doing in violation of a patent-right of the complainant. The application comes before the Court on notice of the motion duly served. The defendants have appeared by their counsel, but have read no affidavits, or shown any thing in opposition to the motion, except what arises upon the bill itself. Nor has the complainant fortified his application with any thing except what is contained in his bill. It is presumed that the bill has been sworn to, though even that does not appear.

Under this state of the case, an objection has been made, * which may be considered in some [* 445] measure as a question of practice, namely: Whether the bill should not be accompanied by an affidavit, that the complainant believes himself to be the original inventor of what he claims under his patent. The bill in this case does not allege that the complainant is the original inventor; so that admitting it to have been sworn to, there is no verification, under oath, that he believes himself to be the original inventor. That it is material to his claim, that he should be the inventor, cannot be denied. It is the only ground upon which the patent-right can be sustained.

It is said, however, on the part of the complainant, that the oath required to be made by the patentee, before he can obtain his patent, is at least *prima facie* evidence that he is the inventor or discoverer. The weight that ought to be given to this oath may depend on circumstances. The Court will certainly not presume that the patentee, when he made

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the oath, did not believe himself to be the true inventor or discoverer. But the question is not whether at that time he was under such belief, but whether he is still under that belief when he seeks to enforce his patent-right.

In the present case the patent was granted in the year 1816, and the patentee may since that time have obtained such information respecting the invention, that he could not now swear that he believes himself to be the inventor of what he claims; and there may be some question whether the established practice of the Court does not require such an affidavit, when application is made for an injunction. Among the rules of practice adopted by the Supreme Court of the United States, for the Courts of Equity, in February term, 1822, it is by the 33d rule provided, that "in all cases where the rules prescribed by this Court or by the Circuit Courts do not apply, the practice of the Circuit Courts shall be regulated by the practice of the High Court of Chancery in England." And in the case of *Hill v. Thompson*,¹

[* 446] decided * in the year 1817, Lord Eldon said, that when in future an injunction is applied for *ex parte*, on the ground of a violation of a right to an invention secured by patent, it must be understood, that it is incumbent on the party making the application, to swear, at the time of making it, as to his belief that he is the original inventor. For although when he obtained his patent he might very honestly have sworn to his belief of such being the fact, yet circumstances may have subsequently intervened, or information have been communicated sufficient to convince him, that it was not his own original invention, and that he was under a mistake, when he made his previous declaration to that effect.

We think there is great good sense in this rule, and that it

¹ 3 Merivale, 624.

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applies with peculiar force to a case where the patentee has slept for a great length of time upon his naked patent-right without carrying it into practical use. The present case, however, cannot be considered as coming strictly within this rule. The application is not altogether *ex parte*. It is made on notice of the motion, and has been resisted by counsel, and was open to the hearing of opposing affidavits. We do not therefore mean to dispose of the application upon this point; although we think the reason and good sense of the rule is applicable to the case, and would suggest it as fit and proper to be adopted in all cases where the bill does not allege the complainant to be the original inventor.

Whether the complainant's patent is good and valid so as ultimately to secure to him the right he claims, is not a question for decision upon the equity side of this Court. That is a question which belongs to a Court of Law, in which the parties have a right of trial by a jury. The equity jurisdiction exercised by the Court over patents for inventions is merely in aid of the common law, and in order to give more complete effect to the provisions of the statute under which *the patent is granted. And this jurisdic- [*447] tion should, of course, never be exercised but upon the supposition, that the applicant for the aid of the Court, has a right, which has been infringed by the party against whom the injunction is prayed.

It is not a matter of course to grant an injunction upon the mere exhibition of the patent, and an allegation that it has been infringed. The patent may be, upon a trial at law, *prima facie* evidence of the right. But in order to warrant an interference by injunction, there ought to be but little, if any doubt in the minds of the Court as to the validity of the patent, especially where the case rests entirely upon the complainant's own showing, without any opposing testimony.

It has been urged on the part of the complainant, that

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under the provisions of the Act of Congress of the 15th of February, 1819,¹ the patent itself gives to the patentee a right to claim the interference of this Court by injunction. That act declares, "that the Circuit Courts of the United States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases, arising under any law of the United States, granting or confirming to authors or inventors, the exclusive right to their respective writings, inventions, and discoveries. And upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of Courts of Equity, to prevent the violation of the rights of any authors or inventors, &c., on such terms and conditions as the said Courts may deem fit and reasonable."

This act does not enlarge or alter the powers of the Court over the subject-matter of the bill or the cause of action. It only extends its jurisdiction to parties not before falling within it. Before this act it had been held, that a citizen of one State could not obtain an injunction in the Circuit Court for the violation of a patent-right against a citizen of the same State, as no act of Congress authorized such [* 448] suit.² This act removed that objection, *and gave the jurisdiction, although the parties were citizens of the same State. But in the exercise of the jurisdiction in all cases of granting injunctions to prevent the violation of patent-rights, the Court is to proceed according to the course and principles of Courts of Equity in such cases. So that the questions presented in the present case are precisely where they would have been without this act.

In support of the present application, much reliance has

¹ 6 vol. L. U. S. 369.

² 4 Hall Law Journ. 60.

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been placed upon the case of *Livingston and Van Ingen*,¹ decided in the Court of Errors of this State. But a little consideration will show there is no analogy between the two cases. The right of *Livingston and Fulton* was founded upon Acts of the Legislature, which were clear and unambiguous. And if those acts were considered valid and constitutional, no doubt could exist as to the right. There were no facts in dispute, nor could any arise, upon which it was requisite for a jury to decide. There was, therefore, no necessity, or propriety, in sending the parties into a Court of Law to establish their right. That right depended solely on the constitutionality of the statutes under which it was claimed. This question belonged exclusively to the Court, and not to a jury to decide ; and which question, if sent to a Court for trial, would, according to the course of the Courts of this State, come back again for ultimate decision to the tribunal where it then was. And independent of this, *Livingston and Fulton* had been in the actual and exclusive enjoyment, and practical exercise of their right for at least three years.

It will be in vain to look for the circumstances in the present case to support the analogy. The right, in point of law, is, to say the least, doubtful. Some of the questions involved in the inquiry are exclusively for a jury ; and the allegations in the bill, as to the practical exercise and enjoyment of the right claimed, are vague and ambiguous. In what particulars the complainant's application is open to these objections, will hereafter * be noticed. We [* 449] would not be understood as having formed, nor do we mean to express, any decided opinion upon the validity of the patent. We only notice the objections to it, so far as

¹ 9 John. 507.

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may be proper and necessary to regulate our judgment in determining, whether such a case is presented as to entitle the complainant to an injunction, according to the course and principles of Courts of Equity in like cases.

The rule in the English Court of Chancery, on this subject, is : That where a patent has been granted, and there has been an exclusive possession of some duration under it, the Court will interpose its injunction, without-putting the party previously to establish the validity of his patent at law. But when the patent is recent, and upon an application for an injunction, it is endeavored to be shown, in opposition to it, that there is no good specification, or otherwise, that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial ; but will send the patentee to law, and oblige him to establish the validity of his patent in a Court of Law, before it will grant him the benefit of an injunction.¹ And we are not aware of any decisions in the Courts of the United States, or in those of any of the States, which are at variance with this rule. We will proceed then briefly to notice how far it applies to the present case : and first, as to the objections taken to the patent and specification.

We have not the patent before us ; and all that the bill states of its contents is, that on the 4th day of December, 1816, the complainant obtained letters-patent “for a new and useful improvement in the steam tow-boat.” This grant presupposes the knowledge and use of a steam tow-boat, of which the patentee does not claim to be the inven-

¹ 3 Merivale, 624.

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tor, but his patent is for an improvement * in such [* 450] steam tow-boat. The bill sets out the specification, and, so far as it contains a description of the complainant's invention, is as follows: "I claim, as my invention, the application of steam-engine power, placed in one vessel, to the towing, or drawing after her, another vessel, for the purpose of conveying thereon, passengers, or merchandise, or either of them, being a new application of a known power. The manner in which this application may be made, varies with the circumstances in some measure, but essentially consists in attaching the packet to the steamboat, with ropes, chains, or spars, so as to communicate the power of the engines from the towing vessel to vessels taken in tow, and kept always at convenient distance."

This specification is obviously broader than the patent. The latter is for an improvement in the steam tow-boat ; and the former contains a description of the steam tow-boat itself ; of which the complainant claims to be the inventor, according to his specification. The patent and specification are connected together and dependent on each other for support. The specification should maintain the title of the patent. The latter should not indicate one thing and the former describe another, as the subject of the grant.¹ Both the language and the policy of the Act of Congress require that the specification should be clear, plain, and intelligible, so that others may be taught by it to make, or do the thing for which the patent is granted. The object of the specification is to inform the public, after the expiration of the term for which the patent is granted, what the invention is : and it ought, therefore, to put the public in possession of whatever is necessary to the use and enjoyment thereof.

¹ Godson on Patents, 102-106 ; 2 Barn. and Ald. 350.

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Does this specification contain any such certainty of description? It states that the manner in which the power is to be applied, varies with the circumstances in [* 451] some measure. Nothing *could be more vague and uncertain than this description. But it adds, "that it essentially consists in attaching the packet to the steamboat with ropes, chains, or spars; so as to communicate the power of the engine from the towing vessel to vessels taken in tow, and kept always at convenient distance." On the argument much stress was laid on the word *attaching*. It was said to signify a fixed and solid union between the two boats, which distinguished it from the ordinary towing in common use, which was called connecting the two boats by some temporary fastening. We are not aware of any such distinction between the two terms, as to draw after it such important consequences. The legal construction would be the same if the word connecting had been used instead of attaching.

The patentee cannot surely claim as his invention the towing of one boat after another. But the manner of attaching the two together would seem to be the right he asks to have secured to him. If he has discovered any important improvement in this respect, it should have been described in the specification with more certainty and precision. To say that the two boats must be so attached as to be kept always at convenient distance, does not seem to be that full explanation which, after the expiration of the patent, would leave the public much wiser than they were before. What is a convenient distance, and the particular manner of attaching the one to the other, will still have to be ascertained by experience. If, according to the patent, the invention claimed is an improvement in the steam tow-boat, the specification, to be complete, should describe the one previously in use, that it might be seen clearly in what the improvement consisted, as

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the patent cannot cover more than the improvement claimed. These are some of the objections to the patent itself, which present such strong doubts in the mind of the Court, as to its validity, that it is deemed improper to interpose an injunction until the validity of the patent has been tried at law.

* Nor has there been such a possession and en- [* 452]
joyment of any right claimed under the patent, as to induce the Court to grant the injunction on that ground. The bill contains no direct allegation that the invention has, at any time, been carried into practical operation by the patentee, or any other persons under his authority. The exertions and attempts stated to have been made for this purpose are unimportant, unless attended with success. The several Acts of State Legislatures alleged to have been obtained, do not show any practical use of the invention, nor can they, with propriety, be considered as showing possession of the right claimed. The only part of the bill which affords an inference that the patentee has carried his invention into practice, is that which states, that a company has been formed in Georgia to navigate the River Savannah with steam tow-boats; that they have paid him five thousand dollars for his patent-right, and that the success of the company was so great as to induce the formation of other companies in other States. It is perhaps reasonable to infer, that it was intended here to state, that the success which the company met with consisted in profitably navigating the Savannah river with steam tow-boats. But, admitting this to be the inference, there is no time stated when it was put in operation. And the practical use of the invention may be too recent and questionable to call for the protecting power of an injunction. In the case of Hill and Thompson, when Lord Eldon adopted the rule before referred to on this subject, the patentee had had his patent-right in operation for about eighteen months;

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yet this was considered too short a period to justify a continuance of the injunction.

We are accordingly of opinion that the motion must be denied.

WILLARD EARLE v. ELISHA SAWYER.

[4 Mason, 1. October T. 1825.]

A combination, if simple and obvious, yet if entirely new, is patentable; and it is no objection to it, that up to a certain point it makes use of old machinery.

Drawings annexed to a specification, and referred to by numbers and letters in the specification, constitute a part of the specification, and may be referred to in aid of the description to give it certainty.

As to the proper rule of damages in cases of infringement of patents.

CASE for the infringement of a patent. After a verdict found for the plaintiff, a motion for a new trial was made by *F. Dexter* for the defendant, which was opposed by *Bliss* and *Webster* for the plaintiff. The facts and arguments are fully discussed in the opinion of the Court.

STORY, J. The plaintiff, on the 28th of December, 1822, procured letters-patent for "a new and useful improvement in the machinery for manufacturing shingles, called the *Shingle Mill*," and filed a specification in the Patent Office, a copy of which, with the explanatory drawings and figures referred to therein, is annexed to the letters-patent. In this

[* 2] specification, * he describes his invention as follows:

"Said improvement consists in such new arrangement and change of parts of my *former machine* for the like purpose, for which letters-patent were granted to me by the President of the *United States*, bearing date the third day of

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November, A. D. 1813, *as to admit the use and application in said machine of the circular saw, instead of the perpendicular saw heretofore used*, and the substitution of such other parts as are rendered necessary by these alterations, in order to effect the required timing and proper movements of the respective parts thus altered, in connection with other parts of said machine.” He then proceeds to describe these alterations with great minuteness, and annexes drawings of the whole machine with the new combination of parts, and distinguishes in those drawings, by appropriate coloring and descriptions, what is new from what belonged to the old machine. The former machine, here alluded to and patented by the plaintiff, is a machine for manufacturing shingles, called the *Improved Shingle Mill*, in which a perpendicular saw, with the appropriate machinery to move it, was exclusively used. The present patent claims, as an invention of the plaintiff, the substitution of a circular saw, with the appropriate machinery in the old machine, for the like purpose of sawing shingles. With the exception of this substitution, all the other parts of the old machine, such as the carriage to move the block to be sawed, and the alternate motion on a diagonal line of each end of it, so as to present first a thick and then a thin end to the saw, were unaltered.

At the trial it was proved, that the defendant had made and used a machine with a circular saw in substance like the plaintiff's, though with some slight variations of form, so as to cover up the evasion of the patent. The defendant had previously applied to the plaintiff to buy one of his improved shingle mills for use in the town where he resided, which the plaintiff declined, upon the ground (as was suggested) that he had already entered into some contract with other persons for the exclusive use * there. The [* 3] defendant, upon that refusal, intimated that the plaintiff would find that other persons could make shingle

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mills as well as he ; and soon afterwards the defendant had his constructed and put in operation.

There was no evidence in the case to show, that any person had ever, before the plaintiff's asserted invention, applied a circular saw in any manner to the plaintiff's old machine. But the whole evidence established, that the first application was suggested by him, and first put in operation by him, before he obtained his patent. Some testimony was offered to prove, that in a machine for cutting clapboards the circular saw had been in use in *Brunswick*, in *Maine*, for several years, but the testimony as to the structure of this machine, and its identity with the plaintiff's invention, as well as its priority in point of time, was so loose and uncertain and unsatisfactory, that though it was left to the jury, it was not deemed of any serious importance in the cause.

There was considerable conflict of testimony in the cause, (which was left to the jury,) as to the question whether the application of the circular saw to the old machine was an invention or not, scientific witnesses differing in opinion on the subject. It was proved that circular saws were in use before, for the purpose of veneering and sawing picture frames, but they were small ; and it was testified, that the machinery, by which a circular saw should be substituted for a perpendicular saw, in the plaintiff's old machine, was so obvious to mechanics, that one of ordinary skill, upon the suggestion being made to him, could scarcely fail to apply it in the mode which the plaintiff had applied his. This testimony was encountered by suggestions and proofs of the difficulties, which the plaintiff himself (who is an ingenious mechanic) had encountered in making his own substitution. But this also was left for the consideration of the jury.

It was proved that the plaintiff's old machine sold for 60 or 70 dollars, and his machine with the improvement sold for 150 or 200 dollars.

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* The jury found a verdict for the plaintiff for [* 4] 300 dollars ; and the defendant has applied to the Court for a new trial, for reasons which he has filed in the cause, upon which I shall have occasion to comment, only stating at present, that the opinions imputed to the Court are not admitted to be accurately laid down, although the inaccuracy is doubtless unintentional on the part of the counsel for the defendant.

The original reasons assigned for the new trial, state the following as misdirections of the Court : 1. That if any man makes or constructs a machine, which is new and useful, he is entitled to a patent : 2. That if he makes an improvement in any machine, which improvement is new and useful, he is entitled to a patent : 3. That if the plaintiff were the first to take out the perpendicular saw from his original shingle mill, and put in a circular saw, [meaning, I presume, with the proper machinery,] that if it be useful, [meaning, I presume, new and useful,] it is sufficient to entitle him to a patent : 4. That if the plaintiff were the first to apply or combine a circular saw with his original shingle mill for the purpose of making shingles, although the shingle mill were in common use, and the circular saw were in use, [meaning, I presume, separately, and not in combination,] and there were nothing new in the mode or machinery, by which it was applied, [but meaning, I presume, that the combination itself was new,] still the plaintiff is entitled to a patent.

In the directions thus supposed, with the explanations and additions above inserted, which seem necessary to express the true sense of the propositions, I do not at present perceive any error. But I rather wish to state the real opinions expressed to the jury, with which, upon more mature reflection, I confess myself entirely satisfied.

The main question was, and still is, whether there is any thing new in the improvement patented by the plaintiff. He

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was already the patentee of the original shingle machine, which operated with a perpendicular or reciprocating saw. The other part of his apparatus for adjusting the logs to be sawed, was very ingenious, but not being in controversy, requires no consideration. By his present patent, he claims to be the inventor of the application of a circular saw, as a substitution for the perpendicular saw. He does not claim (which is very material) to be the inventor of the circular saw, or of any mode or machinery, by which it may be applied to sawing generally, or to sawing logs, or to sawing shingles. He claims to be the inventor of a combination of it in a particular manner with his old machine, for the purpose of sawing shingles. In what manner is the claim met? Not by showing, that any other person ever thought of, or invented such combination before, for it is admitted that the plaintiff is the first person who conceived or executed it; but by showing, that he is not the inventor of a circular saw, or of the particular machinery of belts and drums and wheels, &c., by which such a saw is commonly put in operation; and that the combination itself is so simple, that, though new, it deserves not the name of an invention.

The whole argument, upon which this doctrine is attempted to be sustained, is, if I rightly comprehend it, to this effect. It is not sufficient, that a thing is new and useful, to entitle the author of it to a patent. He must do more. He must find it out by mental labor and intellectual creation. If the result of accident, it must be what would not occur to all persons skilled in the art, who wished to produce the same result. There must be some addition to the common stock of knowledge, and not merely the first use of what was known before. The Patent Act gives a reward for the communication of that, which might be otherwise withholden. An invention is the finding out by some effort of the understanding. The mere putting of two things together, although never done before, is no invention.

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It did not appear to me at the trial, and does not appear to me now, that this mode of reasoning upon the metaphysical nature, or the abstract definition of an invention, can justly be applied to cases under the Patent Act.

That Act proceeds upon the language * of common [* 6] sense and common life, and has nothing mysterious or equivocal in it. The first section¹ enacts, that when any person, &c., shall allege that he has “invented any *new* and *useful* art, *machine*, manufacture, or composition of matter, or any *new* and *useful improvement* on any art, *machine*, manufacture, or composition of matter, *not known* or *used* before the application, &c., it shall be lawful for the Secretary of State to cause letters-patent to be made out, &c., granting the exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery,” &c. The thing to be patented is not a mere elementary principle, or intellectual discovery, but a principle put in practice, and applied to some art, machine, manufacture, or composition of matter. It must be *new*, and not *known* or *used* before the application; that is, the party must have found out, created, or constructed some art, machine, &c., or improvement on some art, machine, &c., which had not been previously found out, created, or constructed by any other person. It is of no consequence, whether the thing be simple or complicated; whether it be by accident, or by long, laborious thought, or by an instantaneous flash of mind, that it is first done. The law looks to the fact, and not to the process by which it is accomplished. It gives the first inventor, or discoverer of the thing, the exclusive right, and asks nothing as to the mode or extent of the application of his genius to conceive or execute it. It must also be use-

¹ Act of 1793, ch. 11.

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ful, that is, it must not be noxious or mischievous, but capable of being applied to good purposes; and perhaps it may also be a just interpretation of the law, that it meant to exclude things absolutely frivolous and foolish. But the degree of positive utility is less important in the eye of the law, than some other things, though in regard to the inventor, as a measure of the value of the invention, it is of the highest importance.

The first question then to be asked, in cases of this nature, is, whether the thing has been done before. In [* 7] case of a machine, * whether it has been substantially constructed before; in case of an improvement of a machine, whether that improvement has ever been applied to such a machine before, or whether it is substantially a new combination. If it is *new*, if it is *useful*, if it has *not been known* or *used* before, it constitutes an invention within the very terms of the act, and, in my judgment, within the very sense and intendment of the legislature. I am utterly at a loss to give any other interpretation of the act; and, indeed, in the very attempt to make that more clear, which is expressed in unambiguous terms in the law itself, there is danger of creating an artificial obscurity. With these views, I did not hesitate to tell the jury at the trial, that the true question for them to decide was, whether the improvement, secured by the patent, had ever been thought of, or applied to the original machine, by any other person, before the plaintiff conceived and executed the combination. If they were of opinion that it had not been, and that he was the author of it, then he was the inventor within the meaning of the act, and entitled to a patent. All the other remarks, introduced as the groundwork of the motion for a new trial, were mere illustrations of this single principle, which was brought home to the case on trial, by a direct application. My judgment on this point remains unshaken by the subsequent arguments, urged at the bar.

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The case of *Brunton v. Hawkes*, (4 Barn. & Ald. 541,) is thought to countenance the doctrine contended for on behalf of the defendant. If it did, it might be very material to consider, whether it could govern in the construction of our own Patent Act. But, upon the most careful consideration of that case, it does not appear to me to break in at all upon the law, as the Court has held it on the present occasion. One question there, was, whether there was any novelty in an alleged improvement in the making of ships' anchors. It was proved, that the same operation had been long known and applied for similar purposes in the adze anchor and the mushroom anchor. The Court thought, upon the evidence, the plaintiff's invention, as to the anchor, was not

* new. Lord Chief Justice Abbott, said, "a patent [* 8] for a machine, *each part of which was in use before*, but in which the *combination* of the different parts is *new*, and a new result is produced, is good, because there is a novelty in the combination. But here the case is perfectly different; formerly, three pieces were united together; the plaintiff only unites two; and *if the union of those two had been effected in a mode unknown before, as applied in any degree to similar purposes*, I should have thought it a good ground for a patent. But, unfortunately, the mode was well known and practised." It strikes me, that the doctrine here laid down is perfectly correct, and such as has been often recognized in this Court. And a careful perusal of the opinions of all the judges, in that case, will fortify, in no small degree, what has been delivered by this Court in the present trial. How, indeed, can it be possible, that an *English* Court should deem some intellectual labor, beyond the novelty of the combination, necessary for a patent, when it is the acknowledged law of *England* (different in that respect from our own) that the first importer of an invention, known and used in foreign parts, may be entitled to a patent as the in-

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ventor in England? What of intellect is employed in the mere importation of a known machine? An inventor, in the sense of the *English* law, is the first maker, or constructor, or introducer, in *England*.

I will now briefly notice some other grounds in support of the motion for a new trial, which have been filed at a later period, and relied upon at the argument. I shall not dwell on the first and second reasons, because they do not correctly state the facts connected with the opinion of the Court. They rest upon suggestions respecting the clapboard machine, and its supposed identity with the plaintiff's machine. In summing up to the jury, the Court took notice of the very imperfect and loose testimony on this point, brought suddenly into the cause, at its very close, and suggested to the jury,

whether, under the circumstances, they could, upon
[* 9] such testimony, believe, that the machine * for sawing clapboards was identical with the plaintiff's improved machine for sawing shingles; and added, that the proof of that fact rested on the defendant, as also, that it was in existence before the plaintiff's invention. The Court further stated, that unless the machine were substantially the same, in principle and operation, no objection could arise from this source to the plaintiff's patent, since he did not claim an improvement upon any or all clapboard machines, but only an improvement upon his original shingle machine. To this opinion also my mind still adheres.

Another ground is, that the Court directed the jury, that the drawings annexed, and referred to in the specification, constituted a part thereof; and that they might be resorted to, to aid the description, and to distinguish the thing patented from other things known before. In point of fact, the drawings were annexed to the specification in the patent, and it made perpetual references to them, distinguishing thereby the new parts from the old, so that it was unintelligible

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without them. The Court, therefore, in the first part of the direction, did no more than state the fact, as it was; and the other part was correct, unless the description must be wholly *in writing*. The argument now is, that by the very terms of the Patent Act, there must be a *written* description (without any reference to drawings) in such full, clear, and exact terms, as to distinguish the things patented from all other things; and that, in case of a machine, the act requires drawings in addition thereto. For this position, the case *Ex parte Fox*, (1 Ves. & Beames, 67,) before Lord Eldon, has been cited. It was a petition to the Lord Chancellor for the grant of a patent, against which a caveat had been entered. On hearing the parties, Lord Eldon granted the patent, and on that occasion is reported to have said, "I take it to be clear, that a man may, if he chooses, annex to his specification a picture or a model, descriptive of it; but his specification must in itself be sufficient, or I apprehend it will be bad." As I understand this language, it is not intended to assert the doctrine for * which it is cited. It means, [* 10] that the specification must in itself be sufficient, and that the mere annexation of a picture or model will not help any defect in the specification. This may be true, where such picture or model is not referred to, as constituting a part of the specification itself. But if the explanations of the specification call for the drawings, and refer to them as a component part in the description, they are just as much a part of the specification, as if they were placed in the body of the specification. Indeed, in many cases it would be impracticable to give a full and accurate description of the form, adjustments, and apparatus of very nice and delicate machinery, without drawings of some of the parts, as every thing might depend on size, position, and peculiar shape. Lord Eldon could not have meant, that if drawings and figures were necessary to a full description of a machine in

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the specification, there was still some stubborn rule of law prohibiting it. That would be to require the end, and yet to refuse the means. One of the objections in *Boulton v. Bull* (2 H. Bl. 463) was, that the specification was imperfect, and it was pressed that there ought to have been drawings to explain the machinery. How was this subject met? Not by stating, that by law no explanatory drawings would help a specification, even if referred to in it, but by showing the specification sufficient without them. Mr. Justice Rooke said, (p. 480,) "As to the objection of a want of a drawing or model, that at first struck me as of great weight. I thought it would be difficult to ascertain, what was an infringement of a method, if there was no additional representation of the improvement, or thing methodised." "If they [the jury] can understand it without a model, I am not aware of any rule of law, which requires a model or drawing to be set forth, or which makes void an intelligible specification of a mechanical improvement, merely because no drawing or model is annexed." ¹

[* 11] * It seems to me then there is no ground for this objection to the charge, even upon the law of patents in *England*, where the specification constitutes no part of the patent itself, but is required by a proviso in every grant, to be enrolled in the Court of Chancery, within a limited time, and particularly to describe and ascertain the nature of the invention, and in what manner the same is to be performed.²

But how stands our own law on this subject; for by this the question must, after all, be decided? The Patent Act requires, that the "inventor shall deliver a written description

¹ See also *Davies on Patents*, p. 440, and *Bovill v. Moore*, 2 Marsh. 211; *Eden on Injunctions*, 249, 260.

² *Davies on Patents*, 8, 34.

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of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, &c., &c. ; and in the case of a machine, he shall fully explain the principle and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions ; *and he shall accompany the whole with drawings and written references*, where the nature of the case admits of drawings," &c. This is an explicit direction to annex drawings, where the nature of the case admits of them, with *written* references ; and when so annexed, they become part of the *written* description required by the act. They may be indispensable to distinguish the thing patented from other things before known. Surely, then, the act could not intend studiously to exclude them as part of the written description. That would be to require the end and deny the means.

I pass over some other grounds, which are not relied on or not proved, to the last assignment of error in the charge of the Court. It is, that the Court stated the measure of damages to be the price of the plaintiff's new machine, after deducting therefrom the price of the plaintiff's old machine.

To this objection it is a sufficient answer, that the Court gave no such direction to the jury. It was not called upon to express *any opinion on the subject. [* 12] The counsel, on both sides, argued the question of damages at large, and coincided in opinion, that, under the circumstances of the case, if the plaintiff was entitled to any damages, the difference of price between the new and old machine was a fair measure of damages. In cases of this sort, where the damages are open to full inquiry, and where the counsel on both sides are content with a measure prescribed by themselves, it is not usual or necessary for the Court to interfere at all. In summing up to the jury, the

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difference of price between the new and old machine was suggested to the jury as evidence of the value of the improvement, and its public utility, and it was left open to them as an ingredient in estimating the damages, but without the slightest intimation that they were bound by it. There certainly is no reason for granting a new trial on account of damages, given according to a rule admitted by the party himself to be a proper one in his own case. But in truth the case does not enable the Court now to say, that the jury, in their estimate of damages, had the least regard to the price of the machines. They were expressly told by the Court, that they were to give the plaintiff his *actual* damages only ; and in what manner they made up their verdict is unknown to us all. There were circumstances in the case calculated to inflame the damages, if the jury should have felt at liberty to go beyond mere compensation for loss ; for there was a meditated infringement of the plaintiff's patent ; and the principal point of defence appeared to be a mere after-thought to excuse the deed.

But I wish to add a few words in relation to the point of law, which the objection suggests, and which is founded upon the decision of this Court, in the case of *Whittemore v. Cutter* (1 Gallis. R. 479.) To that decision, as founded in just principle, I still adhere, although I confess with subdued confidence, since I have reason to believe, that it has not met the entire concurrence of other and abler judicial minds. It has

been maintained, by some learned persons, that the [* 13] price of the invented machine * is a proper measure of damages, in cases where there has been a piracy by making and using the machine, because, in such cases, the verdict for the plaintiff entitles the defendant to use the machine subsequently, and in short transfers the right to him in the fullest manner, and in the same way, that a recovery in trover or trespass, for a machine, by operation of law, trans-

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fers the right to such machine to the trespasser, for he has paid for it.¹ If I thought such was the legal operation of a verdict for the plaintiff, in an action for making and using a machine, no objection would very forcibly occur to my mind against the rule. But my difficulty lies here. The Patent Act gives to the inventor the exclusive right of making and using his invention during the period of fourteen years. But this construction of the law enables any person to acquire that right, by a forced sale, against the patentee, and compels him to sell, as to persons or places, when it may interfere essentially with his permanent interest, and involve him in the breach of prior contracts. Thus, the right would not remain exclusive ; but the very attempt to enforce it would involve the patentee in the necessity of parting with it. The rule itself, too, has no merit from its universality of application. How could it apply, when the patentee had never sold the right to any one? How, when the value of the right depended upon the circumstance of the right being confined to a few persons? Where would be the justice of its application, if the invention were of enormous value and profit, if confined to one or two persons, and of very small value if used by the public at large ; for the result of the principle would be, that all the public might purchase and use it by a forced judicial sale. On the other hand, cases may occur where the wrong done to the patentee may very far exceed the price, which he would be willing to take for a limited number of persons. These, among others, are difficulties which press on my mind against the adoption of the *rule ; and where the declaration goes for a [* 14] user during a limited period, and afterwards the party sues for a user during another and subsequent period,

¹ See Toller's Ex'ors, b. 2, ch. 7, p. 239.

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I am unable to perceive, how a verdict and judgment in a former case is a legal bar to a recovery in the second action. The piracy is not the same, nor is the gravamen the same. If indeed the plaintiff, at the trial, consents that the defendant shall have the full benefit of the machine for ever, upon the ground of receiving the full price in damages, and the defendant is content with this arrangement, there may be no solid objection to it in such a case. But I do not yet perceive, how the Court can force the defendant to purchase, any more than the plaintiff to sell, the patent-right, for the whole period it has to run. The defendant may be an innocent violator of the plaintiff's right; or he may have ceased to use, or to have employment for such a machine. There are other objections alluded to in the case in 1 Gallis. R. 434.

Struck with similar difficulties, in establishing any general rule to govern cases upon patents, some learned judges have refused to lay down any particular rule of damages, and have left the jury at large to estimate the actual damages according to the circumstances of each particular case. I rather incline to believe this to be the true course. There is a great difference between laying down a special and limited rule, as a true measure of damages, and leaving the subject entirely open, upon the proofs in the cause, for the consideration of the jury. The price of the machine, the nature, actual state, and extent of the use of the plaintiff's invention, and the particular losses to which he may have been subjected by the piracy, are all proper ingredients to be weighed by the jury in estimating the damages, *valere quantum valeant*.

Upon the whole, my judgment is, that the motion for a new trial ought to be overruled.

Judgment accordingly.

Herbert v. Adams. 4 Mason.

OBADIAH R. HERBERT v. CHARLES ADAMS.

[4 Mason, 15. October T. 1825.]

A patentee of an invention cannot maintain a suit, after he has made an assignment, for any violation of his patent ; but the suit must be brought by the assignee.

An assignment made before the patent is obtained, is good, and binds the right.

CASE for the infringement of a patent for an improvement in the making of bedsteads. Plea, general issue.

Upon the trial it appeared in evidence, that the plaintiff had made an assignment of his invention on the 8th of July, 1824, and afterwards took out his patent in the Patent Office on the 14th of the same month, and the assignment was recorded the next day in the Department of State, according to the Patent Act, 1793, ch. 11, s. 4.

STORY, J. Under these circumstances I think the present suit cannot be maintained. The suit should have been brought in the name of the assignee. The assignment is not void by being executed before the invention was patented. It was a good transfer of the right of the patentee immediately upon his obtaining the patent, and he would be estopped to set up any adverse title. The subsequent infringement, by the defendant, if any, was a violation of the right of the assignee, and not of the inventor ; for by the fourth section of the Patent Act, after an assignment is recorded, the assignee stands in the place of the original inventor, both as to right and responsibility.

Plaintiff nonsuit.

Webster and Bliss for plaintiff; *Warner and Gorham* for defendant.

Mellus v. Silsbee. 4 Mason.

WILLIAM MELLUS v. ENOCH SILSBEE.

[4 Mason, 108. October T. 1825.]

If an inventor knowingly suffers his invention to go into public and general use without objection, it is a dedication of it to the public, and he cannot afterwards resume the exclusive right.

Our Patent Act differs from the English in several respects. A mere public use by others before taking a patent, *on a sale* thereof by the inventor, is not decisive against him here, as it is in England.

CASE for infringement of a patent, dated the 3d of August, 1822, for an improvement "in the mode of securing from decay the plank, forming the deck, waist, or bottom of ships or vessels, at or near the head of the nails, spikes, or bolts, in correction of the mode heretofore adopted of boring and driving the nails, spikes, or bolts, by which the planks are secured to the timber, beams, or frames, and the mode of securing the head from the effect of the water." Plea, the general issue.

Upon the trial it appeared, that the plaintiff first made the invention in 1804 ; and had suffered it to go into general use without any claim of an exclusive right, or any objection, and without receiving any compensation until the year 1822. The invention was not much used until after 1809, but since the peace of 1815, it had come into very general and public use.

Webster, for the defendant, took several exceptions to the plaintiff's right, and among them, that the plaintiff could not recover, because his allowing the invention to go into public use was a waiver of the exclusive privilege, and it would now be a fraud to enforce it.

Nichols and *Gorham*, for the plaintiff, contended, *e contra*,

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that there had been no such general use as excluded the plaintiff from a recovery. He had a right to allow the public use, so as to test the utility of the invention; and for as long a period as he thought necessary for that purpose.

STORY, J. There is a difference between the language and effect of our statute respecting patents, and that of England. *The statute of 21 Jac. 1, ch. 3, commonly called the Statute of Monopolies, prohibits the grant of monopolies generally; but in the sixth section it excepts "letters-patent and grants of privileges for fourteen years or under, of the sole working or making of any manner of *new* manufactures *within this realm*, to the *true* and *first* inventor and inventors of such manufactures, which *others at the time of making such letters-patent and grants shall not use.*" Upon this statute it has been held, that it is not necessary that the invention should be new to all the world, but it is sufficient, if new *within the realm of England*, and it matters not whether learned by travel or by study.¹ The provision further is, that it must be an invention which *others*, at the time of making the letters-patent, "*shall not use.*" Therefore it was held in *Wood v. Zimmer*, (Holt's R. 58; Davies on Patents, 429,) by Lord Chief Justice Gibbs, that if the inventor, before obtaining a patent, allows his invention to go into public use, he cannot entitle himself to a patent. The public sale of it by the inventor to other persons for use makes the patent void. It is not then *new* to the realm, but is *used* by others within the meaning of the statute.

Our Patent Act uses language somewhat different. The first section² declares, that "when any person or persons, &c.,

¹ *Edgeberry v. Stephens*, Salk. 446.

² Act of 21st February, 1793, ch. 11. See Appendix, *post*, vol. 2.

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shall allege that he or they have invented any *new* and *useful* art, machine, manufacture, or composition of matter, or any *new* and *useful* improvement on any art, machine, manufacture, or composition of matter, *not known or used before the application,*" he or they shall, on application to the Secretary of State, &c., &c., be entitled to a patent. If this were all, there would be great difficulty in construing the words, "not known or *used* before the application," differently from the

words of the English statute, "*which others, at the* [* 110] *making of the letters-patent and grants, * shall not use.*" We should be driven, therefore, to consider the accuracy of the decision of Lord Chief Justice Gibbs. But the 6th section of our statute throws light on this subject, and enables the Court to ascertain with more precision the intention of the legislature. That section authorizes the defendant to give certain matters in evidence, by way of defence, under the general issue, upon proper notice, and among other things, that "the thing thus secured by patent was not originally discovered by the patentee, but had been *in use*, or had been described in some public work, anterior to the supposed discovery of the patentee." Upon these clauses it has been uniformly held, that it must be shown that the invention is new not only in the United States, but to the world, and that it was not *in use* before the asserted discovery. The fact of its being *in use* before his *discovery* is, by the sixth section, made decisive against the patentee." Now, if the intention of the legislature had been, by the first section, to provide, that the mere fact of the invention being "*known or used,*" even with the inventor's permission, before the *application* for a patent, should destroy his right, however otherwise well founded, it is strange that the use should not be limited in the sixth section to the time of such *application*, instead of the "*supposed discovery.*" The sixth section manifestly proceeds upon the ground, that the same thing be-

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ing in use at the time of the supposed discovery, establishes that there is nothing new in the invention ; but it may be known and used at the time of the application for a patent, and yet the applicant have been the true and first discoverer. And the words of the first section are susceptible of the same construction. The things sought to be patented must be something not " known or used " by others before, but *must* be *first* known or *first* used by the person claiming to be the inventor ; that is, others must not have known or used it before his discovery. Upon any other construction, if a party were the true and first inventor, yet if, before his application for a patent, another were to know his invention or use it, * piratically or innocently, the first inventor would [* 111] be ousted of his right to a patent, which is inconsistent with the spirit of the act. Construing, therefore, the first section by the sixth, it seems to me, that the true meaning is, that the first inventor has a right to a patent, though there may have been a knowledge and use of the thing invented by others, before his application for a patent, if such knowledge or use was not anterior to his discovery.

But however this may be, I am clearly of opinion, that if the inventor dedicates his invention to the public, he cannot afterwards resume it, or claim an exclusive right in it. It is like the dedication of a public way, or other public easement. The question, in such cases, is a question of fact, has he so dedicated it? I agree his acts are to be construed liberally ; that he is not to be estopped by licensing a few persons to use his invention to ascertain its utility, or by any such acts of peculiar indulgence and use, as may fairly consist with the clear intention to hold the exclusive privilege. But if the inventor proclaims his intention to all the world, and suffers it to go into general and public use, without objection ; if he asserts no exclusive right for years, with a full knowledge, that the public are led by it to a general use, such conduct in

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my judgment amounts to strong proof that he waives the exclusive right, and dedicates the invention to the world. After such conduct, the attempt to regain the exclusive right, and secure it by a patent, would operate as a fraud upon the public; and would hold out inducements to incur heavy expenses in putting inventions into operation, of which the party might be deprived at the mere will or caprice of the inventor.

If the jury believe the evidence in the present case, it seems quite decisive. But of that they will judge.

Verdict for defendant.

WATSON v. BLADEN.

[4 Wash. 580. April T. 1826.]

Using a machine with a view to an experiment to test its value, is a using within the sixth section of the Patent Act.

A patent which covers the discovery of another that had been in use, is too broad; and therefore void.

THIS was an action for the infringement of a patent granted to E. Treadwell, for an improvement in forming and piercing bread, called by him "a cracker or biscuit finisher." The specification describes the different parts of the machine, amongst which are the circular cutters, the piercers, and the clearers, which cut, pierce, and clear the biscuit at one operation. The plaintiff claims, as assignee of Treadwell, all his right and title to the said invention, so far as the same applies to the city and county of Philadelphia, and to all other cities and towns on the river Delaware, from Chester to Easton, and to Wilmington and Newcastle. Plea, the general issue, without notice of special matter.

The plaintiff proved that the defendant used a machine precisely the same in principle with the one for which he

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had obtained his patent, and that the invention was highly useful.

The defendant, under his notice, gave evidence to show that the plaintiff prepared a drawing of the machine which he contemplated having made, and employed one Tobias Martin, an ingenious and * skilful mechanic, [* 581] to construct it. This person, whose deposition was read, deposed that, after making a model according to the description given by Treadwell, it was found not to answer the intended purpose. That he suggested to Treadwell many improvements and alterations, which, being adopted, rendered the machine effectual. He does not, however, state, with any degree of precision, what were the particular parts which were embodied in the machine in consequence of his suggestions, but he states that he considers himself as being the original inventor, although he knew of Treadwell's intention to take out a patent, and made no objection.

The defendant also produced in Court a machine, constructed by one Peter Christian, many years prior to Treadwell's patent and invention, for cutting, piercing, and clearing the biscuit at one operation, which all the witnesses skilled in the art declared was in no respect different in principle from Treadwell's ; although, being designed to be used by hand, whereas the plaintiff's was fixed in a frame and worked by a lever power, it was not preferable to the old mode of making biscuit by hand, and was in fact of little or no value. It was further proved that biscuit was made with this machine in Christian's public bakery, to the extent of perhaps half a barrel of flour. This was done for an experiment. It was found not to answer as well as was expected, and was thrown aside.

The ground principally relied upon by the plaintiff's counsel to get clear of Christian's discovery, was, that this machine was never used except for an experiment, which is not the

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kind of use meant by the sixth section of the Patent Law. He cited the case of *Bolton v. Bull*, 2 H. Black. 470; *Bedford v. Hunt*, 1 Mass. 302; 3 Wheat. 481, 514; 1 Holt's N. P. Rep. 58; 3 Inst. 184.

The defendant insisted that the patent was void, 1. Because it covers Martin's discoveries, in part, at least. *Sterns v. Barret*, 1 Mass. 153. 2. It is not a new invention; Christian's having been discovered and used, anterior to Treadwell's discovery. 1 Gal. 438; *Peters's C. C. R.* 394. And lastly, because it is too broad, by including all the essential parts of Christian's machine.

WASHINGTON, J. There are three objections made by the defendant's counsel to Treadwell's invention, either of which is sufficient to entitle the defendant to a verdict, if the facts are found by the jury to be in his favor. The first is, that Treadwell was not the inventor of the machine patented, or of the whole of its essential parts. If he was, then, secondly, that he was not the original inventor. And lastly, that the patent includes all the essential parts of Christian's machine, and not merely an improvement of that machine.

1. Treadwell is asserted not to be the inventor of the whole of the machine for which he has obtained a patent; because it is proved by Martin, that some, at least, of the essential parts of it were discovered by him, and were introduced into it upon his suggestions.

[* 582] *The deposition of this witness is certainly very obscure in designating those parts of the machine of which he asserts himself to have been the inventor, and it is therefore to be regretted that his attendance here for the purpose of being examined before the jury could not have been obtained. It is all important to ascertain what those parts were, and this the jury must endeavor to do upon an attentive perusal of his deposition after their retirement. All

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that remains for me to do is to lay down a few general rules for their government.

If they should be satisfied that the whole, or any of the essential parts and principles of the machine were invented by Martin, and introduced into the machine upon his suggestion, the whole patent is void. But if this does not appear, or if they should be satisfied from the testimony of the man, that he merely suggested some alterations in the form or proportions of the machine, as designed by Treadwell, this will not be sufficient to deprive Treadwell of the merit of the invention, or affect the validity of his patent; nor would it be, as to such alterations, a discovery which would entitle Martin to take out a patent for them. If a contrary doctrine were to be maintained, very few, if any patents, could be upheld, unless in those cases where the inventor is also the mechanic who constructs the machine. His genius may be equal to the task of conceiving all the principles, as well as the general structure and form of the machine. But he may be unacquainted with the use of tools, and be quite unable to anticipate in what manner the contemplated form of any particular part of the machine may affect its operation, until the work is in progress, and the materiality of form can then be practically discerned. That some alteration of the contemplated form or proportions should be found necessary, would be, in most instances, to be expected; and who so likely to perceive the necessity of it, and to suggest it, as the workman who is engaged in constructing the machine? But if such suggestions are sufficient to invalidate the patent, few patents would stand the test of such a principle. This point was decided by this Court at the last term in the case of *Pennock and Sellers v. Dialogue*, and was not objected to that I know of.

2. The next objection to the patent is, that Treadwell was not the original inventor of this machine, but that it was invented and used by Peter Christian, anterior to the patent

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and discovery of Treadwell. That Christian's machine was invented many years prior to Treadwell's, is proved by uncontradicted testimony, and is not denied by the plaintiff's counsel. That it possesses all the essential parts and principles of Treadwell's machine, the cutters, piercers, and clearers, is manifest by comparing the two together; besides which, the fact is proved by all the witnesses. Used with no other than hand-power, it is proved, and admitted, not to answer the purpose of a labor-saving machine. But the same objection lies against Treadwell's machine, should the same [* 583] power be applied, * and that the inventor contemplated the application of that power, as well as the lever, as now used, is expressly stated in the specification. The plaintiff's counsel has pronounced Christian's machine to be positively worthless. I can only observe that this censure would be very unbecoming in Treadwell, who has incorporated all its essential parts into the machine for which he has obtained a patent.

But the point mainly relied upon by the plaintiff's counsel is, that no evidence is given that Christian's machine was ever *used* within the true meaning of that expression in the Patent Act. It is admitted that an experiment was made with it, but this, it is argued, was not such a using as the act intends. It surely cannot be denied that the act of making crackers with it amounted to a using of it according to the common and accepted meaning of that phrase; and I am quite at a loss to imagine how this meaning can be varied by the particular motive which induced the inventor so to employ the machine. I can discover nothing in the Patent Act which will authorize the Court to depart from the ordinary meaning of this expression, and to declare that a machine which is put into operation for the sole purpose (if such be the case) of trying its practical utility, is not used within the meaning and intent of the sixth section of that act.

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The plaintiff's counsel relied in some measure upon certain expressions of the judges in the two cases of *Bolton v. Bull*, 2 H. Blac., and *Bedford v. Hunt*, 1 Mass. But so far as any satisfactory inference can be drawn from those expressions, in its application to the particular point under consideration; it strikes me to be unfavorable to the construction contended for. They manifestly contrast the confining of the invention to *the closet* of the inventor and a mere *speculative invention*, with putting it into use, practice, or operation; and not the putting of it in practice for the purpose of an experiment, with any other purpose whatever. Upon the whole, I am of opinion, that the experiment of this machine made by Christian, in the year 1807, amounted to a using of it within the true meaning of the sixth section of the Patent Act.

3. If Christian's machine was invented and used prior to the discovery of Treadwell, then his patent is void, because it covers all the essential parts of Christian's machine, without which it could not operate at all to produce the intended result. The rule of law, that where the patent embraces the discovery of another person, it is void, is too well established to be now controverted; nor was it controverted by the plaintiff's counsel, who candidly admitted, that if Christian's machine was used, he could not maintain the validity of Treadwell's patent.

The jury found a verdict without leaving the room, and the plaintiff suffered a nonsuit.

C. J. Ingersoll, for plaintiff.

M Ilvaine, for defendant.

Ogle et al. v. Ege. 4 Wash.

OGLE AND WITHERO v. EGE.

[4 Wash. 584. April T. 1826.]

Quære, Whether an assignee of part of a patent to be made, sold, or used within a particular district, can maintain a suit at law? But he may in equity. Cases in which, and terms on which injunctions in cases of alleged infringements of patent-rights, are granted.

THE plaintiffs filed their bill on the equity side of the Court, setting forth that the plaintiff Ogle is the original inventor of a new and useful improvement in the plough, for which he obtained a patent in the year 1818. That in the year 1824, he, by deed, and for a valuable consideration, assigned and conveyed to the other plaintiff all his exclusive right to the said invention, with the liberty of making, constructing, using, and vending the same to others to be used, in and throughout the State of Pennsylvania, with a power of attorney for those purposes. That the defendant has, since the date of the said patent, and also of the said assignment within the State of Pennsylvania, constructed, and used ploughs with the improvement so patented, and is still employed in making and using the same. The bill prays an injunction, which was granted at a former session of this Court until answer or further order.

The defendant, without having put in an answer, now moved to dissolve the injunction for the following reasons. 1. Because a patent cannot be partially assigned, so as to enable the assignee to bring an action in his own name. *Tyler v. Tuel*, 6 Cranch, 334; *Whittemore v. Cutter*, 1 Gal. 429. 2 Because the bill does not charge the possession of the invention by the plaintiffs, 1 Mad. C. P. 137. On the other side were cited, *Godson*, 160, 177; 2 Mad. 177; 1 Ves. 476.

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WASHINGTON, J. As to the first ground for dissolving the injunction, I shall content myself with observing, that whether an assignee of part of a patent, circumscribed as to the interest by local limits, can maintain a suit at law in his own name, or united with the patentee or not, (a question unnecessary to be decided in this case ;) there can exist no doubt but that he may support a suit in equity to enjoin third persons from infringing the patent, and for an account.

2. I take the rule to be, in cases of injunctions in patent cases, that where the bill states a clear right to the thing patented, which, together with the alleged infringement, is verified by affidavit ; if he has been in possession of it by having used or sold it in part, or in the whole, the Court will grant an injunction, and continue it till the hearing or further order, without sending the plaintiff to law to try his right. But if there appear to be a reasonable doubt as to the * plaintiff's right, or to the validity of the patent, [*585] the Court will require the plaintiff to try his title at law ; sometimes accompanied with an order to expedite the trial ; and will permit him to return for an account in case the trial at law should be in his favor. *Hill v. Thompson*, cited in *Eden*, 260, 261, 262 ; 14 *Ves.* 132 ; 3 *Meriv.* 624, 628 ; *Coop. Eq. Prac.* 158 ; 6 *Ves.* 707 ; 1 *Mad. C. P.* 113 ; 14 *Ves.* 130 ; *Amb.* 406 ; 1 *Vern.* 120 ; 2 *Mad.* 175 ; 3 *Atk.* 496 ; 3 *Bro. C. C.* 376. Now in this case, the patent was granted in 1818, and is on its face free from all exception. Six years after the issuing of the patent, the patentee, for the consideration of \$700 paid to him, sold and assigned to his co-plaintiff his right and title to the same within the State of Pennsylvania. This is therefore a strong case for retaining the injunction until the answer, or until the invalidity of the patent, or the want of title in the plaintiffs, is established at law. Motion overruled, with costs.

C. J. Ingersoll, for defendant ; *Read*, for plaintiffs.

Davis v. Palmer; Same v. M'Cormick. 2 Brock.

DAVIS v. PALMER and THE SAME v. M'CORMICK.

[2 Brockenbrough, 298. May T. 1827.]

Before Hon. JOHN MARSHALL, Chief Justice of the United States.
Hon. GEORGE HAY, District Judge.

An inventor obtained a patent for certain improvements made in the construction of the plough, and brought suit for an alleged violation of his patent-rights. In the description of those improvements which is annexed to, and made a part of the patent, after reference to the imperfections of the mould-boards formerly in use, the specification proceeds: "In order to meet and remedy the inconveniences arising from this form of structure, I form my mould-board into a different shape, and instead of working the moulding part or face of the mould-board to *straight lines*, my improvement is to work it to *circular or spheric lines*. By repeated experiments, I have ascertained that in one direction, namely: from *a*, fig. 4, (the point of the share) inclining to the back part of the mould-board, the circle or segment to which the mould-board is wrought, should have *about* three times the radius of the smaller segments, represented by the letters *c*, *c*, & *c*, the former being about thirty-six inches, the latter twelve." After a detailed description of the [* 299] * new mould-board, the specification proceeds: "This being thus worked off, uniformly forms a *section of a loxodromic or spiral curve*, and when applied to practice, is found to fit or embrace every part of the furrow-slice far more than any other shaped plough, &c." *Held*:

1. That this patent must be construed, not as extending to all mould-boards whose faces are *worked to circular or spheric lines*, forming a *segment of a loxodromic or spiral curve*, (which general description would apply to mould-boards already in use, and under that construction the patent would, consequently, be void,) but as applying only to mould-boards whose faces are worked upon transverse circular lines, whose radii are in the *exact* proportion of thirty-six to twelve. The word "*about*" must be rejected for uncertainty.
2. That it is the province of the Court to construe the patent and determine what improvements are intended to be patented, and of the jury to decide whether those improvements are described in the patent with sufficient clearness to enable a skilful mechanic to construct a machine thereby. In deciding this question, the jury should give a liberal common sense construction to the directions contained in the specification.

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3. That so much of the patent as relates to the face of the mould-board, is not violated, unless the same circular lines are adopted as are described in the specification, but if the imitation be so nearly exact as to satisfy the jury that the imitator intended to copy the model, and to make some almost imperceptible variation for the purpose of evading the right of the patentee, this may be considered as a fraud on the law, and such slight variation be disregarded.
4. That a particular description of the mould-boards formerly in use, is not necessary to give validity to the patent ; a reference to them in general terms, which are not untrue, or a reference to a particular mould-board generally known, accompanied by such an intelligible description of what is new, as will enable a workman to distinguish it from the old, is sufficient.
5. That although the Act of Congress declares, "that *simply* changing the form or proportion of any machine, shall not be deemed a discovery," yet, when the change of form or proportion produces a new effect, of which the jury must judge, it is not *simply* a change of form or proportion, and does not come within the inhibition of the statute.

THE plaintiff, Gideon Davis, brought his several actions on the case against the defendants, to recover treble damages under the statute, for an alleged violation of the plaintiff's patent-rights, as the inventor of certain new and valuable improvements in the plough.¹ The declarations, which are identical, * contained various counts. [* 300] The first count charged the defendants with having *made and sold* divers improved ploughs *upon the said improved plan, and in imitation of the said invention* of the plaintiff.

The second count charged, that the defendants had *made and sold* divers ploughs, *partly* upon the said improved plan, and *partly* in imitation thereof.

The third count charged, that the defendants *did counter-*

¹ See the Act of Congress "to extend the privilege of obtaining patents, and to enlarge and define the penalties for violating the rights of patentees," sec. 8, passed 17th of April, 1800. Story's Laws U. S., Vol. I. p. 753. See Appendix to Vol. II. *post*.

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six inches radius, (fig. 1,) and at twenty-four inches back from the point to *b*, at right angles with the land-side, this circle will intersect the angle line. This circle is extended out from the land-side. Then I work the block to fit the same segment inclined from *a*, (fig. 4,) at the point of the share to *a*, at a perpendicular raised twelve inches from the horizon, with the circle extended in towards the land-side. Then, having wrought the shape of these two lines, I apply the circular part of the smaller segment, (fig. 2,) and work the face of the mould-board until that segment will have an equal bearing on all parts, corresponding with the cross-lines *c, c, c, &c.*, which, if produced, would all terminate at a point at *d*, which is about thirty-six inches from the perpendicular where the line *a, a*, crosses the line *d, b*. This being thus worked off, uniformly forms a section of a loxodromic, or spiral curve, and when applied to practice, is found to fit or embrace every part of the furrow-slice, far more than any other shaped plough. The plough may be made larger or smaller, suited to deep or shallow ploughing, by enlarging or diminishing the radii of the segments which it is wrought by.

“Believing that this mode of shaping the moulding part, or face of the mould-board is an original invention of my own, not heretofore used or known, and that it is a most important improvement in the shape of the plough, I claim the exclusive privilege of making, using, and vending the same.”

The defendants pleaded “not guilty,” and on the trial, moved the Court to give the jury a series of instructions, which are stated and discussed in the following opinion.

MARSHALL, C. J. These suits are brought by the plaintiff, to recover damages for the alleged violation of his patent, for an improvement on the plough. His improvement is, in part, made on the face, throat, and hind part of the mould-board. The counsel for the defendants have moved the Court,

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1. To declare the patent void, because the specification, so far as it regards the improvements [* 303] in the mould-board, does not describe this part of the improvement with the certainty required by the Act of Congress.¹

Should the patent be submitted to the jury, they then move that it be accompanied with the following instructions :

1. That so much of the patent as respects the face of the mould-board is not violated, unless the defendants have adopted the same spheric lines as are described in the plaintiff's specification.

2. That the jury must be satisfied that the former mould-board is described with sufficient certainty, to distinguish between it and the improvement claimed.

3. If the jury shall be satisfied that M'Cormick has made and used mould-boards, worked out by transverse and concave circular lines, before the plaintiff obtained his patent, or made his alleged improvement, then the particular spheric lines described in his specification constitute only a change of form and proportion, and is not an invention capable of being patented.

In the course of the argument, the counsel have also contended that the same uncertainty exists in that part of the specification which describes the throat and hind part of the mould-board, as in that which describes its face.

1. We will first consider the proposition, that the patent is void for uncertainty.

It is, undoubtedly, the province of the Court to construe every written instrument offered in evidence ; and it results from this duty, that if the instrument be so uncertain in its terms as to have no meaning ; if it be insensible, or have no

¹ See Act of Feb. 21, 1793, Story's Laws U. S. Vol. I. p. 301 ; sec. 3. See Appendix to Vol. II. *post*.

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application to the case, it may be rejected. Is the patent, on which the present actions are founded, of this description ?

The specification, No. 1, relates to the face of the mould-board. It consists, first, of a general, and then of a more particular description of this part of the improvement. The defendants contend that these descriptions are uncertain in themselves, and that there is also a fatal uncertainty [* 304] which of * them describes the improvement for which the plaintiff claims his patent.

The plaintiff, after a general description of the mould-board then in use, and the inconveniences arising from its form, proceeds thus : — “ In order to meet and remedy the inconveniences arising from this form of structure, I form my mould-board into a different shape, and, instead of working the moulding part, or face of the mould-board to straight lines, my improvement is to work it to circular or spheric lines.” The specification then proceeds to a more particular description of the lines used, and of the manner in which they are applied, in order to form the face of the mould-board.

The counsel for the plaintiff seem disposed to consider this general description, as constituting the essential part of the specification, and the subsequent more particular description, as merely an illustration of the general principle, as one mode of carrying it into execution.

If the specification will admit of this construction, then the subsequent and particular description may be expunged without affecting the patent. A principle remains the same, whether it be accompanied by any case put for illustration or not. It may be comprehended more easily, but is not varied by the illustration.

If we consider this general part of the specification as standing alone, and as describing this part of the improvement, it is not liable to the charge of uncertainty. It claims,

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as an improvement, "to work it (the mould-board) by circular or spheric lines." Every mould-board worked by circular or spheric lines, however those lines may cross each other, and whatever may be their relative proportions, is within the plaintiff's patent. If the face of no mould-board previously in use will fit this description, the plaintiff's patent may, perhaps, legally cover the broad ground it would occupy. But if any mould-board previously in use would fit this description, then the plaintiff would claim, as his invention, that which was previously known, and his patent would be void.

* But we do not think the specification will ad- [* 305] mit of this construction. It proceeds to say, "By repeated experiments I have ascertained, that in one direction, namely, from *a*, fig. 4," (which is the point of the share) "inclining to the back part of the mould-board, the circle or segment to which the mould-board is wrought, should have about three times the radius of the smaller segments represented by the letters *c*, *c*, &c., the former being about thirty-six inches, the latter twelve." This is intended for a plough which will turn a furrow-slice of twelve inches. The specification then proceeds to detail minutely the mode of operation by which these lines are to be applied, in order to give the face of the mould-board the required shape, and says: "The plough may be made larger or smaller, suited to deep or shallow ploughing, by enlarging or diminishing the radii of the segments which it is wrought by."

"Believing," the specification adds, "that this mode of shaping the moulding part, or face of the mould-board, is an original invention of my own, not heretofore used or known, and that it is a most important improvement in the shape of the plough, I claim the exclusive privilege of making, using, and vending the same."

This claim applies conclusively, we think, to the particular

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and labored description of the mould-board which immediately precedes it. The language seems to us to require this construction; and the subject seems also to require it. If the patent were to extend to all mould-boards worked out to circular lines, crossing each other in any direction, or in any proportion, it would be unnecessary to describe with so much labor and minuteness, the direction of the longitudinal and perpendicular circular lines, by which the face of the mould-board should be worked out, and the proportions those lines should bear to each other, and the size of the plough. It is obvious, then, that the person who makes his improvement to consist in the peculiar shape given to the face of his mould-board, and who describes the lines and their several proportions, which will give that peculiar shape, must mean to appropriate the shape produced by the application [* 306] of those new lines. We are then decidedly of opinion, that a mould-board conforming to the particular description contained in the specification, is the invention which the plaintiff claims, and that instead of being a mere illustration of the principle stated in the introductory part of the specification, it is itself the essential improvement, of which only a general idea was given in the introductory part.

It is contended on the part of the plaintiff that, if the patent be limited to the more particular part of the specification, still the claim is not confined to mould-boards worked out by segments of circles of the exact form and proportions mentioned in the specification. To support this argument, counsel rely on the word "about," which is introduced into the description; he has found Mr. Davis says, by repeated experiments, that the segment of the larger circle should have about three times the radius of the smaller segments, &c. The claim, therefore, is not for a mould-board of the precise shape described, but for one "about" the shape described.

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It will at once be perceived, that unless the extent of this word "about," be limited, it introduces all the uncertainty which it was supposed would be fatal to the patent, according to the general description contained in the introductory part of the specification. If, instead of thirty-six inches and twelve, the proportions may be thirty-seven and eleven, thirty-eight and ten, why not forty and eight, or thirty-five and fifteen? The proportions may be enlarged or diminished, and with every change of proportion, the shape of the mould-board will be changed. If this be the construction of the patent, then it covers all the various forms of mould-boards which may be made under this latitudinous exposition of its terms; and if any mould-board has been previously used, whose face may be formed by transverse segments of circles, whose radii bear to each other "about" the proportion of thirty-six to twelve, the patent is void.

Will it be said that it may be left to the jury to determine what is "about" the proportion particularly designated? This *expedient will not remove the diffi- [* 307] culty. We doubt how far it may consist with the principle that the Court is to construe every written instrument. But, waiving this doubt, if the word has any limits, they must be always the same. When applied to a mould-board, it cannot be endowed with an elastic principle, to expand or contract itself according to circumstances. It cannot admit of being varied to a certain extent, if no mould-board has been in use of the shape which that degree of variation would produce, and at the same time of being restricted, if a mould-board of such a shape has been in use. The word "about," cannot be equivalent to a general claim of the exclusive right to all concave mould-boards, varying in any degree from those previously in use. The definiteness of the shape, which the specification professes to give to the mould-board, cannot be sacrificed by this loose word. It is

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further observable, that where the specification describes the process of the workman, it drops the word "about."

It has been supposed that the precise proportion required between the radii of the larger and smaller segments of circles, may be relaxed under the concluding part of the description. After giving the mode of operation, the specification adds:—"This being thus worked off, uniformly forms a section of a loxodromic or spiral curve, and when applied to practice, is found to fit or embrace every part of the furrow-slice, far more than any other shaped plough."

The argument is, that it is a mould-board whose face forms a section of a loxodromic or spiral curve that is patented, and that any lines which will give such a service, are within the specification, and consequently, within the patent.

Without noticing the difficulties growing out of this construction, it is sufficient to say, that the specification does not claim the loxodromic or spiral curve as the invention, but states it as the result of the prescribed application of the transverse circular lines, the application of which, in the relative proportions prescribed, is the invention. The language

of this part of the specification, tends to confirm, [* 308] we think, the opinion already * indicated, that the plaintiff intended to claim a mould-board of the precise and definite shape prescribed, not one about that shape. He says his mould-board, "so worked off," "when applied to practice, is found to fit or embrace every part of the furrow-slice, far more than any other shaped plough."

In construing this specification, we must keep in view the notice of the improvement which Mr. Davis claims to have invented, and to describe. It is an improvement in the shape of a machine which has been in common use a great number of years, and in a great variety of shapes. The concave mould-board has been long considered as the most eligible shape that part of the plough can assume, and multiplied

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essays have been made to perfect it. Mr. Davis has recently added to their number; he professes to have discovered that precise concavity in the service of the mould-board, which will, better than any other, fit every part of the furrow-slice, and, consequently, turn it over with less labor. For this discovery he claims a patent; we may reasonably expect, that a specification for such a patent, will give a precise and definite shape to the improvement to be patented.

We are then decidedly of opinion, that in construing this specification, the word "about" must be disregarded, and the patent be restricted to the mould-board as described, independent of that word.

If we consider the particular part of the specification as describing the object to be patented, the defendants insist that the description given in that part is not sufficiently clear to enable a skilful mechanic to construct the machine.

It may not, perhaps, be easy to draw a precise line of distinction between a specification so uncertain, as to claim no particular improvement, and a specification so uncertain as not to enable a skilful workman to understand the improvement, and to construct it. Yet, we think, the distinction exists. If it does, it is within the province of the jury to decide, whether a skilful workman can carry into execution the plan of the inventor. In *deciding [* 309] this question, the jury will give a liberal, common-sense construction to the directions contained in the specification.¹

If the patent be submitted to the jury, the defendants request the Court to give the several instructions which have been already mentioned.

¹ See the able opinions of Mr. Justice Story, in *Ames v. Howard et al.*, reported in 1 Sumner's Rep. 482, and of Mr. Justice Baldwin, in *Whitney et al. v. Emmett et al.* 1 Baldwin's Rep. 303, *post*.

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1. The first is, that so much of the patent as relates to the face of the mould-board is not violated, unless the defendants have adopted the same circular lines as are described in the specification.

This instruction will be given. But it may perhaps be understood with some slight modification. The patent, undoubtedly, covers only the improvement precisely described. But if the imitation be so nearly exact as to satisfy the jury that the imitator attempted to copy the model, and to make some almost imperceptible variation, for the purpose of evading the right of the patentee, this may be considered as a fraud on the law, and such slight variation be disregarded.

2. The second instruction is, that the jury must be satisfied that the former mould-board is described with sufficient certainty, to distinguish between it and the improvement claimed.

We do not think a particular description of the former mould-board is necessary. A general reference to it, either in general terms which are not untrue, or by reference to a particular mould-board, commonly known, accompanied by such a description of the improvement as will enable a workman to distinguish what is new, will be sufficient.

3. The Court is also requested to instruct the jury that, if M'Cormick has made and used mould-boards, worked out by transverse circular lines, so as to produce a concave surface, before the plaintiff obtained his patent, or made his alleged improvement, then the particular lines described in his specification, constitute only a change of form and proportion, not an invention capable of being patented.

[* 310] * It is stated on both sides, that the clause in the statute, to which this instruction refers, is one of considerable doubt. It is in these words: "And it is hereby enacted and declared, that simply changing the form or the

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proportion of any machine, shall not be deemed a discovery.”¹

In construing this provision, the word “simply,” has, we think, great influence. It is not every change of form and proportion which is declared to be no discovery, but that which is *simply* a change of form or proportion, and nothing more. If, by changing the form and proportion, a new effect is produced, there is not simply a change of form and proportion, but a change of principle also.

In every case, therefore, the question must be submitted to the jury, whether the change of form and proportion has produced a different effect.

With respect to the throat and hind part of the mould-board, the Court need only say, that the description of the specification is general, not giving the particular shape of those parts of the mould-board. If either the throat or hind part of a mould-board, was in use before, which answers the description contained in this specification, then the plaintiff has patented what belonged to the public, and his patent is void.

NOTE. After the opinion of the Court was delivered, both suits were dismissed agreed ; each party paying his own costs.

TREADWELL AND WATSON v. BLADEN.

[4 Wash. 703. October T. 1827.]

Action for the infringement of a patent-right. To prove that the plaintiff was not the original inventor, the defendant gave in evidence a prior patent to A,

¹ Act, 1793, before referred to. Story's Laws U. S. Vol. I. p. 301, sec. 2. Appendix to Vol. II.

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for a machine alleged to have been the same in principle with the plaintiff's, and his assignment of the same to the defendant, and offered A as a witness to prove the priority of the invention. A is a competent witness, having no interest in the event of the suit.

If the defendant's notice of special matter states that the thing patented was known and used by A, B, C, and others, prior to the plaintiff's discovery, the defendant must prove its use by others than those named.

Proof by a witness that he had seen an article which might have been made by a machine similar to that for which the plaintiff afterwards obtained his patent, or in some other way, is not sufficient to deprive the plaintiff of his claim to be the original inventor; unless the jury should be satisfied from the evidence that the article was made by a machine similar to it in principle.

What constitutes the form, and what the principle of a machine?

It is the use, and not the *intention*, of an inventor to use an improvement, to be found in the plaintiff's machine, that can invalidate the plaintiff's patent under the sixth section of the Patent Act.

To invalidate the plaintiff's patent, it is not sufficient to show that the thing patented was used prior to the plaintiff's *application* for his patent; but it should be shown that it was prior to his *discovery*.

What amounts to an abandonment of his invention by an inventor, so as to invalidate his patent.

A person cannot have two subsisting valid patents for the same thing at the same time. But if he has obtained a patent, which he afterwards finds to be too broad, by having included in it the discovery of another, he may obtain a second valid patent for such parts of the machine as were discovered by him, and not by another.

Quære, Whether a disclaimer in the specification annexed to the grand patent of those parts, which were not the invention of the patentee, is sufficient to remove the objection to the patent?

[* 704] * THIS was an action on the case for an infringement of a patent granted to Edward Treadwell on the 18th of May, 1826, for an improvement in the art of manufacturing biscuit and sugar bread. The schedule describes the whole instrument, namely, the circular knives, dotters, clearers, the holes and the niches for connecting the cakes and clearing away the loose dough, as in the former patent. But it disclaims the piercers or dotters, as used in the well-known dotter used by hand, and declares that the patentee does not claim as his improvement either the circular knives, the dischargers, or

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clearers, or the use of the knives to cut, the piercers to prick, nor the clearers to discharge the biscuit, these having been long known and occasionally used by many persons. "What he claims is, his improvement in this machine for saving labor are, the contrivance specified for attaching and keeping the biscuit in clusters, particularly the small cuts, niches, or places filed away for attaching the biscuits, and the holes for the passage of the dough through the plate, and the circular connection of the cluster of seven knives in this new combination to save labor." On the 23d of May, 1826, Edward Treadwell, in consideration of \$700, assigned to Elizabeth Watson, the patent-right, so far as the same applies to the city and county of Philadelphia, and all other towns and villages bordering on the River Delaware from Easton to Newcastle, inclusive.

The plaintiff gave evidence to prove that the defendant used a machine for making biscuit and sugar bread, with the improvement mentioned in the specification to Treadwell's patent, and claimed by him, and that the improvement was new and useful. He also gave some evidence of the value of the use this improvement.

The defendant having pleaded the general issue, gave notice of special matter of defence, that Edward Treadwell was not the original inventor; but that the improvement claimed by the plaintiff had been in use, prior to the application of Treadwell, by J. Siddons, Peter Christian, and Daniel Poole; and, generally, it had been used before the application of Treadwell.

The defendant having given in evidence a patent to Daniel Poole for the machine used by the defendant, dated the 24th of December, 1824, and his assignment of the same for a valuable consideration to the defendant on the 25th of February, 1825, offered Poole as a witness to prove the priority of his invention.

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An objection to his competency was made, but overruled by the Court.

WASHINGTON, J. The witness can have no interest in *the event of this suit*, as the verdict could not be given in evidence, should the plaintiffs obtain it, in any action which the defendant might bring against him, for the purchase-money, or for damages. What interest he has, is in *the question* merely, and even that is remote. Whatever objection can be raised can go only to his credit.

The witness was asked generally, if he knew that [* 705] this improvement * had been in use by any person prior to the application of Treadwell? This was objected to by the plaintiff's counsel, the notice having designated three persons by name who had so used it.

WASHINGTON, J. This objection was taken in the case of *Evans v. Eaton*; was overruled by this Court; and that decision was approved by the Supreme Court on a writ of error. The present objection must meet the same fate.

Poole proved that his invention was made about the 1st of January, 1824. That he had seen gingerbread at Boston, before the year 1819, connected together; but he knew not by what machine they were made, never having seen any, nor did he know that they were formed by a machine.

Christian gave the same evidence as he did at the former trial.

Siddons stated, that in July, 1820, he had a machine made with cutters, cleavers, and dotters, holes and niches, but he never used it. That he got his first idea of the machine from Edward Treadwell, whose machine was then in operation.

The plaintiff then gave evidence to prove that Edward Treadwell invented his machine prior to 1819, and that, in

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the latter part of that year, it was made and in use in this city.

Some contradictory evidence was given as to the use of the plaintiff's improvement, and as to its difference from Christian's machine both in principle or in form.

The following objections were made by the defendant's counsel to the validity of the plaintiff's patent :

1. That the first patent of Treadwell, as well as the evidence in the cause, show that this improvement was known, and in use, before the application for the present patent.

2. That a party cannot have, at the same time, two valid patents for the same thing. The first patent is yet in existence, which invalidates the second. *Morris v. Huntington*, 1 Paine's Rep. 348 ; 2 Mass. 30.

3. That the alleged improvement of Treadwell upon Christian's invention is not in principle, but in form only ; as Christian stated in his evidence that he had provided in his machine for the use of a wire which was to operate as a clearer of the loose cut dough ; which, if it had been used, would have produced the same effect as the holes in Treadwell's machine.

4. Treadwell was not the first inventor of the improvement which he has patented.

The plaintiff's counsel cited, on the first point made by the defendant's counsel, *Evans v. Weiss*, 2 Wash. C. C. Rep. 342 ; 1 Gall. 438 ; 1 Paine's Rep. 300, 348.

WASHINGTON, J. The plaintiffs have laid before you a patent, for the improvements of which they claim Edward Treadwell to be the original inventor, and have given evidence to prove * the improvement to be [* 706] useful, and that Treadwell was the original inventor of it. If they have succeeded in satisfying you of these facts, they are entitled to a verdict ; unless the objections relied

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upon by the defendant's counsel, or some one of them, should be well founded.

As to the fact of original inventions, it must depend upon the evidence, of which you are exclusively the judges. The only evidence, relied upon by the defendant to disprove the claim of Treadwell to this discovery, is that given by Poole, who states that, in the year 1819, he saw ginger cakes in clusters and connected together to the number of six or seven ; but he admits that he had no knowledge how they were made, whether with a machine or by hand.

The legal ground of this defence is, that the improvement claimed and patented by Treadwell, was not originally discovered by him, but had been in use prior to the alleged discovery by him. This improvement, as you perceive by the machine before you, consists in what is termed, in the specification, niches, or contrivances for attaching the biscuits in clusters, and the holes for the passage of the surplus dough through the plate. Now, if the ginger cakes spoken of by the witness were made by hand with a cup, or in a very different principle from that stated in Treadwell's specification, it cannot be legally affirmed that the improvement claimed by the plaintiffs had been in use prior to the alleged discovery of Treadwell. It is for you to say, whether, from the appearance of those ginger cakes, you can safely conclude that they were made by an instrument having the improvement for which this patent was granted? As to the machines discovered by Christian, Poole, and Siddons, they most obviously do not interfere with the improvement of Treadwell. The contrivance to connect the biscuit, and the holes to vent the surplus dough are not in Christian's machine ; and those made by Poole and Siddons were not earlier than 1824, about five years posterior to the discovery and use by Treadwell.

The next objection raised against the discovery of Tread-

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well is, that what he calls an improvement upon Christian's machine, is in form only, and not in principle.

What constitutes form, and what principle, is often a nice question to decide ; and upon none, are the witnesses who are examined in patent causes, even those who are skilled in the particular art, more apt to disagree.

It seems to me that the safest guide to accuracy in making the distinction is, first to ascertain what is the result to be obtained by the discovery ; and whatever is essential to that object, independent of the mere form and proportions of the thing used for the purpose, may generally, if not universally, be considered as the principles of the invention. What, for example, is the object of Treadwell's improvement upon Christian's machine ? The answer is, to render the operation of that machine more expeditious in the making of biscuit, by uniting the cakes, so that seven of them may be removed * from the place where they are, and with [* 707] the same labor which would be required to remove a single one ; and by enabling the operator, with greater facility, to extricate the machine from the loose dough. These results are produced by two contrivances not to be found in Christian's machine, and which constitute the principles of Treadwell's improvement.

But it is contended that, as Christian contemplated using wires in his machine, the operation of which would be to clear away the loose dough, the holes in Treadwell's machine differ in form only from the wires before spoken of. The answer to this is, that the wires were never attached to Christian's machine, and were never used with it ; and, consequently, the objection has no foundation in the sixth section of the Patent Law.

It is, in the third place, objected to the validity of Treadwell's patent, that his improvement was known, and in use, prior to his application for a patent ; it was used by Watson,

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and by the defendant for some years prior to May, 1826. If there be any solidity in this argument, the Patent Law would very nearly become a dead letter ; as every inventor uses the machine he invents before he applies for a patent, with a view to satisfy himself whether it answers the purpose for which it was intended.

But it is probable that the counsel did not intend to direct their objection to this kind of use ; but to a general use of it, for some length of time, by the inventor, or by others.

In this view of the question, it is certainly not without difficulty, and it was felt by this Court when the case of *Evans v. Weiss* was decided.

The difficulty is created by the first section of the Act of 1793, which authorizes the issuing of a patent to any citizen of the United States who shall allege himself to be the inventor of any new and useful art, machine, &c., *not known or used before the application*, &c. To construe those expressions, uninfluenced by other parts of the Patent Law, to mean the knowledge of, or use by the inventor himself, would, for the reason before mentioned, render the act a *felo de se* ; and even to extend those expressions to the knowledge of the third person surreptitiously obtained, and his consequent use of the invention, without the consent of the inventors, would be unreasonable and manifestly repugnant to the whole spirit and design of the patent system.

But whatever difficulty may arise out of the first section of the act, it is, I think, cleared away by other parts of the Acts of 1793 ; particularly by that clause of the sixth section which authorizes the defendant to give in evidence, under the general issue, that the thing patented was not originally discovered by the patentee, but had been in use or described in some public work anterior to the *supposed discovery* of the patentee. Here we find the expression "supposed discovery" substituted for "application" in the first section, and the word

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“known,” in that section, is altogether omitted in the sixth; * and, upon the whole, I take the true [* 708] construction of the act to be, that to invalidate the patent, the thing patented must have been used prior to the alleged *discovery*, and that is it not sufficient to show that it was so prior to *the application*. That was the opinion of this Court in the case of *Evans v. Weiss*, 2 Wash. C. C. Rep. 342, and the same opinion has been held in *Goodyear v. Mathews*, 1 Paine’s Rep. 300; *Morris v. Huntington*, 1 Paine’s Rep. 348; and by Mr. Justice Story, in the case cited from 1 Gall. 438.

I admit that great public and private inconvenience may result from this construction, (although not so great as that which the other circumstances would produce,) where an inventor postpones unreasonably the exercise of his privilege of taking out a patent; thus keeping all the world at arm’s length, so that no person can, in the mean time, safely construct, or use the thing invented, nor for fourteen years after the issuing of the patent, in case one should be taken out. But this is an inconvenience which it is competent for Congress alone to remove. If, before the patent is taken out, the inventor looks on, and sees his invention going into general use, without objection on his part, the Courts will treat his conduct as equivalent to an abandonment or transfer of his exclusive right to the public. And it is possible that, without such use by others, an unreasonable and causeless, or faulty delay, in taking out his patent, might be justly, and upon legal principles, considered as amounting to an abandonment; as to which, however, I avoid giving an opinion in this case, because it is unnecessary. For I hold it to be perfectly clear, that Treadwell is not chargeable with a causeless or faulty delay in securing the exclusive right to what he supposed to be his invention. He made the discovery some time in the

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year 1819, and during the latter part of that year, he put it into practical use, and on the 10th of January following, he obtained his patent, not only for the improvement secured by the last patent, but for those other parts of the machine of which he alleged, and, so far as the evidence has gone to warrant a contrary conclusion, we are bound to say, he supposed himself to be the original inventor. The appearance of Christian's machine, which, from the place where it had for many years been reposing, was brought to the bar of this Court upon a former trial between these parties, satisfied the patentee, as it did the Court and jury on that occasion, that Treadwell was not the original inventor of the cutters, the dotters, or the cleavers. This was the misfortune of the patentee, as well as of the plaintiff in that cause ; but it surely would be very harsh to conclude that it was the fault of Treadwell to include in his patent the invention of another person, so as to invalidate a patent.

Lastly, it is objected that the existence of the patent of January, 1820, at the time the patent of May, 1826, was obtained, invalidated the latter.

I entirely concur in the decisions in the cases cited [* 709] from 1 Paine, * 348, and 2 Mass. 30. The principle there decided is, that a person cannot have two subsisting valid patents at the same time, for the same invention. The question in this case then is, are the two patents to Treadwell for the same invention? I think most clearly that they are not. The first patent was for an improvement in the art of making crackers and sugar biscuit by the combined operation of a cutter, a cleaver, a dotter, and contrivances, (as they are called,) for connecting the cakes, and freeing the board from the loose dough.

The second patent is for an improvement on Christian's machine by adding to it the contrivances for connecting the

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cakes or biscuit, and for relieving the board or machine from the loose dough.

But it is insisted that the first patent, which was for the combined operation of those five parts, was necessarily a patent for all and each of the parts, and consequently for those two for which the last patent was granted. This argument was urged in the case of *Evans v. Eaton*, and was rejected by this Court, and that refutation was approved by the Supreme Court on a writ of error, so far as it was rested on the general Patent Law. The difference between that case and this is, that there the Court was confined to a private act for the relief of O. Evans, and upon that point, I freely acknowledge that this Court was mistaken.

These two patents can no more be said to be for the same invention, than the patent to O. Evans for the combined operation of the five instruments for which his patent was issued, and a patent for the hopper-boy, had one been granted, could be said to be for the same invention, had the private act been out of the question.

But even if these patents were substantially for the same invention, I should strongly incline to the opinion (without meaning, however, to give a positive decision on the point) that the disclaimer of all title under the first patent to the three material parts of the invention for which it was granted, would operate as an estoppel to any remedy which might be prosecuted for a violation of that patent; and if all remedy for a breach of that patent be defeated, can any right under it remain?

If, upon the whole, the jury be satisfied that the defendant has used the improvement for which the plaintiff has a patent, between the date of the patent and the institution of this suit; that the improvement is useful, and that Treadwell was the original inventor of it, the plaintiffs are entitled

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to a verdict. The amount of the damages is for the jury to assess.

Verdict for \$25 damages.

C. J. Ingersoll, for plaintiffs.

M Ilvaine and *Dallas*, for defendant.

ABRAHAM L. PENNOCK AND JAMES SELLERS, PLAINTIFFS IN
ERROR v. ADAM DIALOGUE.

[2 Peters, 1. January T. 1829.]

The record contains, embodied in the bill of exceptions, the whole of the testimony and evidence offered at the trial of the cause by each party in support of the issue. It is very voluminous, and as no exception was taken to its competency or sufficiency, either generally or for any particular purpose; it is not properly before the Court for consideration, and forms an expensive and unnecessary burden upon the record. This Court has had occasion, in many cases, to express its regret on account of irregular proceedings of this nature. There was not the slightest necessity of putting any portion of the evidence in this case upon the record; since the opinion of the Court, delivered to the jury, presented a general principle of law; and the application of the evidence to it was left to the jury. [15]

It is no ground of reversal, that the Court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party at the trial. It is sufficient for us, that the Court has given no erroneous directions. [16]

If either party considers any point presented by the evidence, omitted in the charge of the Court, it is competent for such party to require an opinion from the Court upon that point. The Court cannot be presumed to do more in ordinary cases, than to express its opinion upon questions, which the parties themselves have raised on the trial. [16]

It has not been, and indeed it cannot be denied, that an inventor may abandon * his invention, and surrender or dedicate it to the public.
[* 2] This inchoate right, thus gone, cannot afterwards be resumed at his pleasure; for when gifts are once made to the public in this way, they be-

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come absolute. The question which generally arises on trials is a question of fact, rather than of law; whether the acts or acquiescence of the party, furnish, in the given case, satisfactory proof of an abandonment, or dedication of the invention to the public. [16]

It is obvious, that many of the provisions of our Patent Act, are derived from the principles and practice which have prevailed in the construction of the law of England in relation to patents. [18]

Where English statutes, such for instance as the statute of frauds, and the statute of limitations, have been adopted into our own legislation; the known and settled construction of those statutes by Courts of law, has been considered as silently incorporated into the acts; or has been received with all the weight of authority. This is not the case with the English statute of monopolies, which contains an exception, on which the grants of patents for inventions have issued in that country. The language of that clause in the statute is not identical with the Patent Law of the United States; but the construction of it adopted by the English Courts, and the principles and practice which have long regulated the grants of their patents; as they must have been known, and are tacitly referred to in some of the provisions of our own statute, afford materials to illustrate it. [18]

The true meaning of the words of the Patent Law, "not known or used before the application;" is, not known or used *by the public*, before the application. [19]

If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should, for a long period of years, retain the monopoly, and make and sell his invention publicly; and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure; and then, and then only, when the danger of competition should force him to procure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any further use, than what should be derived under it, during his fourteen years; it would materially retard the progress of science and the useful arts; and give a premium to those who should be least prompt to communicate their discoveries. [19]

If an invention is used by the public, with the consent of the inventor, at the time of his application for a patent; how can the Court say, that his case is nevertheless such as the act was intended to protect? If such a public use is not a use within the meaning of the statute, how can the Court extract the case from its operation, and support a patent, when the suggestions of the patentee were not true; and the conditions, on which alone the grant was authorized, do not exist? [21]

The true construction of the Patent Law is, that the first inventor cannot acquire a good title to a patent, if he suffers the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent. This voluntary act, or acquiescence in the public sale or use, is an abandonment of his right; or rather, creates a disability to comply with the terms and conditions of the law; on which alone the Secretary of State is authorized to grant him a patent. [23]

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[* 3] * THIS case was brought before the Court, on a writ of error to the Circuit Court for the eastern district of Pennsylvania.

In that Court, the plaintiffs in error had instituted their suit against the defendants, for an infringement of a patent-right, for "an improvement in the art of making tubes or hose for conveying air, water, and other fluids." The invention claimed by the patentees, was in the mode of making the hose so that the parts so joined together would be tight, and as capable of resisting the pressure as any other part of the machine.

The bill of exceptions, which came up with the record, contained the whole evidence given in the trial of the cause in the Circuit Court. The invention, for which the patent-right was claimed, was completed in 1811; and the letters-patent were obtained in 1818. In this interval, upwards of *thirteen thousand feet of hose*, constructed according to the invention of the patentees, had been made and sold in the city of Philadelphia. One Samuel Jenkins, by the permission of, and under an agreement between the plaintiffs as to the price, had made and sold the hose invented by the plaintiffs, and supplied several hose companies in the city of Philadelphia with the same. Jenkins, during much of the time, was in the service of the plaintiffs, and had been instructed by them in the art of making the hose. There was no positive evidence, that the agreement between Jenkins and the plaintiffs in error was known to, or concealed from, the public. The plaintiffs, on the trial, did not allege or offer evidence to prove that they had delayed making application for a patent, for the purpose of improving their invention; or that from 1811 to 1818, any important modifications or alterations had been made in their riveted hose. The plaintiffs claimed before the jury, that all the hose which had been made and sold to the public, prior to their patent, had been constructed and vended by Jenkins under their permission.

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Upon the whole evidence in the case, the Circuit Court charged the jury :

* “ We are clearly of opinion that if an inventor [* 4] makes his discovery public, looks on and permits others freely to use it, without objection or assertion of claim to the invention, of which the public might take notice ; he abandons the inchoate right to the exclusive use of the invention, to which a patent would have entitled him, had it been applied for before such use. And we think it makes no difference in the principle, that the article so publicly used, and afterwards patented, was made by a particular individual, who did so by the private permission of the inventor. As long as an inventor keeps to himself the subject of his discovery, the public cannot be injured : and even if it be made public, but accompanied by an assertion of the inventor’s claim to the discovery, those who should make or use the subject of the invention would at least be put upon their guard. But if the public, with the knowledge and the tacit consent of the inventor, is permitted to use the invention without opposition, it is a fraud upon the public afterwards to take out a patent. It is possible that the inventor may not have intended to give the benefit of his discovery to the public ; and may have supposed that by giving permission to a particular individual to construct for others the thing patented, he could not be presumed to have done so. But it is not a question of intention, which is involved in the principle which we have laid down, but of legal inference, resulting from the conduct of the inventor, and affecting the interests of the public. It is for the jury to say, whether the evidence brings this case within the principle which has been stated. If it does, the Court is of opinion that the plaintiffs are not entitled to a verdict.”

To this charge the plaintiffs excepted, and the jury gave a verdict for the defendant.

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Mr. Webster, for the plaintiff in error, contended,

1. That the invention, being of such a nature that the use of it, for the purpose of trying its utility and bringing it to perfection, must necessarily be open and public; [* 5] the * implication of a waiver or abandonment of the right, furnished by such public use, is rebutted by the circumstance that the article was made and sold only by one individual; and that individual was authorized and permitted so to do by the inventors.

2. That the use of an invention, however public, if it be by the permission and under the continual exclusive claim of the inventor, does not take away his right, except after an unreasonable lapse of time, or gross negligence, in applying for a patent.

3. That the jury should have been instructed, that, if they found the riveted hose, which was in use by the hose companies, had been all made and sold by Jenkins, and by no one else, prior to the grant of the patent, and that he was permitted by the inventors, under their agreement, so to make and sell the same; that such use of the invention, not being adverse to their claim, did not take away their exclusive right, nor imply an abandonment of it to the public.

4. That, if they found the hose had not been made or sold, prior to the grant of the patent, by any person but Jenkins, then the giving of permission to him, being in itself an assertion of claim, was not a dedication to the public; and that the public, by purchasing and using the hose, thus made by the permission of the inventors, acquired no title to the invention; but, on the contrary, if the price, paid included a premium for the invention, the public, by so purchasing, admitted the right of the inventors.

5. That, at any rate, there being no use, *by the public*, of this invention, it should have been left to the jury, to say, whether, under all the circumstances, considering the nature

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of the invention, and the time necessary to perfect it, the plaintiffs have been guilty of negligence, in not sooner applying for a patent.

Mr. Webster stated, that the question to be decided by the Court laid within a narrow compass. The defence set up was, that the plaintiffs had suffered their invention to *be used before their application for a patent; [* 6] and had thus lost all right to the exclusive use of it.

The Court, in this case, would be called upon to reverse the English decision relative to abandonments; for it was admitted, that those cases had gone to the whole extent of the principles applied to this case in the Circuit Court. Those cases have decided, that any public use of an invention, even for experiment, renders it no longer a new machine. In the Courts of the United States, a more just view had been taken of the rights of inventors. The laws of the United States were intended to protect those rights, and to confer benefits; while the provisions in the statute of England, under which patents are issued, are exceptions to the law prohibiting monopolies. Hence, the construction of the British statute had been exceedingly strait and narrow, and different from the more liberal interpretation of our laws.

By the decisions of our Courts, there must be *a voluntary abandonment*, or *negligence*, or *unreasonable* delay in obtaining letters-patent, to destroy the right of the patentee. *Goodyear v. Mathews*, Paine's Rep. 300; *Morris v. Huntington*, Id. 348.

The exception to the charge of the Court is, that the jury should have been instructed to decide upon the evidence, whether the plaintiff meant to abandon his invention by the permission to Jenkins to use it. Jenkins must be considered as the private agent of the inventors; and their agreement with him, under which he made the hose, is to be considered rather as an assertion of their exclusive right to the invention

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than a surrender of it. By omitting to leave to the jury this question of an intention to abandon, the case was erroneously withdrawn from them. The rights of the parties also entitled them to have the causes of their delay in patenting their invention inquired of by the jury. As the case is presented on the bill of exceptions, the Court in their charge undertook to state the whole law of the subject-matter to the jury; and the omission to instruct them on any one point is error.

[* 7] *If, in this charge of the Court, any thing is omitted which was matter of law for the jury, it is misdirection.

In a case in Massachusetts, said to be reported in 4th Mason's Rep., it was left to the jury to decide whether seventeen years' delay could be accounted for.

Under the provisions of the laws of the United States, the right is created by the *invention*, and not by the *patent*. The Court, therefore, may have misled the jury, in stating that the plaintiffs allowed the invention to be used. The *thing invented* was only permitted to be used.

The suggestion, that by adopting the language of the English statute, the cases decided in England upon that statute are adopted, may be answered by a reference to those cases. They have all arisen within a few years, since the enactment of our law; and, except the dictum of Lord Coke in 2d Institute, the authorities are all of modern date.

If this Court shall be of opinion, that as no instructions were particularly asked upon the questions raised here, the Court below were not bound to notice them in the charge, and that the Court did not undertake to decide the whole law; the plaintiff in error can make out no case here. But if this Court shall consider the questions now submitted, doubtful, as the rights of the plaintiffs may not have been fully investigated, by sending the case back to the Circuit

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Court, a more full investigation of all the points involved in it may be made.

Mr. Sargeant, for the defendant, insisted,

1. That mere invention gives no right to an exclusive use, unless a patent is obtained ; and that if at a time when no right is infringed, the public fairly acquire possession of it, the inventor cannot, by subsequently obtaining a patent, take it away.

2. That the inventor, by abstaining from getting a patent, encouraged the public to use the article freely, and thus benefited his own manufactory. And he is not at liberty, when this advantage is exhausted, to turn round, and * endeavor to reach another and a different [* 8] kind of advantage, by appropriating the use exclusively to himself.

In the circuit where this cause was tried, it was not the practice to ask the Court for special instructions to the jury. After the evidence had been closed, and counsel heard, a charge was given to the jury, according to the nature of the case, upon the points made by counsel, or which might suggest themselves to the mind of the judge. It was competent, however, to either party, after the charge, to ask the opinion of the Court upon any point supposed to have been omitted, which was material to the decision. In this case, no such request had been made ; and no objection can now be made to the charge, for any imputed omission. The only question was, whether the principles laid down to the jury for their guidance were correct, and according to law, in the particular excepted to.

The charge must of course be considered with reference to the facts, the whole of which appear upon the record. The petition of the plaintiffs to the Secretary of State stated, in the words of the Patent Law, that they were the inventors

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of a "new and useful improvement," "not *known* or *used* before their application." The "application" was made in July, 1818. Their averment therefore, upon which they obtained their patent was, that the rivet hose was a new invention, not "known or used" before the year 1818. The facts proved upon the trial were, that the invention had been completed and published in the year 1811, seven years before the application. That during all that period, it had been known and used as common public property, (and not as private property) which any one might use as publicly known. And that it was so known and used with the knowledge of those who now claim to be the inventors; without any assertion or claim on their part of exclusive property, and without notice of intention to make such claim. There was not a single circumstance offered to explain the delay.

There was an attempt to show, that the making of the article for use, was limited by the authority and [* 9] permission * of the plaintiffs, and thence to infer that they did not intend to give it to the public. A witness, produced by them, and the only person who appeared to have made the article, declared in substance, "that he was taught by the plaintiffs in 1811 to make hose; that in *that* year he made a certain quantity of it for the Philadelphia Hose Company, plaintiffs being members of the committee; and that by permission of the plaintiffs he made about thirteen thousand feet of hose, for different hose companies, from 1811 to the time of granting the patent."

Thus, in point of fact, nearly two miles and a half in *length* of hose, had been made at different times in the course of seven years before the patent; and had been sold to different hose companies; not to experiment with, in order to bring the invention to perfection; but for public use, as a thing already completed, and adapted to the purpose of arresting the ravages of fire. It was so used; and from the year 1811

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to the year 1818, it was never materially altered or improved. The thing patented in 1818 was precisely the thing invented, completed and used in 1811.

Were the plaintiffs, under these circumstances, entitled to a patent? Or could a patent, thus obtained, be supported? The authorities upon the subject are decisive. He did not admit that the weight of judicial or legal opinion in England was lessened by the supposed difference in the policy of the two countries, or that in fact any such difference existed. It was true, that the process or mode of legislation was varied according to the existing state of things. The statute of James was made to abolish monopolies; but it saved, by exception, the rights of the inventors of new and useful inventions, who had before enjoyed exclusive privileges. The Constitution of the United States and the Act of Congress, on the contrary, having no monopolies to deal with, created exclusive privileges in favor of the same description of persons. The one preserved to them a preëxisting monopoly, and the other conferred it upon them. Both were influenced by the merits of the inventor, and the public advantage of encouraging inventive genius. And they were

* equally influenced by these considerations; for it [* 10] required at least as strong a sense of their just claims to distinction, to except new and useful inventions from the statutory odium and denunciation of monopolies, as it did to confer upon them the benefits of monopoly by direct enactment. There was no reason, therefore, why the judicial construction of the statute of James, (from which our act of Congress was in this respect copied,) which had become, as it were, incorporated with and part of the statute, should not be as much respected as in the instance of any other statute. The adoption of the language of the statute, was the adoption also of its settled interpretation. It could not surely be insisted that England was wanting in intelligence to dis-

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cern the value of genius, or in liberality to reward it ; or that there was a prevailing bias in her judiciary towards an unjust restriction of the rights of meritorious inventors. The sentiment of the nation, and the government, in all its branches, was the opposite of this.

Before referring to the cases, it might be well, however, to examine the matter a little upon principle. What is the right of an inventor ? It is the right, *given to him by the law*, to apply for and obtain a patent for his invention. The patent, when duly obtained, secures to him the exclusive enjoyment. Has he any other right before he obtains a patent than the one just stated ? It is obvious that he has not. This, then, is what the learned judge, in his charge, styles, with peculiar aptness, an inchoate right ; that is, a right to have a title upon complying with the terms and conditions of the law. It is like an inchoate right to land, or an inceptive right to land, well known in some of the States, and everywhere accompanied with the condition, that to be made available, it must be prosecuted with due diligence, to the consummation or completion of the title. If the condition be not complied with, the right is abandoned or lost, and the rights of others are let in. The abandonment is not a question of intention of the party, but it is the legal construction of his acts or omissions.

Had the plaintiffs ever such an inchoate right ?

[* 11] According * to the opinion of the judge, they undoubtedly had such a right by their invention in 1811. *Then*, they could have made out the case required by the first section of the Act of Congress — they could have stated with truth, that the thing invented “was not known or used before their application.” But in the year 1818 it was no longer true. It might be stated, but it could not be truly stated. They were unable to comply with the condition of law. For, if the inventor, as was the case here, voluntarily

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permit his invention to be known and used, as a thing not intended to be patented, how can he make this statement? By so doing, he abandons his inchoate right; he proclaims to the world that he does not mean to secure it by patent, and every one is at liberty to consider it abandoned, because every one acquainted with the law knows that he has incurred a disability. This is the inevitable legal construction of his conduct, and is altogether independent of his intention; unless we suppose the act to be guilty of the absurdity of requiring that to be stated which it does not require to be true.

But the terms of the act are in this respect too plain to admit of a doubt. Suppose an applicant should state, that his invention had been known and used for seven years before his application, could he obtain a patent? Suppose he should state, that he had always intended to reserve to himself a right to obtain a patent, would that help him? Or, if he should state that it had been so known and used only by his permission? The language of the act is plain and imperative. There is no scope for interpretation. The prescribed condition is express. And there is no doubt that it was the intention of Congress to refer to the "application," as the period before which the thing was not known or used; for in the subsequent Act of 17th April, 1800, conferring the privileges of the Patent Law upon resident aliens, the same word is used for the same purpose. And it is declared that the patent shall be void if the thing patented was *known or used before the application*. Act of 17th April, 1800, section 1.

* It is not contended, that if the invention should [* 12] be pirated, the use or knowledge, obtained by the piracy, or otherwise obtained without the knowledge or consent and without the fault of the inventor, would bar him from getting a patent. Nor is it contended that his own

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knowledge and use would be a bar. The latter is a necessary exception out of the generality of the terms of the law, because every inventor must know his invention, and must use it to the extent of ascertaining its usefulness, before he applies for a patent. The former is a case where there is no fault on the part of the inventor. But it is contended, that the inventor who means to rely upon a patent must make his application within a reasonable time; and that if he permit his invention to be publicly known and used before he applies, he cannot obtain a patent. He abandons his right, if he sell it for public use himself, and *à fortiori*, if he permit another so to sell it.

There is a cautious intimation in the charge, that possibly there might be some saving efficacy in accompanying the use with an assertion of claim by the inventor. And it is also put as a circumstance against the plaintiffs (which was clearly in evidence) that there was no such assertion or notice. The charge is therefore applicable only to a case of unqualified public use, without notice or assertion of claim. That such a notice would be available, or that there can be any other assertion of claim than the legal assertion by applying for a patent; are propositions which it is not now necessary to examine. They were not affirmatively laid down by the Court, nor otherwise adverted to than for the purpose of showing that the facts did not entitle the plaintiffs to the benefit of them. They cannot therefore complain. Whether such assertions or notice, contradicted by the acts of the inventor, will be available, is a question not decided below. Certain it is, that a secret permission given to their own agent, can no more be an assertion or notice, than a resolution locked up in their own breasts.

The construction contended for is in accordance with the policy of the law. Patents are intended to
[* 13] be granted * for a limited time, beginning with the

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invention. He who asks for one must describe his invention with such certainty as will ensure to the public its use, when the patent expires; and at the expiration of the time, the thing invented is public property. The inventor, to enjoy its benefits, must place his whole reliance upon it. Is it competent for him, then, to secure to himself the advantages of his own peculiar knowledge and skill, as long as these will avail him, and when they are exhausted, to apply for a patent? There are many inventions, the secret of which is not at once discoverable from an inspection of the thing invented. The inventor may keep that as long as he can. He may have extraordinary skill or methods of working which will enable him to keep the market to himself. May he enjoy these exclusive privileges for seven years, and then obtain a patent for fourteen more? He would then have the exclusive use for twenty-one years. If for seven, why not for fourteen, or twenty-one, or any other assignable time? The moment that his invention comes into the most common or public use, is the moment when he applies for a patent. When the public have fully got possession of it, he seeks to withdraw it from the common stock and appropriate it to himself. This is directly contrary to the design of the law. It extends the term, and inverts the order of proceeding. The inconveniences would be very great. Those who were engaged in making the article must stop. Those who had arranged for making it must abandon their arrangements. Those who had employed their time in learning to make it must lose their time and their labor. And even a *bonâ fide* inventor, who had discovered the same thing by his own study and experiments, would be deprived of the fruits of his ingenuity and exertions. And why? Simply because the first inventor did not choose sooner to take out a patent, as he might have done. The conditions of the law being such as he can comply with, and ought to comply with, he postpones a compli-

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ance for his own profit, and leads the community [* 14] into an injurious error. If it be designed, * it is a wrong. If it be without design, it is negligence. Ought he to be benefited by his own wrong or negligence?

The authorities are against him. He cited 3 Inst. 184; Wood v. Zimmer, 1 Holt's N. P. Rep. 58; Whittemore v. Cutter, 1 Gall. 482: and referred to Evans v. Eaton, 1 Peters's C. C. Rep. 348; Thompson v. Haight, 1 U. S. Law Journal, 563.

He then examined the several points stated for the defendant, contending that some of them were unsupported by the facts, and others by the law. Under the second he argued that there had been an "unreasonable lapse of time," and "gross negligence." That seven years (the period here unexplained) were beyond all reasonable bounds.

He contended, also, that due diligence, where there were no circumstances of explanation, was a question of law; and that it consisted in applying for a patent as soon after the invention was completed as could reasonably be done: and, finally, that due diligence required that the application should be made before the thing invented was publicly known and used with the consent of the inventor.

Mr. Justice Story delivered the opinion of the Court.

This is a writ of error to the Circuit Court of Pennsylvania. The original action was brought by the plaintiffs in error for an asserted violation of a patent, granted to them on the 6th of July, 1818, for a new and useful improvement in the art of making leather tubes or hose, for conveying air, water, and other fluids. The cause was tried upon the general issue, and a verdict was found for the defendant, upon which judgment passed in his favor; and the correctness of that judgment is now in controversy before this Court.

At the trial, a bill of exceptions was taken to an opinion

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delivered by the Court, in the charge to the jury, as follows, namely, "That the law arising upon the case was, that if an inventor makes his discovery public, looks on and permits others freely to use it, without objection or assertion of claim to the invention, of which the public might take notice, he abandons * the inchoate right to the [* 15] exclusive use of the invention, to which a patent would have entitled him had it been applied for before such use. And, that it makes no difference in the principle, that the article so publicly used, and afterwards patented, was made by a particular individual, who did so by the private permission of the inventor. And, thereupon, did charge the jury, *that if the evidence brings the case within the principle which had been stated*, the Court were of opinion that the plaintiffs were not entitled to a verdict."

The record contains, embodied in the bill of exceptions, the whole of the testimony and evidence offered at the trial, by each party, in support of the issue. It is very voluminous, and as no exception was taken to its competency, or sufficiency, either generally or for any particular purpose, it is not properly before this Court for consideration, and forms an expensive and unnecessary burden upon the record. This Court has had occasion, in many cases, to express its regret, on account of irregular proceedings of this nature. There was not the slightest necessity of putting any portion of the evidence in this case upon the record, since the opinion of the Court, delivered to the jury, presented a general principle of law, and the application of the evidence to it was left to the jury.

In the argument at the bar, much reliance has been placed upon this evidence, by the counsel for both parties. It has been said, on behalf of the defendants in error, that it called for other and explanatory directions from the Court, and that the omission of the Court to give them, in the charge, fur-

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nishes a good ground for a reversal, as it would have furnished in the Court below for a new trial. But it is no ground of reversal that the Court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party at the trial. It is sufficient for us that the Court has given no erroneous directions. If either party deems any point presented by the evidence to be omitted in the charge, it is competent for such

party to require an opinion from the Court upon [* 16] that point. If he does not, it is a waiver of * it.

The Court cannot be presumed to do more, in ordinary cases, than to express its opinion upon the questions which the parties themselves have raised at the trial.

On the other hand, the counsel for the defendant in error has endeavored to extract from the same evidence, strong confirmations of the charge of the Court. But, for the reason already suggested, the evidence must be laid out of the case, and all the reasoning founded on it falls.

The single question then is, whether the charge of the Court was correct in point of law. It has not been, and indeed cannot be denied, that an inventor may abandon his invention, and surrender or dedicate it to the public. This inchoate right, thus once gone, cannot afterwards be resumed at his pleasure ; for, where gifts are once made to the public in this way, they become absolute. Thus, if a man dedicates a way, or other easement to the public, it is supposed to carry with it a permanent right of user. The question which generally arises at trials, is a question of fact, rather than of law, whether the acts or acquiescence of the party furnish, in the given case, satisfactory proof of an abandonment or dedication of the invention to the public. But when all the facts are given, there does not seem any reason why the Court may not state the legal conclusion deducible from them. In this view of the matter, the only question would be, whether,

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upon general principles, the facts stated by the Court would justify the conclusion.

In the case at bar, it is unnecessary to consider whether the facts stated in the charge of the Court would, upon general principles, warrant the conclusion drawn by the Court, independently of any statutory provisions ; because, we are of opinion, that the proper answer depends upon the true exposition of the Act of Congress, under which the present patent was obtained. The Constitution of the United States has declared, that Congress shall have power “to promote the progress of science and useful arts, by securing *for limited times*, to authors and inventors, the exclusive right to their respective writings and discoveries.” It contemplates, therefore, that this exclusive right shall exist but for a * limited period, and that the period shall be subject [* 17] to the discretion of Congress. The Patent Act, of the 21st of February, 1793, ch. 11, prescribes the terms and conditions and manner of obtaining patents for inventions ; and proof of a strict compliance with them lies at the foundation of the title acquired by the patentee. The first section provides, “that when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new or useful art, machine, manufacture, or composition of matter, or any new or useful improvement on any art, machine, or composition of matter, *not known or used before the application*, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State, to cause letters-patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting

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to the said petitioner, &c., *for a term not exceeding fourteen years*, the full and exclusive right and liberty of *making, constructing, using, and vending to others to be used*, the said invention or discovery, &c.” The third section provides, “that every inventor, before he can receive a patent, shall swear, or affirm, that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent.” The sixth section provides that the defendant shall be permitted to give in defence, to any action brought against him for an infringement of the patent, among other things, “that the thing thus secured by patent was not originally discovered by the patentee, *but had been in use*, or had been described in some public work, *anterior to the supposed discovery of the patentee.*”

These are the only material clauses bearing upon the question now before the Court; and upon the construction of them, there has been no inconsiderable diversity of
[* 18] * opinion entertained among the profession, in cases heretofore litigated.

It is obvious to the careful inquirer, that many of the provisions of our Patent Act are derived from the principles and practice which have prevailed in the construction of that of England. It is doubtless true, as has been suggested at the bar, that where English statutes, such for instance, as the Statute of Frauds, and the Statute of Limitations, have been adopted into our own legislation, the known and settled construction of those statutes by Courts of law, has been considered as silently incorporated into the acts, or has been received with all the weight of authority. Strictly speaking, that is not the case in respect to the English Statute of Monopolies, which contains an exception on which the grants of patents for inventions have issued in that country. The language of that clause of the statute is not, as we shall

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presently see, identical with ours; but the construction of it adopted by the English Courts, and the principles and practice which have long regulated the grants of their patents, as they must have been known and are tacitly referred to in some of the provisions of our own statute, afford materials to illustrate it.

By the very terms of the first section of our statute, the Secretary of State is authorized to grant a patent to any citizen applying for the same, who shall allege that he has invented a new and useful art, machine, &c., &c., "*not known or used before the application.*" The authority is a limited one, and the party must bring himself within the terms, before he can derive any title to demand, or to hold a patent. What then is the true meaning of the words "*not known or used before the application?*" They cannot mean that the thing invented was not known or used before the application by the inventor himself, for that would be to prohibit him from the only means of obtaining a patent. The use, as well as the knowledge of his invention, must be indispensable to enable him to ascertain its competency to the end proposed, as well as to perfect its component parts. The words then, to have any rational interpretation, must *mean, not known or used by others, before [* 19] the application. But how known or used? If it were necessary, as it well might be, to employ others to assist in the original structure or use by the inventor himself; or if before his application for a patent his invention should be pirated by another, or used without his consent; it can scarcely be supposed, that the legislature had within its contemplation such knowledge or use.

We think, then, the true meaning must be, not known or used by the public, before the application. And, thus construed, there is much reason for the limitation thus imposed by the act. While one great object was, by holding out a

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reasonable reward to inventors, and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius, the main object was "to promote the progress of science and useful arts;" and this could be done best, by giving the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible; having a due regard to the rights of the inventor. If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should, for a long period of years, retain the monopoly, and make, and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure, and then, and then only, when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any farther use than what should be derived under it during his fourteen years, it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries.

A provision, therefore, that should withhold from an inventor the privilege of an exclusive right, unless he should, as early as he should allow the public use, put the public in possession of his secret, and commence the running of the period, that should limit that right, would not be deemed

unreasonable. It might be expected to find a place [* 20] in a * wise prospective legislation on such a subject.

If it was already found in the jurisprudence of the mother country, and had not been considered inconvenient there; it would not be unnatural that it should find a place in our own.

Now, in point of fact, the statute of 21 Jac. ch. 3, commonly called the Statute of Monopolies, does contain exactly such a provision. That act, after prohibiting monopolies

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generally, contains, in the sixth section, an exception in favor of "letters-patent and grants of privileges for *fourteen years or under*, of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which *others, at the time of making such letters-patent and grants shall not use.*" Lord Coke, in his commentary upon this clause or proviso, (3 Inst. 184,) says that the letters-patent "must be of such manufactures, which *any other at the time of making such letters-patent did not use*; for albeit it were newly invented, yet if any other did use it at the making of the letters-patent, or grant of the privilege, it is declared and enacted to be void by this act." The use here referred to has always been understood to be a public use, and not a private or surreptitious use in fraud of the inventor.

In the case of *Wood v. Zimmer*, 1 Holt's N. P. Rep. 58, this doctrine was fully recognized by Lord Chief Justice Gibbs. There the inventor had suffered the thing invented to be sold, and go into public use for four months before the grant of his patent; and it was held by the Court, that on this account the patent was utterly void. Lord Chief Justice Gibbs said, "To entitle a man to a patent, the *invention* must be *new to the world*. The *public* sale of that which is afterwards made the subject of a patent, *though sold by the inventor only*, makes the patent void." By "invention," the learned judge undoubtedly meant, as the context abundantly shows, not the abstract discovery, but the *thing* invented; not the new secret principle, but the manufacture resulting from it.

The words of our statute are not identical with those of * the statute of James, but it can scarcely [* 21] admit of doubt, that they must have been within the contemplation of those by whom it was framed, as well as the construction which had been put upon them by Lord

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Coke. But if there were no such illustrative comment, it is difficult to conceive how any other interpretation could fairly be put upon these words. We are not at liberty to reject words which are sensible in the place where they occur, merely because they may be thought, in some cases, to import a hardship, or tie up beneficial rights within very close limits. If an invention is used by the public, with the consent of the inventor, at the time of his application for a patent, how can the Court say, that his case, is, nevertheless, such as the act was intended to protect? If such a public use is not a use within the meaning of the statute, what other use is? If it be a use within the meaning of the statute, how can the Court extract the case from its operation, and support a patent, where the suggestions of the patentee are not true, and the conditions on which alone the grant was authorized to be made, do not exist? In such a case, if the Court could perceive no reason for the restrictions, the will of the legislature must still be obeyed: It cannot and ought not to be disregarded, where it plainly applies to the case. But if the restriction may be perceived to have a foundation in sound policy, and be an effectual means of accomplishing the legislative objects, by bringing inventions early into public and unrestricted use; and above all, if such policy has been avowed and acted upon in like cases in laws having similar objects; there is very urgent reason to suppose, that the act in those terms embodies the real legislative intent, and ought to receive that construction. It is not wholly insignificant in this point of view, that the first Patent Act passed by Congress on this subject, (Act of 1790, ch. 34, [ch. 7,]) which the present act repeals, uses the words "*not known or used before,*" without adding the words "*the application;*" and in connection with the structure of the sentence in which they stand, might have been referred either to the time of the invention, or of the application. The addition of the

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* latter words in the Patent Act of 1793, must, [* 22] therefore, have been introduced, *ex industria*, and with the cautious intention to clear away a doubt, and fix the original and deliberate meaning of the legislature.

The Act of the 17th of April, 1800, ch. 25, which extends the privileges of the Act of 1793 to inventors who are *aliens*; contains a proviso declaring, “that every patent which shall be obtained pursuant to the act for any invention, art or discovery, *which, it shall afterwards appear, had been known or used previous to such application for a patent*, shall be void.” This proviso certainly certifies the construction of the Act of 1793, already asserted; for there is not any reason to suppose, that the legislature intended to confer on *aliens*, privileges essentially different from those belonging to *citizens*. On the contrary, the enacting clause of the Act of 1800 purports to put both on the same footing; and the proviso seems added as a gloss or explanation of the original act.

The only real doubt which has arisen upon this exposition of the statute, has been created by the words of the sixth section already quoted. That section admits the party sued to give in his defence as a bar, that “the thing thus secured by patent was not originally discovered by the patentee, but had been in use *anterior to the supposed discovery* of the patentee.” It has been asked, if the legislature intended to bar the party from a patent in consequence of a mere prior use, although he was the inventor; why were not the words “*anterior to the application*,” substituted, instead of “*anterior to the supposed discovery*”? If a mere use of the thing invented before the application were sufficient to bar the right, then, although the party may have been the first and true inventor, if another person, either innocently as a second inventor, or piratically, were to use it without the knowledge of the first inventor; his right would be gone. In respect to a use by piracy, it is not clear that any such fraudulent use is

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within the intent of the statute ; and upon general principles it might well be held excluded. In respect to the [* 23] case of a second invention, it is questionable *at least, whether, if by such second invention a public use was already acquired, it could be deemed a case within the protection of the act. If the public were already in possession and common use of an invention fairly and without fraud, there might be sound reason for presuming, that the legislature did not intend to grant an exclusive right to any one to monopolize that which was already common. There would be no *quid pro quo* — no price for the exclusive right or monopoly conferred upon the inventor for fourteen years.

Be this as it may, it is certain that the sixth section is not necessarily repugnant to the construction which the words of the first section require and justify. The sixth section certainly does not enumerate all the defences which a party may make in a suit brought against him for violating a patent. One obvious omission is, where he uses it under a license or grant from the inventor. The sixth section in the clause under consideration, may well be deemed merely affirmative of what would be the result from the general principles of law applicable to other parts of the statute. It gives the right to the *first* and true inventor and to him only ; if known or used before his supposed discovery he is not the *first*, although he may be a *true* inventor ; and that is the case to which the clause looks. But it is not inconsistent with this doctrine, that although he is the *first*, as well as the *true* inventor, yet if he shall put it into public use, or sell it for public use before he applies for a patent, that this should furnish another bar to his claim. In this view an interpretation is given to every clause of the statute without introducing any inconsistency, or interfering with the ordinary meaning of its language. No public policy is overlooked ; and no injury can ordinarily occur to the first inventor, which is not

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in some sort the result of his own laches or voluntary inaction.

It is admitted that the subject is not wholly free from difficulties; but upon most deliberate consideration we are all of opinion, that the true construction of the act is, that the first inventor cannot acquire a good title to a patent; if he suffers the thing invented to go into public use, or to be *publicly sold for use, before he makes application [* 24] for a patent. His voluntary act or acquiescence in the public sale and use is an abandonment of his right; or rather creates a disability to comply with the terms and conditions on which alone the Secretary of State is authorized to grant him a patent.

The opinion of the Circuit Court was therefore perfectly correct; and the judgment is affirmed with costs.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the district of Pennsylvania, and was argued by counsel; on consideration whereof, it is the opinion of this Court, that there is no error in the judgment of the said Circuit Court. Whereupon, it is considered, ordered, and adjudged by this Court, that the said judgment of the said Circuit Court in this cause, be and the same is hereby affirmed with costs.

WHITNEY AND OTHERS v. EMMETT AND OTHERS.

[1 Baldwin, 303. April T. 1831.]

If the deposition of a witness who is attending in Court is read without objection, he may be examined in chief by the party who read his deposition.

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A patented invention is deemed useful if it is not frivolous ; the want of utility is good cause for not granting the patent, but not for setting it aside.

The prior knowledge and use of the invention which avoids a patent, relates to the time of the application, not the discovery, and to public use with the knowledge and privity of the patentee, not to a private or surreptitious use in fraud of the patent.

If the application is made in a reasonable time after the discovery, any intermediate knowledge or use will not affect the patent. But the invention must be new to all the world.

If the patent is for an improvement, it must be substantially new, one capable of application by the means pointed out by the patent, specification, drawing, model and the old machine.

If by these means the invention and the mode of using it are intelligible to persons skilled in the subject, the requisite of a specification by the third section of the Act of 1793, are complied with.

It is not necessary that the disclosure of the secret should be such as to enable the public to use the invention after the patent has expired, as in England, such being the consideration on which patents are granted there. The difference between their Patent Laws and ours explained.

If the patent is broader than the invention, if not sufficiently descriptive, taken in connection with the specification, &c., the plaintiff cannot recover. But though the patent is too broad in its general terms, it will be limited by a summary and disclaimer, if they show the thing intended to be patented, and that no claim is made to any thing before known or used.

A patent is a contract with the public in the terms of the law, which must be complied with in the same good faith as other contracts, but as it gives a right of property, it ought to be protected by a liberal construction of the law and the acts of the patentee.

A Circuit Court can give a judgment declaring a patent void only in the cases provided for in the sixth section. If the patent is defective for any other cause, the Court can only render a general judgment for the defendant. What is a proper subject for a patent, &c.

THIS was an action to recover damages for the violation of a patent for an improved method of making glass knobs, as described in the specification.

“ To all persons to whom these presents shall come, Henry Whitney, agent of the New England Glass Company, and Enoch Robinson, mechanic, both of Cambridge in the County of Middlesex, and State of Massachusetts, send greeting :

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*“ Be it known, that we, the said Henry Whit- [* 304]
ney and Enoch Robinson, have invented, constructed, made, and applied to use, a new and useful improvement in the mode of manufacturing by machinery, at one operation, glass knobs or trimmings for doors, stoves, drawers, sideboards, bureaus, wardrobes, and all kinds of furniture, and other things where glass handles, knobs, or ornaments may be used and fastened by spindles running through the centre of them, specified in the words following, to wit :

“ This improvement in making knobs, consists in compressing them in moulds, in the manner following. The mould is made of a composition of brass and copper, cast-steel or other metal, of a size and shape suitable to contain the knob, of which mould a model and drawing is deposited in the Patent Office. It is in two parts, a top part and bottom part ; the lower or bottom part is to receive the melted glass and form the main part of the knob, and the top part is to press the knob, form its ornamental face, and to perforate it with a pin longitudinally. The bottom part is made in two pieces, fastened together by a hinge on the back side, with handles on each side, in front, to open and shut it, and a clasp to fasten it together, while receiving the melted glass and the impression. The bottom part terminates upward by a tube, cylindrical or nearly so, from one eighth to four eighths of an inch high, according to the size of the article to be made, into which the top part of the mould enters to compress and form the knob and stamp its face. The top part is of a size and shape suitable to enter and fill the cylindrical space at the top of the bottom part ; on its face or underside is a die, figured with circles, rings, hearts, roses, leaves, fruit, animals, or any other fancy or ornamental shape, which has been or may be used in brass or other ornaments, or the face may be made plain.

“ Into the top part is fastened a steel pin, of a square, \

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round, or any other shape, projecting from it perpendicularly downward, of a length sufficient to penetrate quite through the article to be made. To reject the surplus quantity of glass, and prevent its accumulation in the mould from the quantity displaced by the pin in perforating the knob, a hole, nearly of the size and shape of the pin, is made perpendicularly downwards, through the under part of the bottom piece of the mould, through which the surplus glass is driven, by the expression, in forming the article.

“ To use the mould, we place the bottom part on a table, on which is perpendicularly erected a standard [* 305] twelve or fourteen inches high, * for the purpose of attaching to it a lever, to force down the top part and give the impression, and to hang a gate turned on a pivot, to which the top part of the mould is fixed. On the end of the lever behind the standard, a spiral or other spring is fastened, which is also fastened to the table, to suspend the top part of the mould when it is raised by the lever. The position of the top is so adjusted, with reference to the bottom part of the mould, by a guide fastened to the standard, that when the power is applied to the lever to compress the glass, the top exactly shuts into the bottom part and forces the pin through the knob into the hole below it.

“ The mould being thus prepared for use, the top is raised by the lever and turned a little on one side by the gate, to give room to drop the melted glass into the bottom part of the mould. The glass is then gathered from the pot and dropped into the bottom part of the mould, which is already closed and secured against opening by the clasp; the gate is then turned back against the guide, so that the top of the mould is brought directly over the bottom, and by the application of power to the lever the article is at once compressed, formed and finished; the top is then raised by the lever, the clasp on the bottom part is unfastened, the mould is opened by the handles, and the knob taken out, so entirely finished,

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that it only requires fire polishing to make it a neat article fit for immediate use.

“ We do not claim to be the original inventors of the mould, as applied to the formation of glass wares, but admit that for many purposes it has been heretofore used. Our invention consists in this : a new combination of the various parts of the mould, with the use of the pin and machinery before described, in such a manner as, without any blowing, to produce a finished knob, with a hole perforated through it, and a neck or enlargement, so that it will not come out of the mould without opening it, at one operation, by compression merely.

“ In testimony that the above is a true specification of our said improvement, as above described, we have hereunto set our hands and seals, this 22d day of August, in the year of our Lord 1826.”

A drawing and model of the improved machine were produced at the trial, as also the old machine, and the one used by the defendants, which was alleged to be the same in substance as the one patented ; the fact and extent of the infringement were admitted, *as well as the [* 306] general utility of the improved machine, so far as was required by law.

The cause turned on the validity of the patent, which was alleged to be void, because the invention was not new, and the specification defective ; much evidence was heard and read on the questions of fact, but no questions of law arose except such as were founded on the patent and specification.

Mr. C. Ingersoll and *Mr. C. J. Ingersoll* for defendants.

The patent is void on account of the defect in the specification, in not describing what parts of plaintiff's machine are old and what parts are claimed as his invention ; it is the more necessary in this case as the patent embraces the whole

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machine, whereas, it is admitted that only parts, were invented by the plaintiffs. If the improvement is not so specified as to discriminate between the original and improved machine, and the patent is taken according to its terms, it is broader than the invention, and therefore void. 1 Gall. 479, 480; 11 East. 110. The law requires the specification to explain the precise improvement patented; if it is for a new combination of the old parts, the improved mode of operation and construction must be particularized; if for any new parts or additions, they must be specified, and their connection with the old parts explained. The specification is defective in both particulars; the law requires that it should set out every thing necessary to enable others to avoid any interference with the thing invented, to describe it in such clear terms that others can use it, and the public have the benefits of it after the patent-right has expired, otherwise it is void, although we do not make out a case of fraudulent addition or concealment, according to the terms of the sixth section of the law.

If the specification is not strictly conformable to law, the patent is void, to whatever cause it is owing; it must speak for itself, (Say. 254,) so as to be intelligible without extraneous explanation, for the full and perfect explanation and description of the thing patented is the consideration of the grant, for want of which it is void. 7 Wheat. 423, 468. A perfect description is the plaintiff's only title, which he must make out affirmatively on the face of the specification, for the benefit of the public, who are parties to all suits on patents, and public policy declares them void if they do not meet every requisition of the law. Davis on Patents, 55, 56.

Patents being monopolies, in derogation of com-
[* 307] mon-law rights, * are deemed odious in the law,
unless they are clearly for an invention of the patentee; if the subject-matter is not new, though new to the

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inventor, his patent is void, or if the patent embraces any thing not new. In this case the summary, which is the outline of the patent, refers to the whole machinery, without a clue to separate the old from the new, the parts disclaimed are useless, and those claimed are a mere change of the forms and proportions of the old parts. Judging from the specification, the patent is not for an improvement on a machine, or an improved machine, but for a result which is pointed out; it is wholly obscure as to the mode of operation, and the particular combination of the old and new parts which produce this result; on this account the patent is void. But if it is valid the plaintiff cannot recover in this case, because his patent is for a combination of machinery, and he has not shown that our machine adopts his whole combination, (1 *Mason*, 474, 475,) or in what particular it is an infringement of his right.

Mr. Cadwalader and *Mr. Sergeant*, for plaintiffs.

If inventors are not protected, great injustice is done them, because they cannot be restored to their rights after they have disclosed their invention to the public by a specification, which enables any person to take advantage of it. In this case the invention is very plainly described, in detail, in the body of the specification, and in summing it up, at the close, by declaring it to consist of a new combination of the various parts of the mould, &c.; disclaiming its original invention and admitting its former use. It is not necessary to describe the old machine or its parts, which are as well known and familiar to a person who understands machinery, as a watch; a patent for an improvement on a watch is good without describing the watch, (*Davis* 45, 56,) so of a steam-engine, (8 *Durnf. & East.* 98,) or an improvement in mill machinery, (3 *Wheat.* 511,) &c. The specification is addressed to engineers and persons skilled in the business to which the im-

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provement relates. Davis, 214, 216. If they understand the invention, and can produce the result, the object of the law is answered. When others are enabled to make the improved machine from the directions given in the specification, this is the scope and end of the matter, (Pl. 18,) required by the law; and when this can be done the patent is good, though the description may be imperfect, if it is not designedly so to mislead the public, (1 Peters's C. C. Rep. 400; 1 Gall. 479, [* 308] 480,) and the disclosure made in the * same good faith that is required in other contracts. 14 Ves. 131, 136; 1 Durnf. & East, 606. By applying the specification to the old and improved machines, and putting them into operation, the invention is at once intelligible; and the summary and disclaimer limit it to the new combination, (2 Mason, 112; 8 Durnf. & East, 103,) so that it is as broad as the patent. By applying the same test to the defendants' machine, it is apparent that the whole improvement of the plaintiffs is used. If they allege that any part of what is claimed as the invention had been known or used before our application for a patent, the burden of proof rests on them to prove it to have been a public use, and not one in fraud of the patent, or after notice of the application. Pennock v. Dialogue, 1 Peters, 4, 14. Patents give a right of property in the invention; they are construed as other grants are, liberally, in favor of the grantee, and so that they shall be sustained, where there has been a substantial compliance with the law, and the subject-matter is a practical improvement. 11 East, 110; 2 H. Bl. 495; 1 Durnf. & East, 606.

BALDWIN, J., to the jury.

The plaintiffs' patent is for a new and useful improvement, in the mode of manufacturing glass knobs by machinery at one operation, by spindles running through the centre of the knob, without blowing. The specification describes the man-

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ner of doing it, and concludes with a declaration, summing up the invention and disclaiming the right to the exclusive use of the mould, as formerly used, but claiming the invention to be a combination of the parts, with the use of the pin and machinery before described.

It is admitted by the defendants that they have infringed the right of the plaintiffs as claimed by their patent, to the extent set forth in an account furnished under an order on the equity side of this Court ; also that the subject-matter of the patent is so far useful as to come within the meaning of the law. But it is contended that the patent is void for two reasons. 1. Because the thing patented was not a new invention of the plaintiffs. 2. Because the specification which accompanies the patent is defective, in not discriminating between the old and new machine, and specifying the improvement patented ; and by embracing in it the old parts of the machine, making the patent broader than the invention. These objections depend on the Acts of Congress directing patents to be issued on certain * conditions, [* 309] which must be complied with in order to give action to the special authority conferred. 2 Peter, 18, 21.

The subject-matter of a patent is "the invention of any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereon, not known or used before the application." Act of 1793, 1 Story, 300, 301, &c.

No question is raised as to the utility of the plaintiffs' machine ; the word "useful," in the law, is well settled to be used in contradistinction to frivolous improvements and inventions, or such as are injurious to the public. 1 Mason's Rep. 185, 302 ; 4 Mason's Rep. 6. The want of utility may be a good reason for not issuing a patent, but is no cause for avoiding it. 1 Peters's C. C. Rep. 403, 480 ; 4 Wash 12. The first important inquiry therefore is, whether the plaintiffs'

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patent is for a new improvement or invention made by them. It had been the subject of much difference of opinion, whether the words, "not known or used before the application," in the first section, meant, "but had been in use or described in some public work anterior to the supposed discovery," as in the sixth section; or, "known or used previous to the application for a patent," as in the first section of the Act of 1800, (1 Story, 752.)

It had been decided in the Circuit Courts that the previous knowledge and use related to the discovery, and that a patent was good though the invention was known and used at the time of the application, as the patent would relate to the discovery, unless the patentee had permitted its use under such circumstances as to authorize the presumption of abandonment, or dedication of the invention to public use. 1 Paine, 300, 352; 1 Gall. 472; 4 Wash. 72, 541, 708; 2 Wash. 345; 4 Mass. 111.

But in *Pennock v. Dialogue*, the Supreme Court have referred the words "known or used" to the application for the patent, according to the construction given by the English Courts to the statute 21 Jac. 1, ch. 3, sect. 5, (3 Ruff. 92,) the words of which are, "which others at the time of making such letters-patent and grants shall not use," which is thus construed; for albeit it were newly invented, yet if any other did use it at the making of such letters-patent, or the granting the privilege, it is declared and enacted to be void by this act. 3 Co. Inst. 184; Vide 3 Wh. 514, S. P.

A previous use, to avoid a patent, must not be a private or surreptitious use in fraud of the patentee, but a public use by his consent, by a sale by himself, or by others with [* 310] his acquiescence, by which * he abandons his right, or disables himself from complying with the law; it is deemed a fraud in law to take out a patent after such use. 2 Peters 20; 4 Wash. 538; Holt's N. P. 58, 60.

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But unless the invention has been more or less used by others, or publicly communicated by the patentee, his patent will be sustained; the rule is well illustrated in the English cases, as adopted by the Supreme Court. If the first inventor makes the discovery in his closet, and confines the knowledge to himself, such knowledge will not invalidate a subsequent patent to another for the same thing. On the other hand, though persons engaged in the business to which it relates are generally ignorant of the invention, yet if one person had used it for some time with the knowledge of his two partners, and two servants engaged in its manufacture, and it appeared that a chemist had, in conversation with the patentee, suggested the basis of the invention; or when he had been informed of it by a person whom he employed to make models of the machine; or had adopted a machine which had been in a degree before used by a few, though a general ignorance of it was proved by many persons engaged in the trade, the patent is not good. Davis's Pat. Cas. 61; 2 H. Bl. 470, 487; 8 Taunt. 396, &c., and cases cited; S. C. 4 C. L. 375.

The priority of knowledge and use is a question of fact, which a jury may decide on the evidence of one witness; though numerous others of the greatest knowledge and skill in the matter are wholly ignorant of the invention, the question is on the credibility, not the number of witnesses. 8 Taunt. 395; 4 Wash. 69, 72, 543, 544. The time during which the thing patented had been known and used is not material, the criterion is its public, not its private or surreptitious use, but the use, with the consent of the inventor, express or implied from circumstances. A patentee may take a reasonable time to make his specification, drawings, model, to try experiments on the effect and operation of his machinery, in order to know whether the thing patented can be produced in the mode specified; he may disclose his secret to those he may wish to

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consult, or call to his assistance any persons to aid him in making or using his machine, and preparations for procuring his patent. So if the machine is to operate publicly, as in steamboats, a public experiment may be made, or if the patentee is informed that others are using his invention, he may disclose it to them in order to give notice of what it consists, and caution them against its infringement. In either of these

and like cases, a disclosure of the secret would not [* 311] be such * previous knowledge, or the use of the invention be such an use, as would impair the patent if taken out in a reasonable time after the discovery ; the question of due diligence or negligence is for the jury, on all the circumstances of the case. Though the discovery by the patentee is new, yet if he is guilty of negligence in procuring his patent, by which the invention has become publicly known, and used by any persons, he has no right of action, the use must be surreptitious in fraud of his right in order to protect it. As to the novelty of the invention the rule is this, "it must be new to all the world, not the abstract discovery, but the thing invented ; not the new secret principle, but the manufacture resulting from it ; it must be new at the time of the application for the patent, in the words of the law ; (2 Peters, 20, 22 ;) but it will be considered as new then, if the application is within a reasonable time after the discovery, if the patentee has not sold or permitted the use of the invention. There is this difference between the Patent Law of England, and the United States, arising out of the phraseology of their respective laws ; the words of the statute of James are, "new manufacture within this realm," which are held to authorize a patent for an invention known and used in other countries, if it is new in England. 1 Salk. 446, 447. By the Act of 1800, which is a gloss or commentary on the Act of 1793, (2 Peters, 22,) the patentee must prove that the "invention hath not been known or used in this or any foreign country ;"

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hence it is held void if known or used before anywhere. 1 Peters, C. C. Rep. 400 ; 1 Wash. 170 ; 2 Wash. 311 ; 3 Wash. 433 ; 4 Mass. 109. The novelty of an invention is either the manufacture produced, or the manner of producing an old one ; if the patent is for the former, it must be for something substantially new, different from what was before known ; if the latter, the mode of operation must be different, not a mere change of the form and proportions ; if both are the same in principle, structure, mode of operation, and produce the same result, they are not new, though there may be a variance in some small matter for the purpose of evasion, or as a color for a patent. Nor is a discovery of some new principle, theory, elementary truth, or an improvement upon it, abstracted from its application, a new invention. But when such discovery is applied to any practical purpose, in the new construction, operation, or effects of machinery or composition of matter, producing a new substance, or an old one in a new way, by new machinery, or a new combination of the parts of an old one, operating in a peculiar, better, cheaper, * or quicker method, a new mechanical employ- [* 312] ment of principle already known, the organization of a machine embodied and reduced to practice on something visible, tangible, vendible, and capable of enjoyment, some new mode of practically employing human art or skill. It is a "discovery," "invention" or "improvement," within the Acts of Congress, and a "new manufacture by the statute of James." 2 Gall. 55 ; 1 Mas. 191 ; 3 Wash. 449 ; 4 Wash. 71, 542 ; 7 Wheat. 361, 431 ; 8 Taunt. 391 ; 4 Burr. 2361 ; 2 H. Bl. 468 ; 8 D. & E. 95 ; 2 B. & A. 349 ; 1 Gall. 481 ; 4 Mason, 6, 9. A patent may be for a mode, or a method of doing a thing ; mode when referred to something permanent, means an engine or machine ; when to something fugitive, a method, which may mean engine, contrivance, device, process, instrument, mode and manner

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of effecting the purpose ; the word principle may mean engine, in an Act of Parliament under which the patent issued, or may mean the constituent parts thereof. A patent for a method of producing a new thing, may apply to the mechanism, a new method of operating with old machinery, or producing an old substance ; a patent for a mode or method detached from all physical application, would not refer to an engine or machine ; but when referred to the mode of operation, so as to produce the effect, would be considered as for an engine or machine. The words used as mode or method, are not the subject of the patent ; it is the thing done by the invention, and patents are so construed *ut res magis valeat quam pereat*.

On this principle the patent of Mr. Watt “ for a method of lessening the consumption of steam and fuel in fire-engines,” was sustained ; as the intent was apparent, no technical words were deemed necessary to explain its object, and it was held to be a patent for an engine, machine, and manufacture ; such is the established law here and in England. 3 Wheat. 512 ; 8 Durnf. & East, 107, 108 ; 3 Ves. 140.

You will apply these rules and principles of law to the whole evidence, without regarding so much the words as the evident intention of the patent ; ascertain what is the subject-matter of the patent, and the thing patented, next whether it was invented by the plaintiffs, and then whether it had been known and used before the application for the patent, in this or any other country, in such a manner as, within the rules laid down, would invalidate the right of the privilege granted.

The plaintiffs must make out their case to be [* 313] within the law in * all the particulars required ; slight evidence is sufficient. 1 Durnf. & East, 606, 607 ; 2 Peters, 18, 19. If you believe plaintiffs’ witnesses, their testimony is in law sufficient to establish their right, so far as respects their invention and its novelty ; the burden of prov-

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ing the previous invention, knowledge, or use of the thing patented is on the defendants. They have given evidence sufficient in law to prove it, if you are satisfied of its truth in fact; the plaintiffs must rebut it by legal and credible evidence, or your verdict must be for the defendants. On this part of the case you will decide according to your opinion as to the matter of fact. Should you find that the plaintiffs are the inventors of the thing patented, and that it was not known or used so as to affect the validity of the patent, the next question is one of law, whether the invention claimed is a proper subject-matter for a patent. On this point we have no hesitation in instructing you, that it is an improvement on a machine, manufacture, or composition of matter, within the words and meaning of the law.

The next inquiry is, whether the patent is affected by the objections founded on the specification, namely, that it is broader than the invention, and otherwise defective. This depends on the construction of the words used to denote the intention of grantor and grantee, "as the end and scope of the matter, which is the matter itself, and the intent thereof also accomplished." Pl. 18, a.

The patent is for a new and useful improvement in the mode of manufacturing glass knobs, which is broad enough to include the whole machinery described in the specification, including the old machine and the old process of manufacture, not claimed by the plaintiffs as their invention. But the subsequent words, summing up the invention intended to be patented, disclaiming the invention of the mould and other parts of the old machine, and declaring the patent to be for a new combination of the various parts of the mould, with the use of the pin and machinery before described, operate as a proviso restraining and limiting the patent to the object so specified, and excepting all other parts from the more general description. The disclaimer, at the close of the specifica-

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tion, estops the patentee from setting up any privilege to the part disclaimed, and the summary is equally binding on him, as a limitation to the thing patented. 2 Mason, 112; 4 Wash. 14, 704; 8 Durnf. & East, 96, 103, 107. The specification is a part of the patent, and, taken together, they show that the subject-matter patented is not the old machine, [* 314] or its * constituent parts in their distinct operations; but the combined result of the new and old machinery, produced by a new combination, addition, and improvement. "The distinction between a machine and an improvement on a machine, or an improved machine, is too clear for them to be confounded; a grant of the exclusive use of an improvement in a machine, principle, or process, is not a grant of the improvement only, but the improved machine; an improvement on a machine and an improved machine are the same." 3 Wheat. 456, 509, 517; 7 Wheat. 356, 423; 4 Wash. 9, 14, 709; 1 Gall. 482. A patent for a machine, consisting of an entire new combination of all its parts, is good, though each part has been used in former machines, if the machine is substantially new in its structure and mode of operation; but if the same combination existed before, in machines of the same nature, up to a certain point, and the invention consists in adding some new machinery, in some improved mode of operation, or some new combination, the patent must be limited to the improvement; if it includes the whole machine it cannot be supported. 7 Wheat. 430, 431; 2 Marsh. 211, 213; 2 H. Bl. 487; 1 Peters's C. C. Rep. 343; 1 Gall. 482; 2 Mason, 116; 4 Wash. 543. A patent must not be broader than the invention, or it will be void, not only for so much as had been known or used before the application, but also for the improvement really invented. Bull. N. P. 76; 11 East, 110; 1 Gall. 440; 2 Gall. 54; 1 Mason, 188; 2 Mason, 109, 111.

The improvement patented must be the improvement in-

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vented. 8 Taunt. 394 ; 3 Mer. 629. If for a discovery, it must be for something new, not for an improvement only ; each item must be a new invention, and the discovery must not fail in a material part. 2 B. & A. 345, 351 ; 4 B. & A. 549, 552 ; 1 Durnf. & East, 605, 606 ; 2 Marsh. 213, 214 ; 7 Wheat. 430. If for an improvement on a machine, the patentee must show the extent of the improvement, so that a person who understands the subject may know in what it consists. 3 Wheat. 518. It need not describe the old machine, but must limit the patent to such improvement. 7 Wheat. 435.

In using the word patent, in reference to the description of the thing patented, we must be understood as including the patent, the specification attached to it, with the model and drawing in the Patent Office, all of which are to be taken together as the description.

In deciding on its sufficiency, the Court inspect the whole description as one paper, which they assume to be true in fact, and if found * to be in conformity with [* 315] the requisitions of the law, so that it appears with reasonable certainty, either from the words used or by necessary implication, in what the invention or improvement consists, as claimed by the patentee, they will adjudge it sufficient. 1 Mason's Rep. 188, 189. A description, though in some respects obscure, imperfect, or not so intelligible as to fully answer all the objects of the law, is good if it enables the Court to specify the improvement or invention patented, from the face of the patent and accompanying papers. It is enough if there is a substantial description of the thing patented, though defective in form or mode of explanation. In this respect the papers will be viewed in the same light as a declaration in a suit at law ; the Court, looking on them as a statement of the patentee's right and title, will overlook all defects in the mode of setting it out, if it contains a substan-

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tial averment of such matter as suffices in law to make out a cause of action. This is a question of law which the Court decides ; it is a question for the jury to decide, whether the statements are true in fact ; the Court does not look beyond the patent and the other papers, but the jury decide from the papers, the evidence of the witnesses, an inspection of the old and new machine and the model, to ascertain whether in point of fact the specification, as made out at the trial, is sufficient. 7 Wheat. 366, 428, 433, 435, 456, 457 ; 11 East, 113 ; 14 Ves. 131, 135 ; 3 Ves. 140 ; 1 Paine, 207, 446 ; 1 Durnf. & East, 602, 604 ; 8 Durnf. & East, 100, 108 ; 2 H. Bl. 473 ; 8 Taunt. 401 ; 1 Mason's Rep. 189.

In the present case our opinion is, that the description is sufficient in law, but whether it is sufficient in fact, is for you to decide according to your own opinion on the evidence, a comparison of the old and new machines, the mode of operation, the effect produced, and an examination of the model and all the papers. If the machine, and its mode of construction and operation, is so explained as to enable you to specify the distinct improvement patented, then the specification is good in law and fact, unless it appears that something has been omitted which is required by the Acts of Congress to make the patent valid.

The third section of the Act of 1793, directs certain things to be done by the applicant for a patent before he is entitled to it, and gives the reasons therefor, but does not declare that the patent shall be void, if all the acts directed have not been complied with previously to its being granted.

[* 316] * The sixth section specifies the cases in which the patent shall be void, which are not the omission of what was directed in the third section, but the defendant proving "that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described

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effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the thing thus secured by patent was not originally discovered by the patentee, but had been in use, or had been described in some public work anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery of another person, in either of which cases judgment shall be rendered for the defendant, with costs, and the patent shall be declared void."

It is the exclusive province of the legislature to discriminate between what acts are to be done to authorize a patent to issue, and those which will make it void if done or omitted. When this has been done in clear, explicit terms, a court cannot superadd requisites to the grant of the patent, or include other acts than those specified, which authorize them to declare it void, or so declare it if the specified acts or omissions are not proved to be fraudulent, or the thing patented was not new, &c. Laws are construed strictly to save a right or avoid a penalty; they are construed liberally to give a remedy, or to carry into effect an object declared in the law; but if a court, by construction, add an object not so declared, apply the penal provisions of the law to a case not within its definition, or exclude from the remedy provided a case defined, it is judicial legislation of the most odious kind, necessarily retrospective, and substantially and practically *ex post facto*. It is equally so to confound the parts of a law which are merely directory as to the acts to be done, with those which prescribe acts as conditions precedent to the vesting a right, or define those acts or omissions which authorize a court to annul a grant; for the direct effect would be, to impose on a plaintiff in a patent cause a forfeiture of his right by construction, when by the provisions of the law he was entitled to damages treble the amount of the injury he had sustained. No case could arise in which the language of the Supreme

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Court, in *Fletcher v. Peck*, would be more forcibly applicable ; the character of *ex post facto* legislation, so severely reprobated in their opinion, would not depend on the tribunal which exercised it. Vide 6 Cranch, 138, 139.

We cannot, therefore, give our sanction to the [* 317] positions assumed by * the defendants' counsel, that the patent is void if the specification is in any respect defective, or for whatever cause, and that the public are parties to all suits for the infringement of patent-rights. Congress have, in the sixth section, prescribed the rules of our decision in cases between individuals, and defined the causes for declaring a patent void on proof by a defendant ; the trial is on a question of property, of private right, unconnected with the public interest, and without any reference to the public, unless a case is made out of a design to deceive them, and we cannot better express our sentiments on this subject, than in the words of a great English judge. " It is said it is highly expedient for the public, that this patent having been so long in public use, after Mr. Arkwright had failed in that trial, should continue to be open ; but nothing could be more essentially mischievous, than that questions of property between A and B, should ever be permitted to be decided upon considerations of public convenience or expediency. The only question that can be agitated in Westminster Hall is, which of the two parties, in law or justice, ought to recover." By Lord Loughborough. *Arkwright v. Nightingale*, Davies's Patent Cases, 56.

We know of no principle which affords to this Court a safer guide in administering justice in this building. Congress seem to have adopted it in the tenth section, by authorizing the District Court, in certain cases, by a summary process in the nature of a *scire facias*, to repeal the patent, which is a public prosecution in which public considerations operate ; the sixth section is confined to civil suits in the Circuit Court.

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Herein consists an important difference between the Patent Law of England and this country. The statute of James I. did not regulate the action for an infringement of a patent-right, consequently the English courts could only render judgment for the defendant, if the patent was not valid ; they could not declare it void by a regular judgment, and the plaintiff could bring successive actions. The patent could be annulled, only by a *scire facias* in chancery, at the suit of the king ; (King v. Arkwright, Davies, 144 ;) and in a suit for damages, nothing could be decided but the right of property. Davies, 56. The law of England having been thus declared in 1785, accounts for the sixth and tenth sections of the Act of 1793, which were evidently predicated on these decisions, and passed with a direct reference to them, as held by the Supreme Court in 2 Peters, 14.

In referring to the English adjudications on the statute of James, * we must, therefore, be careful [* 318] to take the expressions of the judges in civil suits at common law, that a "*patent is void*," as not meaning that it becomes void by a judgment in favor of a defendant, on the ground of its invalidity in law ; but only that it is voidable in chancery on a *scire facias* for that cause, and in a court of law, void as a legal foundation for an action for damages. A judgment in a court of law concludes only the parties to the suit, the patent may be given in evidence in other suits against new defendants, till it is cancelled in chancery ; here it becomes annulled by a judgment in favor of a defendant in a Circuit Court, on proof of the kind required by the sixth section, or a judgment in the District Court against the patentee, according to the provisions of the tenth.

In England a patent is granted as a favor, on such terms as the king thinks proper to impose. Godson, 46, 48 ; 4 B. & Ald. 553. Here a patent is a matter of right, on complying

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with the conditions prescribed by the law. 1 Paine, 355. There the patent is not accompanied with a specification; none is filed or enrolled at the time, but it is done within the period prescribed in a proviso, setting forth the requisites of the specification, as conditions to be performed in order to make the patent valid; if not done it declares the patent void. These conditions are in the discretion of the king, but neither they nor the objects or reasons for granting the patent are declared or set forth; but the patent contains a declaration, that it shall be construed and adjudged, most favorably and benignly for the best advantage of the grantee, notwithstanding any defective and uncertain description of the nature and quality of the invention and its materials. Godson, 50, 155, 157, and cases cited; Bull. N. P. 76; 11 East, 107; 14 Ves 136.

In deciding on the sufficiency of these specifications, Lord Mansfield states the questions to be, whether it is sufficient to enable others to make up the thing patented, and the public to have the benefit of the invention after the patent has expired. Bull. N. P. 76, 77; *Liardet v. Johnson*, 1778.

These are the two tests which are applied to the specification, not by the words of the statute, but by the courts, in order to effectuate its supposed policy, as is very clearly expressed by Buller, J., in the *King v. Arkwright*. "The party must disclose his secret, and specify his invention in such a way that others may be taught by it to do the thing for which the patent is granted; for the end and meaning of the speci-

fication are to teach the public after the term for
 [* 319] which * the patent is granted what the privilege expired is, and it must put the public in possession of the secret in as ample and beneficial a way as the patentee himself uses it. This I take to be clear law as far as respects the specification, for the patent is the reward which, under an Act of Parliament, is held out for a discovery, and there-

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fore, unless the discovery be true and fair, the patent is void ; (Davies, 106, 128) ; such is the settled rule in England. Davies, 55 to 60 ; 1 Durnf. & East, 605, 608. In its practical application it has been uniformly held, that the clearness of the specification must be according to the subject-matter of the patent, it is addressed to persons in the profession, having knowledge and skill in the subject-matter, from the nature of their business ; if they can so understand it as to make the thing patented, by following the directions of the specification and plan, taking the old machine to their assistance, without any new invention of their own, then the patent is good, though men ignorant of the subject to which it relates may not understand it. Davies, 56, 128 ; 11 C. L. 472 ; 11 East, 108.

The patentee must specify his invention clearly and explicitly ; any ambiguity affectingly introduced into the specification, or any thing done to mislead the public, will make it void. 1 Durnf. & East, 606, 607. If the specification is sufficient in any part, any other part which is not necessary to understand it may be rejected as surplusage ; (2 H. Bl. 489 ; 11 East, 111) ; one part may be substituted for another. 1 C. & P. 566 ; 11 C. L. 468. If the patentee of an old machine procures a new patent, with certain improvements on the old machine, reciting the old patent, and with a specification of the whole machine so improved, but not describing the new parts or referring to the old specification, the new patent was held good by a reference to the old specification and drawing, and comparing the new with them ; (11 East, 101, 113) ; the patent of Mr. Watt was sustained on the same principle ; the description was held good by referring a workman to the old engine.

The great object of the specification is to prevent the public from being misled by an evasive one having such tendency. A patent is a bargain with the public, in which the

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same rules of good faith prevail as in other contracts, and if the disclosure communicates the invention to the public the statute is satisfied. 14 Ves. 131, 136; 1 Durnf. & East, 606, 607.

As the English statute does not require a specification, these rules and principles are matters of judicial construction, on which the English Courts act without any statutory directions. Their Patent Law is a proviso, excepting from the general prohibition of grants of monopolies by the king, "grants of privilege" "for the sole working or making of any new manufacture within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters and patents shall not use, so as they be not contrary to law," &c. Sect. 5; 3 Ruff. 92. On this proviso their whole system of jurisprudence as to patents is built, by a series of adjudication according to what the judges presumed to be the object and intention of Parliament. The silence of the law left a wide field open to the discretion of Courts, in adopting such rules as would best effectuate its design, and best promote the interests of the public. But in this country the law is more explicit.

The Constitution gives Congress the power "to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." This is a declaration by the supreme law of the land, of its objects and purposes, and the means of effecting them, which leaves no discretion to the judges to assign or presume any other or different ones.

The Acts of Congress, of 1790, (1 Story, 80,) and of 1793, (1 Story, 300,) are the execution by Congress of their constitutional powers; the title of these acts is "to promote the progress of the useful arts;" the mode of doing it is by

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granting patents pursuant to the enacting clauses. The conditions of such grants are prescribed, among which is a specification or description of the invention to be patented, the requisites of which are defined: "and shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in case of any machine, he shall fully explain the principle and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions." As to the specification, then, nothing is left to construction as to its requisites or purposes, both are so clearly defined, and in such a manner, as to leave no discretion in Courts to presume what was intended, to alter, add, or diminish, where the law is so explicit.

* With the Constitution, the English statute, and [* 321] the adjudication upon it before them, Congress have declared the intention of the law to be to promote the progress of the useful arts by the benefits granted to inventors; not by those accruing to the public, after the patent had expired, as in England. This is most evident from their imposing as conditions, that the invention must be new to all the world, and the patentee be a citizen of the United States. If public benefit had been the sole object, it was immaterial where the invention originated, or by whom invented; but being for the benefit of the patentee, the meritorious cause was invention, not importation, and the benefit was not extended to foreigners, in which respects the law had been otherwise settled in England.

Here the patent contains no proviso declaring it void, if the specification is not in conformity with the law; this is

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provided for in the sixth section as a substitute for the proviso, and defines the causes for which a Circuit Court can adjudge a patent void, in a civil suit, for defects in the specification. These are concealment or addition, fully appearing to have been made for the purpose of misleading the public, which is wilful fraud clearly proved ; but the Court cannot bring within this definition of a patent with a specification defective on other grounds, still less act upon the English principle, that the specification is for the purpose of giving the public the benefit of the invention, after the expiration of the patent, as that would be in contradiction to the Act of Congress expressly assigning other reasons. Such has been the uniform construction of the law in the Circuit Courts, that a patent can be declared void for no other defect in the specification than fraudulent concealment or addition. 1 Peters's C. C. Rep. 401 ; 1 Wash. 171 ; 3 Wash. 198 ; 1 Mason, 180, 190 ; 1 Gall. 434 ; 7 Wheat. 429, 430.

No discretion is left to the Circuit Courts to annul a patent for any reason not contained in the Acts of Congress ; they have not left us free to infer motives, objects, and grounds of supposed policy for requiring specifications ; the third section of the Act of 1793, defines them without any declaration, that the patent shall be void if the specification is defective. English decisions, therefore, founded on the assumed reason for the grant of a patent, are not of authority here where the Constitution and laws give other reasons, and omit the one founded on the public benefit to result from the disclosure after the expiration of the privilege. You will, therefore, not make

that a subject of deliberation, for it is not material [* 322] whether the * public can profit by the invention during or after the term of the patent. The true inquiry is whether, in the spirit of the law, the plaintiffs have made such a description of the thing patented as to distinguish it from all others before known, and to enable others

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skilled in the matter, to make, compound, or use it, and to explain the principle and mode of application by which it can be so distinguished from other inventions. If from the patent, specification, drawings, model, and old machine, clear ideas are conveyed to men of mechanical skill in the subject-matter, by which they could make or direct the making of the machine by following the directions given, the specification is good within the Act of Congress. 3 Wheat. 518; 7 Wheat. 435.

If the plaintiffs' patent is valid, it gives them a right of property in the thing patented, which is entitled to full protection in Courts, the wise policy of the Constitution and laws, for securing to inventors the exclusive privilege to use their discoveries for a limited time, has been fully illustrated by the great results produced by the skill of our citizens. Intended for their protection and security, the law should be construed favorably and benignly in favor of patentees, in the spirit of the proviso in patents in England. When the invention is substantially new, is useful to the public, and the disclosure by the specification and other papers, is made in good faith, and fairly communicated in terms intelligible to men who understand the subject, juries ought to look favorably on the right of property and to find against a plaintiff only for some substantial defect in his title papers, or proof.

Having given you our opinion on all the questions of law applicable to the case, it is submitted to your verdict.

If you think the thing patented not new, but had been known or used anywhere, before the application for the patent, you will find generally for the defendants; so you will find, if the alleged improvement is in fact only a change of the form and proportions of the old machine or process.

If you think the specification, &c., not descriptive of the invention, so as to be in compliance with the requisitions of the third section of the law, through accident, mistake, or

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ignorance, you will find for the defendants, and specify the ground of your verdict.

If you think the defect in the specification was intended to mislead the public, or should find against the plaintiffs on any other ground specified in the sixth section, you will [* 323] specify it in your * finding, so that the Court may render the proper judgment, either generally for defendants, or add a judgment the effect of which will annul the patent.

If you think the plaintiffs have made out their case, you will find such damages as they have proved they have actually sustained ; they must prove their damages ; if they have not done so you are not to supply the defect.

Verdict for plaintiffs, 500 dollars.

A motion was made for a new trial for excessive damages, which was argued at October term, 1831.

Mr. C. Ingersoll and *Mr. C. J. Ingersoll*, for defendant.

The jury have exceeded the actual damage sustained by the plaintiff, which the law has made the standard for their verdict.

By the fourth section of the law of 1790, (1 Story, 81,) the plaintiff was to recover "such damages as shall be assessed by a jury ;" by the fifth section of the Act of 1793, "three times the price of a license to use the invention," (1 Story, 302) ; by the third section of the Act of 1800, (1 Story, 753,) "three times the actual damages sustained from or by reason of such offence." The meaning of this clause is apparent by a reference to the statute of James I., section 4, "shall recover three times so much as the damages he or they shall have sustained by means or occasion," &c. (3 Ruff. 92) ; by adding the word "actual," Congress intended to exclude potential or speculative damages ; actual means "real, not poten-

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rial," (Johnson's Dict.) ; " real or effective," " that exists actually," " existing in fact," (Webster's Dict.) ; not what may be ; (1 Gall. 485) ; the Court must decide what are actual damages ; even in case of a tort the jury ought to give the reasons of their verdict ; (Comb. 357 ; 2 Wils. 160) ; the Court may ask them what they have made the standard of their verdict in patent cases. 1 Gall. 485. In 1 Wash. 403, 480, Judge Washington referred to the profitable use of the invention by the defendant. In 3 Wheat. App. 26, the value of the use to the defendant is stated as the rule of damages. The injury done to the character of the plaintiffs was by the defendants making an inferior article ; the reduction of the price by competition are merely speculative damages ; the actual damage sustained, is to be ascertained as in cases of waste, the value of the property or estate wasted. The actual loss sustained by the infringement of a patent, is the * profit made by the defendant while he uses [* 324] the invention, the saving of labor by the improved machine, without regarding the value of the use of the parts not patented ; the difference in the profits resulting from the use of the old as compared with the new, calculated by the time and extent to which the defendants have used it, is the true rule. In this consists the difference between a common law tort and a patent tort, in the former the jury have a discretion in awarding damages, in the latter they have a standard prescribed to them, as definite as on a contract for the payment of money or the delivery of goods ; the damages cannot exceed the interest, so in patent cases, the defendant's profits are the measure of the plaintiff's loss.

Mr. Cadwalader and Mr. Sergeant, for plaintiffs.

The third section of the Act of 1800, is a substitute for the fifth section of the Act of 1793, and actual damages mean, the injury actually sustained, and the consequences of

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the infringement, which are not too remote to be traced to it, the words "for or by reason of," &c., put a patent tort on the same footing as any other tort. 1 Peters's C. C. Rep. 397. A consequence of increased competition is a reduction of profits, the putting an inferior article into the market, tends to throw out the pressed knob and substitute the blown knob in its place, whereas, on a fair comparison, the pressed are preferred. Here, as the infringement has been intentional, the plaintiff ought to recover the difference between the cost and the selling price of the knobs made by the defendants, by the use of the plaintiffs' improvement which the jury have not exceeded, though they might have made an allowance for damages occasioned by wilful vexation, as may be done in trover, (6 Serg. & Rawle, 426); no new trial will be granted, unless there has been a plain mistake in law or fact, 3 Binn. 320; or if damages are too small or too large, unless for some other cause in addition; (1 Wash. 154, 202); the case in Comb. 357, 358, only shows that the jury will not be allowed to exercise a despotic power. In 1 Gall. 485, 350 dollars were given for merely making the machine, and a new trial refused. S. P., 1 Peters, 397. These cases establish the rule that the jury may judge of the actual damage, as in the case of tort generally; those which affect the person or reputation of another are exceptions. The true question is, not what profits the defendants have made by the infringement, but what loss the plaintiffs have sustained; of this the

[* 325] jury are the * proper judges, and the Court will not disturb their verdict, unless they decide positively that the plaintiffs have not sustained 500 dollars damages in any view of the case. The jury may ascertain the damages from any cause which has injured the plaintiff, the difficulty of liquidating them under any definite head, as a matter of account, is no objection to their putting an estimate on the amount; as the loss of sales which the plaintiffs would have

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made had there been no infringement. In a word, the jury may allow the plaintiff whatever they may think from the evidence he has lost by the violation of his right by the defendants, and put him in the same situation as if he had had the exclusive use of his invention during the time the defendants have used it.

The opinion of the Court was delivered by HOPKINSON, J.

The motion for a new trial in this case is rested on the alleged excessiveness of the damages. The Act of Congress gives the rule of damages, and if it has been violated, the verdict ought not to stand; on the other hand, the finding of a jury on a question so peculiarly within their province, will not be disturbed, unless it be made clear that they have disregarded and exceeded the measure of the law.

The Congress of the United States, after two attempts, which proved to be unsatisfactory, to fix the amount of damages to be recovered from any person who should make, devise, use, or sell the thing whereof the exclusive right is secured to a patentee, by an act passed on the 17th of April, 1800, established a rule which has since remained as the law of such cases. The third section of the act enacts, that any person offending as above mentioned "shall forfeit and pay to the said patentee, his executors, administrators, and assigns, a sum equal to three times the *actual damage sustained* by such patentee, his executors, administrators, or assigns, from or by reason of such offence." The practice under this act has been for the jury to find the actual or single damages, which are afterwards trebled by the order or judgment of the Court.

It is obvious that the directions of the last Act of Congress are not, and could not be precise on such a subject, and that a considerable latitude is necessarily given to the jury in estimating what they shall consider to be the actual damage sus-

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tained by a patentee by the violation of his right ; and the Courts of the United States have shown no disposition to draw the power of the jury, in this * respect, within close and narrow limits. The elements of such a calculation in various cases that occur, are so various, and sometimes in their nature so uncertain, that the estimate of a jury must be very extravagant to enable the Court to say, that they have so disregarded the rule of the law, and so clearly exceeded the limits of their authority, that their verdict cannot be supported. Are the jury to take, as the actual damage sustained by the patentee, the benefit or profit made and received by the offender by the use of the invention? or the profit which the patentee would have made by the same use of his invention, but has lost by the illegal interference with his right? May they deduce the latter from the former, and consider proof of the profits made by the offender to be evidence in fact of the injury or damage sustained by the patentee? This is broad ground, on which the jury may rightfully move ; and the error of their calculation must be made clear and certain, before the Court can undertake to correct it by overthrowing their verdict. Still wider limits have been insisted upon for the jury by the counsel of the plaintiffs. They have contended that, as an item in the estimation of actual damages, the jury may examine and determine the loss sustained by the reduction of the price of the articles manufactured by the patented machine, in consequence of the competition brought into the market against them, when the patentee had a right to a monopoly ; and going yet further, they say, that the injury done to the reputation of the manufacture, by the inferior skill and workmanship of the offender, may be fairly and legally brought into the calculation of actual damage. Whether this may or may not be done, must depend upon the particular case under consideration, and the nature of a question of damages shows

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that what may be a good rule in one case, would be altogether inadmissible in another. All the items or elements above mentioned may be brought into the account, provided that there be evidence satisfactory to the jury to bring them within the character and description of "actual damages," *proved in fact* to have fallen upon the plaintiff, "from or by reason of" the offence of the defendant; but they should not be allowed when they are merely hypothetical, imaginary or speculative. It is not enough that injury may have been suffered by these means; the plaintiff has a right to recover only such damages "as he can *actually prove*, and has *in fact* sustained." It must not rest in conjecture, but must be susceptible of proof, and be actually proved.

While the Courts of the United States sitting on patent cases, have *adhered to these principles in [* 327] their construction of the Act of Congress, they have not been inclined to interfere with verdicts, but keeping them within this boundary, have rather given a loose rein to juries in the exercise of their power over the damages. This is abundantly shown by the cases referred to at the bar. In *Whittemore v. Cutter*, decided in 1813, and reported in 1 Gall. 478, the question of the damages to be recovered for the violation of a patent-right, was considered by Judge Story. In that case, the plaintiff proved only that the defendant had made his patented machine, and not that he had ever used it. Here there was neither profit made by the defendant or lost by the plaintiff, nor any reduction of the price of the article manufactured by a competition in the market; nor an injury to its reputation by inferior workmanship. Where, then, are we to look for the constituents of damage in such a case? The counsel for the plaintiffs contended, "that although there is no evidence of actual damage, the jury ought to give damages either to the full value of the expense of making the machine or of the price at which such a machine might be

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sold." The judge rejected these pretensions for the most satisfactory reasons. He stated to the jury, that "it is clear by the statute that only the *actual damages* sustained can be given ;" and he explains this actual damage to mean "such damages as the plaintiff can *actually prove*, and has *in fact* sustained, as contradistinguished to mere imaginary or exemplary damages." This is a rational and satisfactory interpretation of the phrase. The judge thus instructs the jury, that "if they are of opinion that a use of the machine is actually proved, the rule of damages should be the value of the use of such machine, during such illegal use." This language is not exactly precise. It is not clear whether the judge would be understood ; when he speaks of the value of the use of the machine, "he means its value to the illegal use of it, or the value which its owner could or might have derived from it during the time of the illegal use." The rules are or may be very different. If the latter were intended by the judge, it is in fact the *direct* and *actual* damage sustained by the patentee ; if the former, it is the profit or advantage made of the machine by the offender, which may be more or less than the patentee would have derived from it. We see, however, no objection to another explanation of the language of the judge, that is, that the jury ought to take the value of the use of the machine to the spoliator, not as the direct ground of their verdict, but as a test or means by which, in the absence of other proof, they might estimate the damage done to the plaintiff. In either construction the judge meant to conform to the language of the Act of Congress, and affirm the rule he set out with, "that only the actual damage sustained can be given." The jury gave \$350 single damages, finding at the same time, "that the defendant was guilty of making the machine only ;" no attempt appears to have been made to disturb the verdict, although

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the judge had charged the jury, that in such a case, "the plaintiff can recover nominal damages."

The case of *Gray v. James*, decided in this circuit in 1817, and reported in 1 Peters, 394, was an action for violating the plaintiff's patent-right in the art of cutting and heading nails by one operation. Jacob Perkins was the inventor of this machine, which was so defective that, after a trial, it was altogether abandoned; and it did not appear that it had ever been used afterwards by any person. The defects of Perkins's patent were cured by one Jesse Reed, who patented his improved machine; but the two machines were precisely on the same principle. The jury gave a verdict for the plaintiff, and assessed his single damages at 750 dollars. A motion was made on the part of the defendant for a new trial and in arrest of judgment. One of the reasons in support of the motion was, that the damages given by the jury were excessive, and the argument was, that Perkins's machine was acknowledged by himself to be worthless; and that it was in fact thrown away as a useless thing, and was so considered by those who knew any thing about it, consequently his assignees sustained no damage by the use which the defendant made of it. The judge was of opinion that "the premises may be admitted, and yet the argument terminated in what is called a *non sequitur*." We cannot say that we are satisfied with the ingenious reasoning of the learned judge, to support this opinion; nor do we see how the owner of a thing, absolutely worthless, and which he had thrown away as useless, can sustain *any actual damages*, by the use of this thing, made useful only by being combined with something else, or so changed in its operation by an invention to which the owner of the worthless machine had no title or claim. He has lost nothing, he has been deprived of nothing that was of any value to him, what then has been his injury or damage?

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If the Act of Congress had given the advantage or use made by another of a particular machine as the rule of damages, then indeed a worthless invention, made valuable [* 329] by an improvement, might entitle the * inventor to compensation for the use of his invention, and perhaps on principles of equity and justice, he ought to have it. But the law does not take this rule, but the damages actually sustained by a patentee by the use of his invention, and not the value that has been imparted to it by a subsequent inventor; nor the use which such inventor has made of it, provided he has not by such use inflicted any loss, injury, or damage upon the patentee. His damages, and not another's gain, are made the rule for the jury. It is not like the case of *Whittemore v. Cutter*, where the machine made by the defendant was the same with that patented by the plaintiff, and where we have agreed that, in the absence of other evidence, the jury may assume the value of the use of the machine to the spoliator as proof of the damage or injury done to the patentee. The judge who decided the case of *Gray v. James*, seems to be hardly satisfied with supporting the verdict on the reasoning we have quoted, for he adds, "but the fact is that Perkins's machine was proved at the trial to possess intrinsic value on the single ground of saving labor; whether the value so proved justified the jury in finding the damages which they did, is a question of which this body were the proper judges upon the evidence laid before them, and the Court sees no reason to find fault with them."

A patentee, however, whose invention, though worthless to himself, has become useful to another may not be deprived of it without his consent, *for it is his property*; nor can another use it for any purpose without responsibility to him. Such as it is, of much value or little value, or of no value, the law has guaranteed the exclusive possession of it to the in-

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ventor, and the law will prevent any interference with his right, and every use of the thing invented against the will of the owner. Although no damages can be recovered by the provisions of the Act of Congress, in a case where no damages have actually been sustained, the patentee has nevertheless a remedy for the invasion of his right peculiarly appropriate for such a case. He may have an injunction upon the wrongdoer, which will prevent the unauthorized use of his invention, and put it in his power to compel the invader either to abandon it or make him a just compensation for the use of it. The Court would exercise this power, to do what is right and equitable between the parties, and so as to prevent imposition and wrong by either.

Without embarrassing the question now to be decided with a review of all the evidence that has been brought into the discussion, * it will be sufficient to advert [* 330] to the admitted fact that the defendants manufactured five hundred and seventy-one dozen of glass knobs, by the use of the machine invented and patented by the plaintiffs ; all of which were sold by the defendants, with the exception of some that were imperfect. From the bill produced of one of the sales, these knobs were sold at a great profit. The profit obtained by the defendants on the sale of these knobs was a fair and legal subject for the calculation and judgment of the jury on the evidence laid before them ; and they had the same right to take this profit as the rule or measure by which they would estimate the actual damage sustained by the plaintiffs by this invasion of their rights. Although the profit gained by the defendants is not the amount to be recovered by the plaintiffs as their damage, yet it is that from which a calculation or estimate of that damage may be rightfully made by the jury. If in this case the jury have taken this profit as their guide and measure in assessing the actual damage sustained by the plaintiffs, can the Court say that

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they have done wrong, or that, under the evidence laid before them, we could give them a better rule? Can we say that they have exceeded the power and discretion allowed to them, so that it becomes the duty of the Court to undo all that they have done, and set aside their verdict as contrary to the law or evidence of the case? We think not.

If the payment of the sum for which a judgment must be rendered against the defendants shall be oppressive or inconvenient to them, we shall regret it, because they appear to have acted under a mistaken opinion of the rights of the plaintiffs, from misinformation in relation to the validity of their claims of invention, and not from an obstinate or malicious design to injure them or benefit themselves by a wilful disregard of the rights of the plaintiffs. An intelligent and impartial jury have passed upon the case; "and the Court sees no reason to find fault with them." The plaintiffs having established their right, and having no reason to apprehend any further interference with it, it would have been satisfactory to the Court if some reasonable and liberal compromise could have been made with the defendants, who appear to be industrious and useful mechanics, which would have made our judgment unnecessary. We do not feel authorized to press the suggestion further.

Rule discharged.

JOSEPH GRANT AND OTHERS v. E. AND H. RAYMOND.

[6 Peters, 218. January T. 1832.]

Action for damages for an infringement of a patent-right, granted to the plaintiff in 1825. The plaintiff recited that a former patent had been issued in 1821, to the same person, for the same improvement, "which had been can-

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called, owing to the defective specification on which the same was granted." The exclusive privilege given by the patent on which the suit was brought, is to continue fourteen years from the day on which the original was issued. On the trial, the defendants objected that the Secretary of State had no power, by law, to accept a surrender of, and to cancel the first letters-patent; or to inquire into, and decide upon the causes for so doing; or to grant the second patent for the same invention with an amended specification, for the unexpired portion of the term of fourteen years which had been granted by the first patent. The Circuit Court of the southern district of New York decided, in conformity with its former decisions, that such surrender might be made when the defect arose from inadvertence or mistake; and without any fraud or misconduct on the part of the patentee: and that the Secretary of State had authority to accept such surrender, and cancel the record of the patent; and to issue a new patent for the unexpired part of the fourteen years granted under the first patent. By the Court: It will not be pretended that this question is free from difficulty. But the executive departments, it is understood, have acted on the construction adopted by the Circuit Court, and have considered it as settled. We would not willingly disregard the settled practice, in a case where we are not satisfied it is contrary to law; and where we are satisfied it is required by justice and good faith.

To promote the progress of useful arts, is the interest and policy of every enlightened government. It entered into the views of the framers of our Constitution, and the power "to promote the progress of science and useful arts by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries," is among those expressly given to Congress. It is the reward stipulated for advantages derived by the public for the exertions of individuals; and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought to be construed in the spirit in which they have been made, and to execute the contract fairly on the part of the United States, where the full benefit has been received; if this can be done without transcending the intentions of the statutes, or countenancing acts which are fraudulent, or may prove mischievous.

If a mistake should be committed in the department of State, no one would say it ought not be corrected. All would admit, that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued; and yet the law does not, in terms, authorize a new patent, even in such a case. Its emanation is not founded on the words of the law, but it is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken, for the same purpose, if the mistake has been innocently committed by the inventor himself?

The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals; and the means it employs are the compensation made to those individuals for the time

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[*219] and labor * devoted to those discoveries, by the exclusive right to make up and sell the things discovered for a limited time. That which gives complete effect to this object and intention, by employing the same means for the correction of inadvertent error, which are directed in the first instance, cannot be a departure from the spirit and character of the act. *Quære*, What would be the effect of a second patent, issued after an innocent mistake in the specification, on those who, skilled in the art for which it was granted, perceiving the variance between the specifications and the machine, had constructed, sold, and used the machine. This question is not before the Court, and is not involved in the opinion given in the case. The defence, when true in fact, may be sufficient in law, notwithstanding the validity of the new patent.

The defendant in the Circuit Court, in his plea, assigned the particular defect supposed to exist in the specification, and then proceeded to answer in the very words of the act, "that it does not contain a written description of the plaintiff's invention and improvement, and manner of using it, in such full, clear, and exact terms, as to distinguish the same from all other things before known, so as to enable any person skilled in the art to make and use the same. The plea alleged, in the words of the act, that the prerequisites to issuing a patent had not been complied with. The plaintiffs denied the facts alleged in the plea, and on this issue was joined. At the trial, the counsel for the defendants, after the evidence was closed, asked the Court to instruct the jury, that if they should be of opinion that the defendants had maintained and proved the facts alleged in their plea, they must find for the defendants. The Court refused this instruction, and instructed the jury that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design, or for the purpose of deceiving the public. By the Court: The instruction was erroneous, and the judgment of the Circuit Court ought to be reversed.

This instruction was material if the verdict ought to have been for the defendants; provided the allegations of the plea were sustained, and if such verdict would have supported a judgment in their favor; although the defect in the specification might not have arisen from design, and for the purpose of deceiving the public. That such is the law, the Court is entirely satisfied. The third section of the act requires, as preliminary to a patent, a correct specification and description of the thing discovered. This is necessary in order to give the public, after the privilege shall expire, the advantage for which the privilege is allowed, and is the foundation of the power to issue a patent. The necessary consequences of the ministerial character in which the secretary acts, is, that the performance of the prerequisites to a patent must be examinable in any suit brought upon it. If the case was of the first impression, the Court would come to this conclusion; but it is understood to be settled.

Courts did not, perhaps, at first, distinguish clearly between a defence which would authorize a verdict and judgment in favor of a defendant in an action

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for the violation of a patent, leaving the plaintiff free to use his patent and to bring other suits for its infringement ; and one which, if successful, would require the Court to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. This distinction is now well settled.

If the party is content with defending himself, he may either plead specially, or plead the general issue and give the notice required by the sixth section, of any * special matter he means to use at the trial. If he [* 220] shows that the patentee has failed in any of those prerequisites on which the authority to issue the patent is made to depend, his defence is complete. He is entitled to the verdict of the jury, and the judgment of the Court. But if, not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity with the sixth section. If he depends on evidence "tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the desired effect ;" it may avail him so far as respects himself, but will not justify a judgment declaring the patent void ; unless such "concealment or addition shall fully appear to have been made for the purpose of deceiving the public ;" which purpose must be found by the jury, to justify a judgment of *vacatur*.

The defendant is permitted to proceed according to the sixth section, but is not prohibited from proceeding in the usual manner, so far as respects his defence ; except that special matter may not be given in evidence on the general issue, unaccompanied by the notice which the sixth section requires. The sixth section is not understood to control the third. The evidence of fraudulent intent is required only in the particular case, and for the particular purpose stated in the sixth section.

THIS case came before the Court, in the first instance, on a certificate of division in opinion in the Circuit Court of the United States for the southern district of New York.

On inspecting the record, it appeared that on the trial of the cause in the Circuit Court, the counsel for the defendants had excepted to the decisions of the Court on various matters which had been presented for the consideration of the Court ; and that a bill of exceptions had been sealed by the Court on their motion.

The record proceeded to state, that the cause afterwards came on for argument on a motion for a new trial, when the opinions of the two judges of the Circuit Court were opposed

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upon questions, presented for the decision of the Court, excepted to on the trial, as stated in the bill of exceptions: "that upon the questions thus occurring before the Court, the opinions of the said two judges were opposed; and upon request of the counsel for the plaintiffs, the points upon which the disagreement happened, were stated under the direction of the judges, and certified under the seal of the Court to the Supreme Court."

Mr. Webster stated, that a question, preliminary to the argument of the case, was presented for the decision of the Court. It was, whether the Court would entertain the case as it came up from the Circuit Court on a division [* 221] in that Court on a motion * for a new trial. This

Court had exercised their right to decide in cases where the opinions of the judges of the Circuit Court on questions of law had been opposed, when a motion for a new trial was before the Court.

Mr. Justice Story. In the cases referred to, the division of the Court took place on the trial of the cause before the jury, as well as on the motion for a new trial.

Mr. Chief Justice MARSHALL suggested that the case might be brought on if the parties would agree that it should stand as if a judgment had been given by the Circuit Court on the exceptions. The case, he said, could not be heard on a difference in opinion of the judges of the Court, on a motion for a new trial.

The counsel for the plaintiffs and defendants having agreed that the case should stand as suggested by the Chief Justice, and an agreement in writing to that effect having been filed, the Court made the following order.

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It is now here by the Court considered and ordered, that this cause shall now be heard and decided, as on a writ of error brought after verdict and judgment in the Circuit Court, on the exceptions which were taken in that Court; that the cause shall now proceed, as if judgment had been actually entered in the Circuit Court for the plaintiffs there, and that the certificate in the case shall be taken, regarded, and treated as a writ of error, sued out by the defendants below, on the judgment of the Circuit Court, and that the question shall be, as in other cases, whether the said judgment ought to be reversed or affirmed: but that this Court will reserve its opinion and judgment in this cause till the defendants in the Court below shall have sued out a writ of error in this cause to the said Circuit Court, and filed a return thereto, with a bill of exceptions in this cause, in the usual form, signed by the Court below, in this Court.

The case came on for argument, after the defendants had sued out a writ of error on a judgment entered in the Circuit * Court for the plaintiffs, in conformity [* 222] with the suggestion and order of this Court. The case was as follows:

The action was brought to recover damages for an alleged infringement of a patent-right, and came on for trial in the Circuit Court in November, 1828, when a verdict was rendered for the plaintiffs for three thousand two hundred and sixty-six dollars sixty-six cents.

The plaintiffs gave in evidence a patent from the United States, in the following terms, the same being the patent declared upon:

“Whereas Joseph Grant, a citizen of the United States, hath alleged that he hath invented a new and useful improvement in the mode of manufacturing hat bodies by the combination of motions, namely, the rotary and revolving motion,

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with the vibrating or transverse motion, which forms the two hat bodies by machinery, and crosses the wool from one extremity of the hat bodies to the other at one operation, called Grant's improved winding machine for setting up hat bodies — his former patent for the same invention, dated the 11th day of August, 1821, having been cancelled, owing to the defective specification on which the same was granted — which improvement he states had not been known or used before his application — hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement; hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose.

“These are, therefore, to grant, according to law, to the said Joseph Grant, his heirs, administrators, or assigns, for the term of fourteen years, from the 11th day of August, 1821, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Joseph Grant himself in the schedule hereunto annexed, and is made a part of these presents.

“In testimony whereof, I have caused these letters to be made patent, and the seal of the United States to be hereunto affixed. Given under my hand, at the city of
[* 223] Washington, this 28th * day of April, in the year of
our Lord 1825, and of the independence of the
United States of America the forty-ninth.

[L. s.]

J. Q. ADAMS.

By the President. H. CLAY, Secretary of State.

City of Washington, to wit: — I do hereby certify, that the foregoing letters-patent were delivered to me on the 26th

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day of April, in the year of our Lord 1825, to be examined ; that I have examined the same, and find them conformable to law, and I do hereby return the same to the Secretary of State within fifteen days from the date aforesaid, to wit, on this 28th day of April, in the year aforesaid.

WILLIAM WIRT,

Attorney-General of the U. S.

The schedule referred to in these letters-patent, and making part of the same, contained a description, in the words of the said Joseph Grant himself, of his improvement in the mode of manufacturing hat bodies by the combination of motions, namely, the rotary or revolving motion, with the vibrating or transverse motion, which forms the two hat bodies by machinery, and crosses the wool from one extremity of the hat bodies to the other at one operation, called Grant's improved winding machine for setting up hat bodies ; his former patent for the same invention, dated on the 11th day of August, A. D. 1821, having been cancelled, owing to the defective specification on which the same was granted.

The schedule, which contained a full description of the invention, and of the mode of using it, was also given in evidence.

The counsel for the plaintiffs also produced and read in evidence a certificate of the Secretary of State, duly authenticated under his hand and official seal, and certain papers thereto annexed, in the words and figures following :

To all to whom these presents shall come greeting :

I certify that the annexed is a true copy of the record of cancellation of a patent granted to Joseph Grant on the 11th of August, 1821, and cancelled on the 28th of April, A. D. 1825 ; also, that the annexed is a true copy of the petition praying for the cancellation, and the issuing of another patent for the same invention.

In testimony whereof, I, Henry Clay, Secretary of State

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of the United States, have hereunto subscribed my
[* 224] name, and * caused the seal of the department of
state to be affixed. Done at the city of Washing-
ton, this 19th day of May, A. D. 1828, and of the independ-
ence of the United States of America, the fifty-second

[L. s.]

H. CLAY.

This patent was returned to the Patent Office, the seal
broken, and now stands cancelled, owing to the defective
specification on which it was issued, and another patent grant-
ed (with a corrected specification) on the 28th day of April,
1825, bearing date with the first, and for the same invention.

The petition of Joseph Grant, of Providence, in the county
of Providence, and State of Rhode Island, hatter, a citizen of
the United States of America, respectfully represents, that
your petitioner has invented a new and useful improvement
in the mode of manufacturing hat bodies by the combination
of motions, namely, the rotary or revolving motion with the
vibrating or transverse motion, which forms the two hat
bodies by machinery, and crosses the wool from one extremity
of the hat bodies to the other at one operation, called
"Grant's improved winding machine for setting up hat
bodies," according to the specification, explanations, and
drawings, herewith presented ; which the subscriber prays
may be taken as a part of his petition — an improvement not
used or known before his application, the advantages of
which your petitioner is desirous of securing to himself and
his legal representatives.

Your petitioner would further state, that he has, heretofore,
namely, on the 11th day of August, A. D. 1821, obtained
letters-patent from the President of the United States for his
said improvement, but, owing to a defective specification on
which the same were granted, he prays that the said patent
may be cancelled, and a new and correct one granted, em-
bracing the same improvements, so far as the same are set

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forth in the accompanying specification, drawing, and explanations. Your petitioner therefore prays that letters-patent of the United States may be issued, granting to your petitioner, his heirs, administrators, or assigns, the full and exclusive right of making, constructing, using, and vending to others to be used, his said improvement, according to the specification and drawings hereto annexed, agreeably to the Act of Congress in such case made and provided ; your petitioner having paid thirty dollars *into the [* 225] treasury of the United States, and complied with other provisions of the said act. As in duty bound, will ever pray.

JOSEPH GRANT.

To the Hon. Henry Clay, Secretary of State of the United States of America.

Providence, April 20, 1825.

As the assignee of David Curtis, who was the assignee of Joseph Grant, of one moiety of the original patent, I unite in the prayer of the above petitioner, that the original patent may be cancelled, and a new one granted to the said Joseph Grant, as above set forth.

SOLOMON TOWNSEND.

To the Hon. Henry Clay, Secretary of State of the United States of America.

Providence, April 20, 1825.

The counsel for the defendant objected that the Secretary of State had no power, by law, to accept a surrender of and to cancel said letters-patent, or to inquire into or decide upon the causes for so doing, or to grant said second patent for the same invention, with an amended specification, for the unexpired portion of the term of fourteen years, which had been granted by the first patent.

The Court decided that such surrender might be made, when the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee ; and that the Secretary of State had authority

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to accept such surrender, and cancel the record of the patent, and to issue a new patent for the unexpired part of the fourteen years granted under the old patent in manner aforesaid. To which decision the counsel for the defendant excepted.

The fourth plea, filed on the part of the defendant, after reciting the specification annexed to the patent of the plaintiffs, averred as follows: "And the defendants aver that said specification does not correctly or accurately describe the improvement claimed by the said Joseph Grant as his invention; but said specification, and the drawings thereto annexed, are altogether defective in this, among other things, namely: in said specification no proportions, sizes, or distances, are given, and the bigness or size of none of the principal parts of said machine is given in said specifications or drawings, but the same is wholly omitted; and, in [* 226] other particulars, said specification *and drawings are altogether defective. And the defendants aver that said specification, annexed to and making part of said letters-patent, with the drawings thereto annexed, do not contain a written description of his, the said Joseph Grant's invention and improvement aforesaid, and manner of using it, in such full, clear, and exact terms as to distinguish the same from all other things before known, and so as to enable any person skilled in the art of which said machine or improvement is a branch, or with which it is most nearly connected, to make and use the same; and that, for the cause aforesaid, said letters-patent are void. All which the defendants are ready to verify; wherefore they pray judgment if the said Joseph Grant and Solomon Townsend ought to have or maintain their aforesaid action against them, and for their costs." To which plea the following replication was filed:

"And as to the plea of the said Eliakim Raymond and Henry Raymond, by them fourthly above pleaded, the said

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Joseph Grant and Solomon Townsend say, that, by reason of any thing in the said last-mentioned plea alleged, they ought not to be barred from having and maintaining their aforesaid action thereof against them, the said Eliakim Raymond and Henry Raymond, because they say that the specification mentioned in the said last-mentioned plea does correctly and accurately describe the improvement claimed by the said Joseph Grant, as his invention ; and because they say further, that neither the said specification, nor the drawings thereto annexed, are defective in any of the particulars in that behalf alleged in the said last-mentioned plea ; and this they, the said Joseph Grant and Solomon Townsend, pray may be inquired of by the country ; and the said Eliakim Raymond and Henry Raymond do the like," &c.

The counsel for the defendants on the said trial introduced sundry witnesses to prove the allegations traversed in the said fourth plea, and insisted that they had proved the same, and that the said specification of the said Joseph Grant did not describe the improvement which he claimed to have invented, in such full, clear, and exact terms as to distinguish the same from all other things before known, nor so as to enable a person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make and use the same ; * and they requested the Court [* 227] to charge the jury, that if they found that the defendants had maintained and proved their averments in that respect, that they must find the same for the defendants ; which instructions the Court refused to give, but instructed the jury that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design, and for the purpose of deceiving the public ; to which opinion the counsel for the defendants also excepted.

The case was argued by *Mr. Webster*, for the defendants

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in the Circuit Court, now before the Court as plaintiffs in error; and by *Mr. Ogden*, for the defendants, plaintiffs in the Circuit Court.

Mr. Webster stated, that the first question for the decision of the Court was, whether the Secretary of State can accept the surrender of a patent, cancel it, and grant a new one for the unexpired term for which a patent had been granted, on a suggestion that the specification is defective through inadvertence or mistake?

It cannot but be doubted whether such cancellation can be made anywhere, so as to take out a new patent.

The whole system of patents rests on statute provision. There is no common-law power, or prerogative right, in the President to issue a patent. In this particular, our law is different from the English. *Ours* is a statute grant; theirs is an emanation out of a statute prohibition. With us, the fountain is statute; with them, *prerogative*. Our statute makes no provision for any surrender, and the issuing of a new patent thereon. Indeed, it seems impossible to reconcile such a proceeding to the requisitions of the act.

How can the patentee allege, or assign for his second patent, that *his improvement had not been known before that application*. That is a statute requisition; here, in the case before the Court, it had been in use three years. The party must claim, and in this case does claim, under his second patent, as a new and substantive patent; not under his first, with an amended specification.

On surrender or cancellation of the patent, the party comes for a new patent, for the same invention. Now, in [* 228] all such * cases, it must be that the thing has been used or known before that application. In this very case, it does not appear that his petition contained the *statute requisites*; it refers it to *his former application*.

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But however this may be, the Secretary of State has no authority to make a record of cancellation, and to issue a new patent. The Secretary of State is a merely ministerial officer. All the laws relating to granting patents regard him as merely ministerial. His department is denominated an executive department. He has no where any particle of judicial power. On the subject of patents, as well as all others, he acts wholly ministerially.

By the first Patent Law, April 10, 1790, the Secretaries of State, War, and Attorney-General, were invested with authority to grant or refuse patents. But this was repealed by the existing law of February 21, 1793. The power of granting or withholding patents, was by this act taken away from everybody. The Secretary was to give the patent out, on certain requisitions being complied with, without exercising any judgment, or making any inquiry; and the patent was to avail the grantee what it might, according to the truth of the representations of the patentee. It is matter of right, and matter of course, to issue the patent; if the requisites of the law be complied with. The Secretary has nothing to do but make out the patent.

He is applied to as keeper of the seal. And if a dispute arises between inventors, the Secretary cannot decide it; he is to appoint umpires. Sect. 9. He is not trusted to decide even whether the *form* of the letters-patent be conformable to law; that belongs to the Attorney-General.

The general power of the Secretary is commented on in *Marbury v. Madison*, 1 Cranch, 159, 160. He is to record diplomatic transactions; but he cannot alter or cancel those records. He records treaties and Acts of Congress; but those, of course, he cannot alter.

The Secretary has no power to record in his office any transaction, not his own, except so far as authorized by statute.

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In regard to patents, the statute declares what shall be recorded.

1. The patent itself. 2. The assignment of it [* 229] if requested. * These are all. The Secretary has nothing more to do. As to cancelling a patent, he is *functus officio*.

The breaking the seal, or other cancellation by the patentee of his patent, is just as effectual if done anywhere else as if done at the State department. It is not a transaction which the law has prescribed for recording anywhere. He can neither authorize this cancellation nor forbid it, nor make it matter of official record.

The vacating and cancelling the record of a patent is in its nature a judicial act. The Act of 1793 treats it as such, and provides two modes of such vacation. Cited the 6th and 10th sections of the act.

The common law, also, provides a mode. *The Court cannot add a new section to the act.*

In England, the repealing of patents is always regarded as a judicial act. Godson on Patents, 200.

The limitations, under which the Court below thought the Secretary could vacate one patent and issue another, show that the power he is expected to exercise is judicial. The defect must arise from inadvertence or mistake, without fraud or misconduct. The power of the Secretary to act, then, depends upon his having adjudged the case to be one of mistake, and not a case of fraud. This is judicial power. How can the Secretary make this judicial investigation.

1. He has no parties before him, and no power to bring persons before him. When done in Court, this is done in the presence of *litigant parties*. 2. He cannot summon witnesses before him, and if they should come voluntarily, he cannot administer an oath to them. Such oaths would be extra-judicial and nugatory. He cannot require the party's own oath.

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Now, whether the want of a proper specification be the effect of accident or of fraud, is a question of fact ; and it is to be decided by the Secretary, without parties, oaths, or witnesses.

Besides, the surrender is to be accepted only when the specification is defective. Is not that very question a question of fact, or a mixed question of law and fact ? Certainly it is. It is for the jury : even a Court cannot determine it without a jury.

By Act of April 20th, 1818, the Secretary of State appoints a *superintendent*. Does he delegate to him his judicial power ?

* There is but one way of answering this view of [* 230] the subject. It must be contended, that in every case, on the mere suggestion of the patentee, a new patent is to be issued for the residue of the term, with an amended specification : leaving it to be decided, when suit should be brought, whether the defect was inadvertent or fraudulent.

This would change the whole Patent system. Its effects would be monstrous. Patentees would try their claims under one specification ; they might fail ; and they would call it *inadvertence*, and try another experiment.

A man builds an expensive factory, puts in costly machinery, not patented, not described in any specification ; he expends much money ; by and by, he is sued for violating a patent, and he finds that since he built, an old patent has come out with a new specification. A hearing, of which he knew nothing, has been had before the Secretary, and a new patent has issued, and he is called on to stop his factory. Now this supposed case is the very case before the Court. The defendants erected their works in 1823, 1824. They knew of the plaintiff's patent of August 11, 1821, but it did not describe any machinery used by them. But in 1825 he surrendered his first patent, took out another, with a specifi-

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tion *describing their machinery*, and sued them. Under the direction of the Court he has recovered a verdict for three thousand two hundred and sixty-six dollars ; and is entitled of course, to have this *trebled*, and the defendants are ruined. *Is this legal?* A bill in equity is pending also, to stop the defendants' factory.

Now, what reason is there for saying that defendants shall suffer these losses, even by the mistake or inadvertence of the patentee. The invention had become public, and if not protected by the first patent, it was gone forever. A bad patent is no patent. 1 Barn. & Ald. 386. It may be well for Congress to give the Courts or judges power to vacate patents on patentee's own motion ; but then Congress would provide limitations and securities for innocent persons. On the doctrine of this case there are no securities.

What are the consequences of such a principle? A man finds out that there are other machines made like [* 231] his, which he * would like to *stop* ; he sets up in advertence, gets a new patent, and stops them. *If he swears it, who can deny it? It is of younger date, and he swears he meant to describe it.* This would furnish irresistible temptation to perjury.

There is a deeper objection. A man makes an *invention* ; he gets a patent, but his specification does not describe it, but describes something else. In the mean time, the public use, not what he has patented, but what he has not. Now, how is the public to be deprived of the use of this? It is denied that they can be prevented this use. The decision of this Court in *Pennock v. Dialogue*, proves this cannot be. The invention was used and known before it *was patented*. A patent, not describing an invention, is void as to that invention, and does not protect it. The invention, by a single month's use, unprotected by a patent, becomes public property and can never be resumed.

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Whether the patent be void through fraud or inadvertence, if it does not describe the invention, then the invention is not protected, but *has become public property*. Pennock v. Dialogue so decides.

In England a *scire facias* to repeal a patent is a criminal proceeding, and does not allow costs. 7 Term Rep. 367; Godson, 201.

This case was tried in New York before Pennock v. Dialogue was decided in this Court.

The only case applicable to the one now before the Court is Morris v. Huntington, 1 Paine, 348. That was decided in 1824. Its doctrine was materially charged by Pennock and Dialogue. After all, that case only decides, that a patent, while another is in existence, is void. The judge then goes on to say, it may be surrendered.

It seems admitted that the new patent ought not to reach back so as to affect those who had already used the invention. But how can this distinction be made? Cited to this point, Brooke v. Clarke, 1 B. & A. 396, note.

The great and conclusive objection is this; the new patent is granted on the new application, and the invention had been public four years. This is fully settled in the case of Pennock v. Dialogue.

The second point is presented on the defendants' fourth plea. * The Court instructed the jury that [* 232] the patent would not be void, unless the defective or imperfect specification arose from design, or the purpose of deceiving the public.

This point presents two questions.

1. Whether the patent would be void or not, for the reasons stated; the direction of the Court was not pertinent to the issue. The parties were at issue on a question of fact; witnesses were examined, and counsel had summed up; but the Court told the jury the issue was *immaterial*, and under this question the jury found a verdict for plaintiff.

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It can require no argument to prove that this is an illegal direction. 2 Day's Reports, 519; 1 Starkie, 388; 9 Cranch, 339, 355.

2. If the question had legally arisen, the law was wrongly stated.

It is insisted, that the plea was a good bar. If the specification was defective, as set forth in the plea, the plaintiff could not recover, whether that defect arose from accident or design. The very words of the third section of the statute require this. There are certain conditions precedent to be complied with, *before an inventor can obtain a patent*. This is one of them. The language of this section is emphatic and absolute; it could not be stronger. Courts may just as well *dispense with the oath*.

Suppose he omit to deliver any written specification whatever; can he afterwards say that omission was owing to inadvertence? *Yet a defective specification, or bad specification, is no specification*. The same law that requires a written specification, requires a *full and accurate one*. A defective one is no better than none at all. Suppose he omit to sign the specification, can that be cured?

A party is to describe his invention so as to answer two purposes:

1. To distinguish it from all other things before known.
2. To enable any person skilled in the art to make and use it. If he fail in either of these, he fails in a condition precedent.

This is all very clear, and there would be no doubt about it but for the sixth section. That section has been supposed to raise the doubt.

This section, as has been observed by most [* 233] judges, is inartfully * drawn. It speaks of the right of a defendant to *give this act in evidence, in an action founded on the act itself*. It is not grammatical. It seems borrowed from the law of 1791.

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The first important remark is, that the preceding sections have described the whole extent of the patentee's right. This section has for its object, the giving of immunities and protection to those who may be sued by patentees. Therefore, its object was not to enlarge the right of patentees. Second, most of its provisions are only affirmative, and the right existed before. The action being case, all the material defences are competent. Third, it gives some matters as a defence not mentioned in the first act, such as license or abandonment to the public. Fourth, it does not repeat *the same* objections to specification.

It allows the defendant to prove three things as fatal defects in his specification. 1. That it does not contain the whole truth relative to the discovery, with intent to deceive the public. This provision may stand with the first section. 2. That it contains more than is necessary to produce the described effect: with intent to deceive the public. This may stand with the third section. 3. That the thing had been used, or described in a public work. This may also stand.

Now, the fraudulent intent is applied only to the two first. In these cases Congress may say that fraud shall be proved; because, even with these defects, it may be a patent, and a very useful patent.

It may be a valid patent, though the patentee take it but for part of his invention; yet if he fraudulently deceive the public by keeping back part, it shall be void. So it may be a good and valuable patent, though it contain more than is necessary to produce the described effect. But if it be not so described as to be distinguished from other things before known, or so that skilful persons can use it, it is *no patent*, or *of no use at all*. These last objections go to its very existence; and are therefore made prerequisites. They are absolute conditions precedent.

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But the main consideration yet is, that this sixth section has an object of its own. It looks, not so much to the defence in its suits, *as to the judicial vacation of the patent.*

It does not look mainly to the defence of the [* 234] suits, because it leaves * out several known grounds of defence. 1. License. 2. Abandonment to the public. 3. That the patent is broader than the invention. 4. That the machine is not well described. All these are defences, and yet not mentioned here.

The object of the sixth section is like that of the tenth, to *repeal for fraud proved.* All this may stand, without contradicting the third section, or doing violence to its language.

Indeed, Pennock and Dialogue, (2 Peters, 1,) has apparently decided this. The sixth section speaks of inventions *known before the patentee's discovery.* This does not contradict the third section — “*known before application.*” The Court has settled this, and it decides this case.

The plaintiff relied below on the following cases. Park v. Little and Wood, 3 Washington, 196, in April, 1813; Gray et al. v. James, 1 Peters's C. C. Rep. 401, 1817.

But it does not appear in this case whether the defendant was or was not proceeding with a view to vacate the patent. Most probably he was; for at that time such was the practice. This is rendered still more probable by a decision looking the other way in 1820, by the same judge. Kneass v. Schuylkill Bank, 4 Wash. C. C. Rep. 13. *This case is clearly for the plaintiffs in error.*

The case of Whittemore v. Cutter, 1 Gallison, 419, decided in May, 1813, was probably a case *to vacate*; at any rate the judges doubted, and would have divided if the case had turned on this point. The case of Lowell v. Lewis, 1 Mason, 183, in 1817, was probably a similar case; page 189 cited particularly.

How can the Court dispense with the express words of the

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third section. Here they are put into the form of a *special plea*; *can they be disregarded*? Suppose there be but one witness; though this is merely a *formal* requisite, can the Court dispense with it?

Besides, why should the statute require a specification, unless *it was to be full and accurate*? For what purpose should an insufficient *specification be enjoined*? The Court may as well say *there shall be none*. The statute says as imperatively what the specification shall contain, as that there shall be a specification at all. If an imperfect or defective specification does not render a patent void, *what harm does it do to it*? Let this question be answered.

* Now, the patentee says his specification in [* 235] 1821 was *defective*, not through fraud, but *defective*. But why was not that patent good, or this? If defective through fraud, he could not get another. It must be presumed to be defective through *inadvertence*. If so, what need of a new one?

Compare the two rules of law decided in this case together.

1. The judge held, that a party might surrender his patent and take a new one, when the specification in the first was defective through mistake, and without fraud. 2. The Court ruled, that though a specification be altogether defective, yet the patent is not void, unless such defect arise from design.

How can these things stand together? If the last proposition be true, all inquiry about the first is idle; unless the question be, whether a man having one good patent may surrender it and take out another good one for the same thing.

It is now matter of settled law, that if a patent be broader than the invention it is void; and it is never inquired whether this arise from design or accident. In nine times out of ten it arises from *inadvertence*. Now, on what principle is this? Not because the plaintiff's *invention* has not been invaded.

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It may have been exactly copied. It is because he has not rightly described what he *claimed*, and therefore his patent protects him in nothing.

So if a patent be for an improvement of an old machine, it must state the improvement accurately, and distinguish between what is old and what new.

Finally, the English statute has always been construed the other way.

Our sixth section is a substitute for the English *scire facias*. Cited Davis's Patent Cases, 413 ; Godson, 124 ; Holroyd, 100, note.

Cited also Dodson's Patents, 56 ; 1 Term Rep. 605 ; 1 Wash. C. C. Rep. 71 ; 3 Wash. C. C. Rep. 198 ; 1 Mason, 189, 190 ; 4 Id. 9, 10 ; 3 Wheat. 518 ; 2 Hen. Black. 478 ; 1 Ves. and Beames, 67 ; 8 Term Rep. 101 ; 2 Car. and Paine, 558, 555 ; 11 East, 107 ; 14 Ves. 131.

Mr. Ogden, for the defendants in error.

The first question is, whether the Secretary of State of the United States has a power by law to accept of the [* 236] surrender of * and to cancel a patent which had once been issued, and to grant a second patent for the same invention, with an amended specification for the unexpired portion of the term of fourteen years which had been granted by the first patent ?

Upon this question there is not known a single case where the point has been expressly decided in the United States. The Patent Law is silent upon the subject ; and the question must then be decided upon general principles.

A patent for a useful machine is a grant of the exclusive privilege of making and using the machine for a limited time. Now it would seem that a *grantee* may surrender his grant. A man who has a privilege may *surrender* that privilege. If a man cancels his patent upon record, it amounts to a *surrender* of it.

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The difficulty in question, if there be any, must be in the other branch of it. Has the Secretary of State the power, after the surrender of one patent, to grant a new one for the same invention, with an amended specification for the unexpired portion of the term of fourteen years which had been granted by the first patent? Why should he not? When the first patent is cancelled, the invention is unprotected. If a useful one, why should not the inventor have the benefit of it?

He certainly never intended to abandon the benefit of it to the public. His first patent is evidence of that.

A specification requires to be drawn with great accuracy. Mechanics, by whom machines are usually invented, it cannot be supposed are capable of drawing a proper specification. Can it be supposed that the law ever intended to punish their ignorance in drawing a very special legal paper by a forfeiture of all the advantages of their invention?

It is apprehended that the issuing a new patent in England, where there has been no sufficient specification to comply with the condition of the first patent, is pretty much a matter of course.

In the case *Ex parte Beck*, 1 Bro. Ch. Rep. 575, the Lord Chancellor says, "that perhaps upon the petitioner's applying for a new patent, the officers might, under these circumstances, be induced to remit their fees; but that he could give no relief upon the present petition." Here the Lord Chancellor speaks of the issuing of a *new* patent as a matter of course.

*In our Patent Law, the inventor must file his [*237] specification before he can procure his patent. In England, the patent contains upon its face a condition that if the patentee shall not make and file a specification within a limited time *after* the date of the patent, then the patent, and all the liberties and advantages under it, shall cease and be void.

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One of the cases cited by the plaintiff in error shows that the specification is not filed within the time mentioned in the patent; although the patent is void, a new one may be taken out by the inventor for the same invention.

This case, in principle, seems to support the proposition for which the defendant in error contends; that if a first patent is void for want of a specification, or for want of a sufficient specification, a new one may be issued for the same invention to the same inventor. In the case of *Morris v. Huntington*, 1 Paine's Rep. of Cases in the Second Circuit, 355, Mr. Justice Thompson says, "I see no insuperable objection to entering a *vacatur* of the patent of record in the department of State, if taken out inadvertently, or by mistake. All the proceedings in that department on the subject of patents are *ex parte*, except in the case of interfering applications. The department acts rather ministerially than judicially, and upon the representation of the applicant, without entering into an examination of the question of right; and there seems to be no good reason why, on a like *ex parte* application, the patent may not be surrendered and cancelled of record, if no misconduct be imputable to the patentee in taking it out." Cited also page 356.

So far then as this question has ever arisen in any of our Courts, the right to surrender an old patent and procure a new one has been recognized. Cited also *Barrett et al. v. Hall*, 1 Mason, 475, as to the *second* point.

The second point is settled by the express terms of the Patent Law, and by the adjudications which have taken place under it.

1. By the express terms of the Patent Law.

The sixth section of the Patent Act declares, "that the defendant shall be permitted to plead the general issue, and give this act and any special matter in evidence, of which notice in writing must have been given, &c., thirty days

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before the trial ; tending to prove that the specification filed by the plaintiff * does not contain the [*238] whole truth relative to the discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made *for the purpose of deceiving the public, &c., &c.*

So, therefore, if the specification does not contain the whole truth relative to the discovery, or if it contains more than is necessary to produce the described effect, the patent shall not, for these causes, or either of them, be evidence unless “ the concealment or addition shall fully appear to have been made for the purpose of deceiving the public.”

2. By the adjudications which have taken place under the law.

The first case in which the question came up, was the case of *Whitney v. Carter*, in the Circuit Court of Georgia. That case is cited in Mr. Fessenden's Essay on the Law of Patents, 123.

His honor, Judge Johnson, in charging the jury in that case, said, “ he considered the defendants' second objection equally unsupported, and referred to the sixth section of the Patent Law, by which it is required that the concealment alleged (in order to defeat the patentee's recovery) must appear to have been made for the purpose of deceiving the public. That Mr. Whitney could have no motive for such concealment,” &c., &c.

In the case of *Gray and Osgood v. James et al.* 1 Peters's C. C. Rep. 394, this question came up before the Circuit Court in Pennsylvania. Judge Washington says, “ but if the jury should be of opinion that the specification is materially defective, the objection will not be sufficient to invalidate the plaintiff's patent, unless they should also be satisfied that the concealment of the circumstances not described, was intended to deceive the public.”

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In the case of *Whittemore v. Cutter*, 1 Gallis. 429, Mr. Justice Story says, "any defect or concealment in a specification to avoid a patent, must arise from an intention to deceive the public." In the case of *Lowell v. Lewis*, 1 Max. 189, the same learned judge makes a similar declaration.

Mr. Chief Justice MARSHALL delivered the opinion of the Court.

[* 239] * This action was brought by Grant and Townsend against E. and H. Raymond, to recover damages for an infringement of their right under a patent granted to the plaintiff, Joseph Grant, in April, 1825. It recited that a former patent had been issued in August, 1821, to the same person for the same improvement, "which had been cancelled, owing to the defective specification on which the same was granted." The exclusive privilege given by the patent on which the suit is brought, is to continue fourteen years from the day on which the original was issued.

One of the pleas filed by the defendants, contained the following averment: and the defendants aver that the said specification does not correctly or accurately describe the improvement claimed by the said Joseph Grant as his invention, but said specification, and the drawings thereto annexed, are altogether defective in this, among other things, namely: in said specification no proportion, sizes, or distances are given, and the bigness or size of none of the principal parts of said machine is given in said specification or drawings, but the same is wholly omitted; and in other particulars, said specifications and drawings are wholly defective: and the defendants aver that said specification annexed to and making part of said letters-patent, with the drawings thereto annexed, do not contain a written description of his the said Joseph Grant's invention and improvement aforesaid, and manner of using it, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and so as to

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enable any person skilled in the art of which said machine or improvement is a branch, or with which it is most nearly connected, to make and use the same; and that, for the cause aforesaid, said letters-patent are void."

The plaintiffs reply that they ought not to be barred, "because they say that the specification mentioned in the said last-mentioned plea, does correctly and accurately describe the improvement claimed by the said Joseph Grant as his invention; and because they say further, that neither the said specification, nor the drawings thereto annexed, are defective in any of the particulars in that behalf alleged in the said last-mentioned plea, and this they pray may be inquired of by the country." On this replication issue was joined.

* At the trial the counsel for the defendants objected that the Secretary of State had no power by law to accept a surrender of, and to cancel the said letters-patent, or to inquire into or to decide upon the causes for so doing, or to grant said second patent for the same invention with an amended specification, for the unexpired portion of the term of fourteen years which had been granted by the first patent.

The Court decided that such surrender might be made when the defect arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee; and that the Secretary of State had authority to accept such surrender, and cancel the record of the patent, and to issue a new patent for the unexpired part of the fourteen years granted under the old patent, in manner aforesaid. To which decision the counsel for the defendants excepted.

After adducing the testimony on which they relied to support their plea herein before stated, the counsel for the defendants moved the Court to instruct the jury that if they found that the defendants had maintained and proved their averments in that respect, that they must find the same for

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the defendants, which instructions the Court refused to give; but instructed the jury that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design, and for the purpose of deceiving the public; to which opinion the counsel for the defendants also excepted.

The jury found a verdict for the plaintiffs, and assessed their damages to three thousand two hundred and sixty-six dollars sixty-six cents: the judgment on which is brought before this Court by a writ of error.

The first question in the cause respects the power of the Secretary of State to receive a surrender of a patent, cancel the record thereof, and issue a new patent for the unexpired part of the fourteen years for which the original had been granted. The Court was of opinion that this might be done "when the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee."

The right of the patentee to surrender his patent has not been denied, but the plaintiffs in error insist that no power exists to grant a new patent for the unexpired [* 241] term. The * words of the act, they say, do not confer this power. It cannot be exercised with its necessary guards by the Department of State; and inconvenience of no inconsiderable magnitude might result to the public from its exercise. The Secretary of State is, in the act of making out patents, a mere ministerial officer, and can exercise no power which is not expressly given.

It is undoubtedly true, that the Secretary of State may be considered, in issuing patents, as a ministerial officer. If the prerequisites of the law be complied with, he can exercise no judgment on the question whether the patent shall be issued. It is equally true that the Act of Congress contains no words which expressly authorize the Secretary to issue a corrected

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patent, if the original, from some mistake or inadvertence in the patentee, should be found incompetent to secure the reward which the law intended to confer on him for his invention. The force of this objection, and of the argument founded on it is felt. If the new patent can be sustained, it must be on the general spirit and object of the law, not on its letter.

To promote the progress of useful arts, is the interest and policy of every enlightened government. It entered into the views of the framers of our Constitution, and the power "to promote the progress of science and useful arts, by securing for limited times to authors and inventors, the exclusive right to their respective writings and discoveries, is among those expressly given to Congress. This subject was among the first which followed the organization of our government. It was taken up by the first Congress at its second session, and an act was passed authorizing a patent to be issued to the inventor of any useful art, &c., on his petition, "granting to such petitioner, his heirs, administrators, or assigns, for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery." The law farther declares that the patent "shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained." The emendatory Act of 1793, contains the same language, and it cannot be doubted that the settled purpose of the United States has ever been, and continues to be, to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent. It is * the reward [* 242] stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought, we think, to be construed in the

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spirit in which they have been made ; and to execute the contract fairly on the part of the United States, where the full benefit has been actually received : if this can be done without transcending the intention of the statute, or countenancing acts which are fraudulent or may prove mischievous. The public yields nothing which it has not agreed to yield : it receives all which it has contracted to receive. The full benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved ; and for his exclusive enjoyment of it during that time the public faith is pledged. That sense of justice and of right which all feel, pleads strongly against depriving the inventor of the compensation thus solemnly promised, because he has committed an inadvertent or innocent mistake.

If the mistake should be committed in the Department of State, no one would say that it ought not to be corrected. All would admit that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued. And yet the act does not in terms authorize a new patent, even in this case. Its emanation is not founded on the words of the law, but is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken for the same purpose, if the mistake has been innocently committed by the inventor himself ?

The counsel for the plaintiffs in error have shown very clearly that the question of inadvertence or mistake is a judicial question, which cannot be decided by the Secretary of State. Neither can he decide those judicial questions on which the validity of the first patent depends. Yet he issues it without inquiring into them. Why may he not, in like manner, issue the second patent also ? The correct performance of all those preliminaries on which the validity of the original depends, are always examinable in the Court in which

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a suit for its violation shall be brought. Why may not those points on which the validity of the amended patent depends, be examined *before the same tribunal? [* 243] In the case under consideration, those questions were not supposed by the Circuit Court to have been decided in the Department of State, but were expressly submitted to the jury. The rightfulness of issuing the new patent is declared to depend on the fact, that "the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee." The jury were of course to inquire into the fact. The condition on which the right to issue the patent depended, could be stated to them for no other purpose.

It has been said that this permission to issue a new patent on a reformed specification, when the first was defective through the mistake of the patentee, would change the whole character of the Act of Congress.

We are not convinced of this. The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to these discoveries, by the exclusive right to make, use, and sell, the things discovered for a limited time. That which gives complete effect to this object and intention, by employing the same means for the correction of inadvertent error which are directed in the first instance, cannot, we think, be a departure from the spirit and character of the act.

An objection much relied on is, that after the invention has been brought into general use, those skilled in the art or science with which it is connected, perceiving the variance between the specification and the machine, and availing themselves of it, may have constructed, sold, and used the machine without infringing the legal rights of the patentee,

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or incurring the penalties of the law. The new patent would retroact on them, and expose them to penalties to which they were not liable when the act was committed.

This objection is more formidable in appearance than in reality. It is not probable that the defect in the specification can be so apparent as to be perceived by any but those who examine it for the purpose of pirating the invention. They are not entitled to much favor. But the answer to the objec-

tion is, that this defence is not made in this case; [* 244] and the * opinion of the Circuit Court does not go so far as to say that such a defence would not be successful. That question is not before the Court, and is not involved in the opinion we are considering. The defence when true in fact may be sufficient in law, notwithstanding the validity of the new patent.

It has been also argued that the new patent must issue on the new specification, and on the application which accompanies it. Consequently, it will not be true that the machine was "not known or used before the application."

But the new patent, and the proceedings on which it issues, have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application; and, if the new patent is valid, the law must be considered as satisfied if the machine was not known or used before that application.

It has been urged that the public was put into possession of the machine by the open sale and use of it under the defective specification, and cannot be deprived of it by the grant of a new patent. The machine is no longer the subject of a patent.

This would be perfectly true, if the second patent could be considered as independent of the first. But it is in no respect so considered. The communication of the discovery to the

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public has been made in pursuance of law, with the intent to exercise a privilege which is the consideration paid by the public for the future use of the machine. If, by an innocent mistake, the instrument introduced to secure this privilege fails in its object, the public ought not to avail itself of this mistake, and to appropriate the discovery without paying the stipulated consideration. The attempt would be disreputable in an individual, and a Court of Equity might interpose to restrain him.

It will not be pretended that this question is free from difficulty. But the executive departments, it is understood, have acted on the construction adopted by the Circuit Court, and have considered it as settled. We would not willingly disregard this settled practice in a case where we are not satisfied it is contrary to law, and where we are satisfied that it is required by justice and good faith.

* We will now proceed to the second exception. [* 245]

The plea assigns the particular defect supposed to exist in the specification, and then proceeds to aver, in the very words of the act, that it "does not contain a written description of his, the said Joseph Grant's, invention and improvement aforesaid, and manner of using it, in such full, clear, and exact terms as to distinguish the same from all other things before known, and so as to enable any person skilled in the art, &c., to make and use the same," &c.

The plea alleges, in the words of the act, that the prerequisites to the issuing a patent had not been complied with.

If the matter alleged in this plea constituted no bar to the action, the plaintiffs might have demanded, and have submitted the question of law to the Court. But they have chosen to deny the facts alleged in the plea, and to aver in their replication "that neither the specification nor the drawings thereto annexed, are defective in any of the particulars in

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that behalf alleged." Issue was joined upon this replication and it is that issue which the jury were sworn to try.

At the trial, the counsel for the defendants, after the evidence was closed, asked the Court, in substance, to instruct the jury that if they should be of opinion that the defendants had maintained and proved the facts alleged in their plea they must find for the defendants. The Court refused this instruction. Ought it to have been refused? If in the opinion of the jury the defendants have proved and maintained every fact alleged in the plea, on which the issue they are sworn to try is joined, ought not the jury to find that issue for the defendants? Is not this required by their oaths? The conclusion, "and that for the cause aforesaid, said letters-patent are void," is an inference of law from the facts previously alleged; not the allegation of a distinct fact to be submitted to the jury.

The Court proceeded to instruct the jury, "that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design or for the purpose of deceiving the public."

Now this "*design*," this "*purpose of deceiving the public*," constituted no part of the issue. The defendants had not alleged it, and could not be supposed to come prepared to prove it. A verdict for them would not imply [* 246] it. The instruction is * understood to direct a verdict which finds in fact that the description or specification is not defective; and this verdict against the evidence is to be found because that defect "arose not from design, or for the purpose of deceiving the public."

But we must inquire whether the instruction, independent of its departure from the issue, be consistent with law. It is "that the patent would not be void unless," &c.

The fifth section of the act gives the party aggrieved an action for the infringement of his patent-right. The sixth

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provides "that the defendant in such action shall be permitted to plead the general issue, and give this act in evidence, and to give in evidence any special matter, of which notice in writing may have been given to the plaintiff or his attorney thirty days before trial, tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect; which concealment or addition shall fully appear to have been made for the purpose of deceiving the public; or that the thing thus secured," &c., "in either of which cases judgment shall be rendered for the defendant with costs, and the patent shall be declared void."

Courts did not, perhaps, at first distinguish clearly between a defence which would authorize a verdict and judgment in favor of the defendant in the particular action, leaving the plaintiff free to use his patent, and to bring other suits for its infringement; and one which, if successful, would require the Court to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. This distinction is now well settled.

If the party is content with defending himself, he may either plead specially; or plead the general issue, and give the notice required by the sixth section of any special matter he means to use at the trial. If he shows that the patentee has failed in any of those prerequisites on which the authority to issue the patent is made to depend, his defence is complete. He is entitled to the verdict of the jury and the judgment of the Court. But if, not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity to the sixth section. If he depends on evidence "tending to prove that the specification filed by the plaintiff * does not contain the whole [* 247] truth relative to his discovery, or that it contains more than is necessary to produce the described effect," it

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may avail him so far as respects himself, but will not justify a judgment declaring the patent void, unless such "concealment or addition shall fully appear to have been made for the purpose of deceiving the public;" which purpose must be found by the jury to justify a judgment of *vacatur* by the Court. The defendant is permitted to proceed according to the sixth section, but is not prohibited from proceeding in the usual manner, so far as respects his defence; except that special matter may not be given in evidence on the general issue unaccompanied by the notice which the sixth section requires. The sixth section is not understood to control the third. The evidence of fraudulent intent is required only in the particular case, and for the particular purpose stated in the sixth section.

This instruction was material if the verdict ought to have been for the defendants, provided the allegations of the plea were sustained, and if such verdict would have supported a judgment in their favor; although the defect in the specification might not have arisen from design, and for the purpose of deceiving the public. That such is the law we are entirely satisfied. The third section requires, as preliminary to a patent, a correct specification and description of the thing discovered. This is necessary in order to give the public, after the privilege shall expire, the advantage for which the privilege is allowed, and is the foundation of the power to issue the patent. The necessary consequence of the ministerial character in which the Secretary acts, is that the performance of the prerequisites to a patent must be examinable in any suit brought upon it. If the case was of the first impression, we should come to this conclusion; but it is understood to be settled.

The Act of Parliament concerning monopolies contains an exception on which the grants of patents for inventions have issued in that country. The construction of so much of that

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exception as connects the specification with the patent, and makes the validity of the latter dependent on the correctness of the former, is applicable, we think, to proceedings under the third section of the American act. The English books *are full of cases in which it has been [* 248] held that a defective specification is a good bar when pleaded to, or a sufficient defence when given in evidence on the general issue, on an action brought for the infringement of a patent-right. They are very well summed up in Godson's Law of Patents, title Specification: and also in the chapter respecting the infringement of patents: also in Holroyd on Patents; where he treats of the specification, its form and requisites. It is deemed unnecessary to go through the cases, because there is no contrariety in them, and because the question is supposed to be substantially settled in this country. Pennock and Sellers v. Dialogue, 1 Peters, 1, was not, it is true, a case of defect in the specification or description required by the third section, but one in which the applicant did not bring himself within the provision of the first section, which requires that before a patent shall issue the petitioner shall allege that he has invented a new and useful art, machine, &c., "*not known or used before the application.*"

This prerequisite of the first section, so far as a failure in it may effect the validity of the patent, is not distinguishable from a failure of the prerequisites of the third section.

On the trial evidence was given to show that the patentee had permitted his invention to be used before he took out his patent. The Court declared its opinion to the jury, that if an inventor makes his discovery public, he abandons the inchoate right to the exclusive use of the invention. "It is possible," added the Court, "that the inventor may not have intended to give the benefit of his discovery to the public." "But it is not a question of intention," "but of legal

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the defendants, which instructions the Court refused to give; but instructed the jury that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design, and for the purpose of deceiving the public; to which opinion the counsel for the defendants also excepted.

The jury found a verdict for the plaintiffs, and assessed their damages to three thousand two hundred and sixty-six dollars sixty-six cents: the judgment on which is brought before this Court by a writ of error.

The first question in the cause respects the power of the Secretary of State to receive a surrender of a patent, cancel the record thereof, and issue a new patent for the unexpired part of the fourteen years for which the original had been granted. The Court was of opinion that this might be done "when the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee."

The right of the patentee to surrender his patent has not been denied, but the plaintiffs in error insist that no power exists to grant a new patent for the unexpired [* 241] term. The * words of the act, they say, do not confer this power. It cannot be exercised with its necessary guards by the Department of State; and inconvenience of no inconsiderable magnitude might result to the public from its exercise. The Secretary of State is, in the act of making out patents, a mere ministerial officer, and can exercise no power which is not expressly given.

It is undoubtedly true, that the Secretary of State may be considered, in issuing patents, as a ministerial officer. If the prerequisites of the law be complied with, he can exercise no judgment on the question whether the patent shall be issued. It is equally true that the Act of Congress contains no words which expressly authorize the Secretary to issue a corrected

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patent, if the original, from some mistake or inadvertence in the patentee, should be found incompetent to secure the reward which the law intended to confer on him for his invention. The force of this objection, and of the argument founded on it is felt. If the new patent can be sustained, it must be on the general spirit and object of the law, not on its letter.

To promote the progress of useful arts, is the interest and policy of every enlightened government. It entered into the views of the framers of our Constitution, and the power "to promote the progress of science and useful arts, by securing for limited times to authors and inventors, the exclusive right to their respective writings and discoveries, is among those expressly given to Congress. This subject was among the first which followed the organization of our government. It was taken up by the first Congress at its second session, and an act was passed authorizing a patent to be issued to the inventor of any useful art, &c., on his petition, "granting to such petitioner, his heirs, administrators, or assigns, for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery." The law farther declares that the patent "shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained." The emendatory Act of 1793, contains the same language, and it cannot be doubted that the settled purpose of the United States has ever been, and continues to be, to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent. It is * the reward [* 242] stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought, we think, to be construed in the

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spirit in which they have been made ; and to execute the contract fairly on the part of the United States, where the full benefit has been actually received : if this can be done without transcending the intention of the statute, or countenancing acts which are fraudulent or may prove mischievous. The public yields nothing which it has not agreed to yield ; it receives all which it has contracted to receive. The full benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved ; and for his exclusive enjoyment of it during that time the public faith is pledged. That sense of justice and of right which all feel, pleads strongly against depriving the inventor of the compensation thus solemnly promised, because he has committed an inadvertent or innocent mistake.

If the mistake should be committed in the Department of State, no one would say that it ought not to be corrected. All would admit that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued. And yet the act does not in terms authorize a new patent, even in this case. Its emanation is not founded on the words of the law, but is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken for the same purpose, if the mistake has been innocently committed by the inventor himself ?

The counsel for the plaintiffs in error have shown very clearly that the question of inadvertence or mistake is a judicial question, which cannot be decided by the Secretary of State. Neither can he decide those judicial questions on which the validity of the first patent depends. Yet he issues it without inquiring into them. Why may he not, in like manner, issue the second patent also ? The correct performance of all those preliminaries on which the validity of the original depends, are always examinable in the Court in which

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a suit for its violation shall be brought. Why may not those points on which the validity of the amended patent depends, be examined * before the same tribunal? [* 243] In the case under consideration those questions were not supposed by the Circuit Court to have been decided in the Department of State, but were expressly submitted to the jury. The rightfulness of issuing the new patent is declared to depend on the fact, that "the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee." The jury were of course to inquire into the fact. The condition on which the right to issue the patent depended, could be stated to them for no other purpose.

It has been said that this permission to issue a new patent on a reformed specification, when the first was defective through the mistake of the patentee, would change the whole character of the Act of Congress.

We are not convinced of this. The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to these discoveries, by the exclusive right to make, use, and sell, the things discovered for a limited time. That which gives complete effect to this object and intention, by employing the same means for the correction of inadvertent error which are directed in the first instance, cannot, we think, be a departure from the spirit and character of the act.

An objection much relied on is, that after the invention has been brought into general use, those skilled in the art or science with which it is connected, perceiving the variance between the specification and the machine, and availing themselves of it, may have constructed, sold, and used the machine without infringing the legal rights of the patentee,

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This objection is more formidable in appearance than in reality. It is not probable that the defect in the specification can be so apparent as to be perceived by any but those who examine it for the purpose of pirating the invention. They are not entitled to much favor. But the answer to the objec-

tion is, that this defence is not made in this case:

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so far as to say that such a defence would not be successful. That question is not before the Court, and is not involved in the opinion we are considering. The defence when true in fact may be sufficient in law, notwithstanding the validity of the new patent.

It has been also argued that the new patent must issue on the new specification, and on the application which accompanies it. Consequently, it will not be true that the machine was "not known or used before the application."

But the new patent, and the proceedings on which it issues, have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application; and, if the new patent is valid, the law must be considered as satisfied if the machine was not known or used before that application.

It has been urged that the public was put into possession of the machine by the open sale and use of it under the defective specification, and cannot be deprived of it by the grant of a new patent. The machine is no longer the subject of a patent.

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public has been made in pursuance of law, with the intent to exercise a privilege which is the consideration paid by the public for the future use of the machine. If, by an innocent mistake, the instrument introduced to secure this privilege fails in its object, the public ought not to avail itself of this mistake, and to appropriate the discovery without paying the stipulated consideration. The attempt would be disreputable in an individual, and a Court of Equity might interpose to restrain him.

It will not be pretended that this question is free from difficulty. But the executive departments, it is understood, have acted on the construction adopted by the Circuit Court, and have considered it as settled. We would not willingly disregard this settled practice in a case where we are not satisfied it is contrary to law, and where we are satisfied that it is required by justice and good faith.

* We will now proceed to the second exception. [* 245]

The plea assigns the particular defect supposed to exist in the specification, and then proceeds to aver, in the very words of the act, that it "does not contain a written description of his, the said Joseph Grant's, invention and improvement aforesaid, and manner of using it, in such full, clear, and exact terms as to distinguish the same from all other things before known, and so as to enable any person skilled in the art, &c., to make and use the same," &c.

The plea alleges, in the words of the act, that the prerequisites to the issuing a patent had not been complied with.

If the matter alleged in this plea constituted no bar to the action, the plaintiffs might have demanded, and have submitted the question of law to the Court. But they have chosen to deny the facts alleged in the plea, and to aver in their replication "that neither the specification nor the drawings thereto annexed, are defective in any of the particulars in

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tiff, not being a worker in iron in 1813, or 1814, [* 296] employed his brother, * in England, under strict injunctions of secrecy, to execute or fabricate the said improvement for the purpose of the said plaintiff's making experiments. And that the said plaintiff, afterwards, in 1817, left England, and came to reside in the United States of America ; and that, after the departure of the said plaintiff from England, namely, in 1817 or 1818, his said brother divulged the said secret for a certain reward to an eminent gunmaker in London ; that the said plaintiff, on his arrival in this country, in 1817, disclosed his said improvement to a gunmaker, whom he consulted as to obtaining a patent for the same, and whom he wished to engage to join and assist him. That the plaintiff made said disclosures under injunctions of secrecy, claiming the improvement as his own, and declaring that he should patent it. That the said plaintiff treated his invention as a secret after his arrival in this country, often declaring that he should patent it ; and that he assigned as a reason for delaying to patent it, that it was not so perfect as he wished to make it before he introduced it into public use ; and that he did make alterations in his invention up to about the date of his patent, which some witnesses considered as improvements, and others did not. That, in this country, the said invention was never known or used prior to the said 19th day of June, 1822 ; that, on that day, letters-patent were issued to the said plaintiff, being then an alien, for his said invention ; and that the said plaintiff immediately brought the said invention into public use under the said letters-patent. That afterwards, and after suits had been brought for violation of the said letters-patent, the said plaintiff was advised to surrender them on account of the specification being defective, and that he did accordingly, on the 7th day of May, 1829, surrender the same into the department of the Secretary of State of the United States of America ; and that, thereupon the letters-patent first above

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mentioned were issued to the said plaintiff. And the said plaintiff also gave in evidence that, prior to the said 19th day of June, 1822, the principle importers of guns from England, in New York and Philadelphia, at the latter of which cities the plaintiff resided, had never heard any thing of the said invention, or that the same was known or used in England; and that no guns of the kind were *imported [* 297] into this country until the years 1824 or 1825.

And that letters-patent were granted in England on the 11th day of April, 1807, to one Alexander J. Forsyth, for a method of discharging or giving fire to artillery, and all other fire-arms; which method he describes in his specification as consisting in 'the use or application as a priming, in any mode, of some or one of those chemical compounds which are so easily inflammable as to be capable of taking fire and exploding without any actual fire being applied thereto, and merely by a blow, or by any sudden or strong pressure or friction given or applied thereto, without extraordinary violence; that is to say, some one of the compounds of combustible matter, such as sulphur or sulphur and charcoal, with oxmuriatic salt; for example, the salt formed of dephlogisticated marine acid and potash, (or potasse,) which salt is otherwise called oxmuriate of potash; or such of the fulminating metallic compounds as may be used with safety; for example, fulminating mercury, or of common gunpowder, mixed in due quantity with any of the above-mentioned substances, or with any oxmuriatic salt as aforesaid, or of suitable mixtures of any of the above-mentioned compounds;' and that the said letters-patent continued in force for the period of fourteen years from and after granting of the same. (It is understood that the patent and specification of Forsyth, may be at any time referred to on the argument for correction or explanation of the bill of exceptions.) And thereupon the defendant, further to maintain the said issue on his part, gave in

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evidence a certain letter from the plaintiff to the defendant dated in December, 1824, from which the following is an extract: ' Some time since I stated that I had employed counsel respecting regular prosecutions for any trespasses against my rights to the patent; I have at length obtained the opinions of Mr. Sergeant of this city, together with others eminent in law, and that is, that I ought (with a view to insure success) to visit England, and procure the affidavits of Manton and others to whom I made my invention known, and also of the person whom I employed to make the lock at the time of invention; for it appears very essential that I should also prove that I did actually reduce the principle to practice, otherwise a verdict might be doubtful. It is, therefore, my [* 298] intention to visit * England in May next, for this purpose; in the mean time, proceedings, which have commenced here are suspended for the necessary time.'

" And the said judges of the said Court did thereupon charge and direct the said jury, that the patent of the 7th day of May, 1829, having been issued, as appeared by its recital on the surrender and concealment of the patent of the 19th day of June, 1822, and being intended to correct a mistake or remedy a defect in the latter, it must be considered as a continuation of the said patent, and the rights of the plaintiff were to be determined by the state of things which existed in 1822, when the patent was obtained.

" That the plaintiff's case, therefore, came under the Act passed the 17th day of April, 1800, extending the right of obtaining patents to aliens, by the first section of which, the applicant is required to make oath that his invention has not, to the best of his knowledge or belief, been known or used in this or any foreign country. That the plaintiff most probably did not know, in 1822, that the invention for which he was taking out a patent, had, before that time, been in use in a foreign country; but that his knowledge or ignorance on

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that subject was rendered immaterial by the concluding part of the section, which expressly declares, that every patent obtained pursuant to that act, for any invention which it should afterwards appear had been known or used previous to such application for a patent, should be utterly void. That there was nothing in the act confining such use to the United States ; and that, if the invention was previously known in England or France, it was sufficient to avoid the patent under that act. That the evidence would lead to the conclusion that the plaintiff was the inventor in this case ; but the Court were of opinion that he had slept too long on his rights, and not followed them up as the law requires, to entitle him to any benefit from his patent. That the use of the invention, by a person who had pirated it, or by others who knew of the piracy, would not affect the inventor's rights, but that the law was made for the benefit of the public as well as of the inventor ; and if, as appeared from the evidence in this case, the public had fairly become possessed of the invention before the plaintiff applied for his patent, it was sufficient, * in the opinion of the Court, to invalidate [* 299] his patent, even though the invention may have originally got into public use through the fraud or misconduct of his brother, to whom he intrusted the knowledge of it."

The case was submitted to the Court, on printed arguments, by *Mr. Paine*, for the plaintiff in error ; and *Mr. Emmet*, for the defendant.

For the plaintiff in error, it was contended, that the case fell within the principles which had been uniformly acknowledged and supported in the Circuit Court of the United States ; and which were not intended to be disavowed,

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but sanctioned by this Court in *Pennock v. Dialogue*, 2 Peters, 1.

In this country many strong cases of public use, prior to the application for a patent, have been brought before the Courts, where the public had been long in possession; and the Courts have allowed the inventor to show in different ways, that he had not thereby abandoned his use to the public. How much more favorable to us are the circumstances of our case, as respects a prior use. Before we took out our first patent, the invention had never been seen or heard of in this country. It was not then known to ourselves, nor to any others in this country, that it had been used in England; and it had been so used only one or two years — a short period, compared with the many cases which have been sustained by the Courts. Even if this use had been an American use, it would not have been an extraordinary one. But it was not an American, but a foreign use; and, therefore, not a use by the public, who contest our exclusive right, by saying that they had become the innocent possessors of our invention. Not one of that public had gotten possession of it.

The case does not seem to be fairly stated, when it is said that, although the invention was disclosed by piracy, yet the public have innocently got possession of it by that means. The only public who can set up the innocence of their possession as against us, did not get their possession by the piracy; but under the invalid patent. And if this be so, what difference does it make that afterwards guns were brought [* 300.] from England? * Does such a circumstance bear, can it be made to bear at all upon the merits of the case?

The parts of the charge to the jury of the Circuit Court which are objected to, as understood by the counsel for the plaintiff, may be stated thus:

That the use of the invention abroad, acquired through a

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fraudulent or piratical disclosure of the secret, for a period of only one or two years before the application for the patent, and that use entirely unknown to the inventor here, avoids the patent, because it was obtained under the alien act.

That our patent of 1829, obtained under the citizen's act, is, in respect to the prior foreign use, to be construed as if obtained under the alien act, because it was obtained on the surrender of the patent of 1822, which was obtained under the alien act, the one being only a continuation of the other.

That the inventor (the Court are understood to have been speaking, in this part of the charge, without reference to the question as to whether the patent was obtained under the alien or citizen's act, but to have designed their remarks to apply to patents generally) had slept too long on his rights, and not followed them up as the law requires, to entitle him to any benefit from his patent ; that the use of the invention, by a person who had pirated it, or by others who knew of the piracy, would not affect the inventor's right ; but that the law was made for the benefit of the public, as well as of the inventor ; and if, as appeared from the evidence in this case, the public had fairly become possessed of the invention before the plaintiff applied for his patent, it was sufficient to invalidate his patent, even though the invention may have originally got into public use through the fraud or misconduct of his brother, to whom he intrusted the knowledge of it.

The following points comprehend these objections to the charge of the Court.

1. The second patent is original and independent, and not a continuation of the first patent.

When patents are surrendered and cancelled in England, they are entirely vacated and gone, and as if they had never

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general issue aforesaid, insist upon, and give in evidence, that the pretended new and useful improvement in guns and fire-arms, mentioned and referred to in the several counts of the said Joshua Shaw's declaration, was not originally discovered or invented by the said Joshua Shaw ; also, that the said pretended new and useful improvement, or the material or essential parts or portions thereof, or some or one of them, had been known and used in this country, namely, in the city of New York, and in the city of Philadelphia, and in sundry other places in the United States, and in England, and in France, and in other foreign countries, before the said Joshua Shaw's application for a patent, as set forth in his said declaration ; and also, before the alleged invention or supposed discovery thereof by the said Joshua Shaw.

“ And further, that the said alleged new and useful improvement, or the material or essential parts or portions thereof, or some or one of them, or the principle thereof, was the invention or discovery of a gunmaker, or of some other person, residing in England. And further, that the said patent was void, because in and by the specification or description therein referred to, no distinction or discrimination is made between the parts and portions previously known and used as aforesaid, and any parts or portions of which the said Joshua Shaw may be the inventor or discoverer ; the said Joseph Cooper at the same time protesting that he, the said Joshua Shaw, has not been the inventor or discoverer of any part or portion of the said alleged improvement.

“ And further, that the said patent is void, because the said specification or description does not describe [* 295] the improvement * of which the said Joshua Shaw claims to be the inventor or discoverer, in such full, clear, and exact terms, as to distinguish the same from all other things before known, nor so as to enable a person skilled in the art or science of which it is a branch, or with which it

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is most nearly connected, to make and use the same. And further, that the said patent is void, because it was not granted, issued, or obtained, according to law. And further, that the said patent is void, because it was surreptitiously obtained by said Joshua Shaw."

The cause was tried in January, 1832, and a verdict and judgment given for the defendant. The plaintiff prosecuted this writ of error.

The following bill of exceptions was tendered by the counsel for the plaintiff, and sealed by the Court: —

"The plaintiff, to maintain the issue on his grant, gave in evidence the letters-patent of the United States of America, as set forth in the declaration of the said plaintiff, issued on the 7th day of May, 1829; and also that the improvement for which the said letters-patent were granted, was invented or discovered by the said plaintiff in the year 1813 or 1814, and that the defendant had sold instruments which were infringements of the said letters-patent. And thereupon the said defendant, to maintain the said issue above joined on his part, then and there proved by the testimony of one witness, that he had used the said improvement in England, and had purchased a gun of the kind there, and had seen others use the said improvement, and had seen guns of the kind in the Duke of York's armory, in 1819; and also proved by the testimony of five other witnesses, that, in 1820 and 1821, they worked in England at the business of making and repairing guns, and that the said improvement was generally used in England in those years, but that they never had seen guns of the kind prior to those years; and also proved that, in 1821, it was known and used in France, and also that the said improvement was generally known and used in the United States of America after the 19th day of June, 1822. Whereupon the said plaintiff, further to maintain the said issue on his part, then and there gave in evidence, that the said plain-

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tiff, not being a worker in iron in 1813, or 1814, [* 296] employed his brother, * in England, under strict injunctions of secrecy, to execute or fabricate the said improvement for the purpose of the said plaintiff's making experiments. And that the said plaintiff, afterwards, in 1817, left England, and came to reside in the United States of America ; and that, after the departure of the said plaintiff from England, namely, in 1817 or 1818, his said brother divulged the said secret for a certain reward to an eminent gunmaker in London ; that the said plaintiff, on his arrival in this country, in 1817, disclosed his said improvement to a gunmaker, whom he consulted as to obtaining a patent for the same, and whom he wished to engage to join and assist him. That the plaintiff made said disclosures under injunctions of secrecy, claiming the improvement as his own, and declaring that he should patent it. That the said plaintiff treated his invention as a secret after his arrival in this country, often declaring that he should patent it ; and that he assigned as a reason for delaying to patent it, that it was not so perfect as he wished to make it before he introduced it into public use ; and that he did make alterations in his invention up to about the date of his patent, which some witnesses considered as improvements, and others did not. That, in this country, the said invention was never known or used prior to the said 19th day of June, 1822 ; that, on that day, letters-patent were issued to the said plaintiff, being then an alien, for his said invention ; and that the said plaintiff immediately brought the said invention into public use under the said letters-patent. That afterwards, and after suits had been brought for violation of the said letters-patent, the said plaintiff was advised to surrender them on account of the specification being defective, and that he did accordingly, on the 7th day of May, 1829, surrender the same into the department of the Secretary of State of the United States of America ; and that, thereupon the letters-patent first above

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mentioned were issued to the said plaintiff. And the said plaintiff also gave in evidence that, prior to the said 19th day of June, 1822, the principle importers of guns from England, in New York and Philadelphia, at the latter of which cities the plaintiff resided, had never heard any thing of the said invention, or that the same was known or used in England; and that no guns of the kind were *imported [* 297] into this country until the years 1824 or 1825.

And that letters-patent were granted in England on the 11th day of April, 1807, to one Alexander J. Forsyth, for a method of discharging or giving fire to artillery, and all other fire-arms; which method he describes in his specification as consisting in 'the use or application as a priming, in any mode, of some or one of those chemical compounds which are so easily inflammable as to be capable of taking fire and exploding without any actual fire being applied thereto, and merely by a blow, or by any sudden or strong pressure or friction given or applied thereto, without extraordinary violence; that is to say, some one of the compounds of combustible matter, such as sulphur or sulphur and charcoal, with oxmuriatic salt; for example, the salt formed of dephlogisticated marine acid and potash, (or potasse,) which salt is otherwise called oxmuriate of potash; or such of the fulminating metallic compounds as may be used with safety; for example, fulminating mercury, or of common gunpowder, mixed in due quantity with any of the above-mentioned substances, or with any oxmuriatic salt as aforesaid, or of suitable mixtures of any of the above-mentioned compounds;' and that the said letters-patent continued in force for the period of fourteen years from and after granting of the same. (It is understood that the patent and specification of Forsyth, may be at any time referred to on the argument for correction or explanation of the bill of exceptions.) And thereupon the defendant, further to maintain the said issue on his part, gave in

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evidence a certain letter from the plaintiff to the defendant dated in December, 1824, from which the following is an extract: 'Some time since I stated that I had employed counsel respecting regular prosecutions for any trespasses against my rights to the patent; I have at length obtained the opinions of Mr. Sergeant of this city, together with others eminent in law, and that is, that I ought (with a view to insure success) to visit England, and procure the affidavits of Manton and others to whom I made my invention known, and also of the person whom I employed to make the lock at the time of invention; for it appears very essential that I should also prove that I did actually reduce the principle to practice, otherwise a verdict might be doubtful. It is, therefore, my [* 298] intention to visit * England in May next, for this purpose; in the mean time, proceedings, which have commenced here are suspended for the necessary time.'

"And the said judges of the said Court did thereupon charge and direct the said jury, that the patent of the 7th day of May, 1829, having been issued, as appeared by its recital on the surrender and concealment of the patent of the 19th day of June, 1822, and being intended to correct a mistake or remedy a defect in the latter, it must be considered as a continuation of the said patent, and the rights of the plaintiff were to be determined by the state of things which existed in 1822, when the patent was obtained.

"That the plaintiff's case, therefore, came under the Act passed the 17th day of April, 1800, extending the right of obtaining patents to aliens, by the first section of which, the applicant is required to make oath that his invention has not, to the best of his knowledge or belief, been known or used in this or any foreign country. That the plaintiff most probably did not know, in 1822, that the invention for which he was taking out a patent, had, before that time, been in use in a foreign country; but that his knowledge or ignorance on

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that subject was rendered immaterial by the concluding part of the section, which expressly declares, that every patent obtained pursuant to that act, for any invention which it should afterwards appear had been known or used previous to such application for a patent, should be utterly void. That there was nothing in the act confining such use to the United States ; and that, if the invention was previously known in England or France, it was sufficient to avoid the patent under that act. That the evidence would lead to the conclusion that the plaintiff was the inventor in this case ; but the Court were of opinion that he had slept too long on his rights, and not followed them up as the law requires, to entitle him to any benefit from his patent. That the use of the invention, by a person who had pirated it, or by others who knew of the piracy, would not affect the inventor's rights, but that the law was made for the benefit of the public as well as of the inventor ; and if, as appeared from the evidence in this case, the public had fairly become possessed of the invention before the plaintiff applied for his patent, it was sufficient, * in the opinion of the Court, to invalidate [* 299] his patent, even though the invention may have originally got into public use through the fraud or misconduct of his brother, to whom he intrusted the knowledge of it."

The case was submitted to the Court, on printed arguments, by *Mr. Paine*, for the plaintiff in error ; and *Mr. Emmet*, for the defendant.

For the plaintiff in error, it was contended, that the case fell within the principles which had been uniformly acknowledged and supported in the Circuit Court of the United States ; and which were not intended to be disavowed,

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he might and ought to have taken out his patent; and if he had done so, he would have anticipated the *public use* of the invention in England and France. But he delayed until 1822, a period of three years. His own story shows that such delay was without sufficient cause. It was, therefore, *unreasonable*; and the law in protection of the right acquired in the mean time by the public, construes his acts into an *abandonment*.

It would appear that, even to the mind of the plaintiff's counsel, this view of the case is conclusive, unless the fact of the invention having got into *public use* before the first patent was taken out, can be shaken; for they say, that the use, in this case, was not an *American*, but a foreign use, and therefore not a use by the public, who contest their exclusive right. This distinction is directly opposed to the Act of 1800, which uses the language "known or used, in this or *any foreign country*;" and it is equally opposed to the intent and meaning of the Act of 1793. We are perfectly willing to admit that, in this respect, the construction of both acts should be the same; and that the proviso at the end of the first section of the Act of 1800 applies to *every patent*, whether obtained under *that* Act or the Act of 1793. In the words [* 308] of Mr. Justice Story, the Act of * 1800 affords, in this respect, a gloss or explanation of the original act. *Pennock v. Dialogue*, 2 Peters's S. C. Rep. 22. This only tends to show, that if the plaintiff had been a citizen in 1822, and had taken out his first patent under the Act of 1793, his case would have been just as objectionable as it is now. But where do the plaintiff's counsel find any law for such a distinction between American and foreign *public use*, or how could it be sustained on principle? If the doctrine be a sound one, it would go to this extent—I dedicate my invention to the public in Europe; the European public being thus legally possessed of it, the article is manufactured

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and exported in large quantities ; I immediately come over here, take out a patent, and prevent the use of the article in the United States, thereby prohibiting the European public from engaging in a traffic or commerce which was an immediate incident to my own grant or dedication to them.

The impolicy of recognizing such a distinction, would afford a sufficient argument against it, even if the terms of the statute were not explicit ; and if nothing had ever fallen from the bench to give a construction to the expression “ public use.” But there is positive and high authority on this subject. Lord Chief Justice Gibbs says, “ to entitle a man to a patent, the invention must be *new to the world.*” 1 Holt, N. P. Rep. 58. And such, we submit, is the settled law on this point.

It would seem to be of little importance in this cause to discuss the plaintiff's position “ that the second patent is original and independent, and not a continuation of the first patent ;” because the only object of disconnecting the two patents in this case, would be to rescue the second patent from the operation of the Act of 1800, under which the first patent was taken, (the judge having charged the jury that the Act of 1800 was sufficient to control the case.) Now, we not only admit that the Act of 1793, should receive a similar construction with that of 1800, as to *previous knowledge or use* of an invention, but the plaintiff's counsel labor to establish this very ground. Their position, however, is not a correct one. The object of cancelling a first patent, and taking out a second, is not to take a fresh start for the term of years during which the law allows the exclusive right to be conferred. It is to enable the *inventor [*309] to enjoy, for the *remainder of that term*, the privilege which was *originally intended* to be granted. And in this view, even if the construction of the two acts was different, we apprehend that the judge laid down the law cor-

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rectly, namely, that the plaintiff's rights depended upon the state of things in 1822, and upon the Act of 1800.

It is only necessary to follow the plaintiff's argument on his third point, to perceive the impediment which the first section of the Act of 1800, taken either in reference to that act only, or as explanatory of the Act of 1793, offers to his case. To get rid of this difficulty, it is in substance contended by his counsel, that the legislature did not mean what they have said in this section, when certain cases came to be considered; and that the positive and unequivocal language used by them is, in this respect, unimportant. Now, the very fact that this section was intended to be *declaratory* of the law in all cases, whether arising under that, or the former Act of 1793, shows that the explicit language used, was considered to be all-important by the legislature; and it certainly was not contemplated that this explicit language should be *littered* away to suit particular cases.

If the facts of this case, as we have endeavored to show, make out a *negligence* or *unreasonable delay* on the part of the plaintiff in taking out his patent; and that such negligence or unreasonable delay amounts *in law* to an *abandonment*; the case is disposed of. We contend also that the delay was not accounted for; the alleged reason for it being virtually contradicted by the testimony offered to make out his case; and further, that the finding of the jury is conclusive as to this point.

The intent of the delay of the patent, and whether the allowing the invention to be used without a patent, should not be considered an abandonment, or a present of it to the public, are questions for the jury. *Morris v. Huntington*, Paine's Rep. 22.

The principles which we contend for, being recognized in many of the cases cited on the part of the plaintiff, (particularly the case of *Pennock v. Dialogue*,) it has been deemed

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unnecessary to refer to those cases more particularly.

If the *charge of the judge was not erroneous as [*310] to the law, there can be no ground for granting a new trial.

Mr. Justice M'LEAN delivered the opinion of the Court.

This writ of error brings before this Court, for its revision, a judgment of the Circuit Court of the United States for the Southern District of New York.

An action was brought in the Circuit Court by Shaw against the defendant Cooper, for the violation of a certain patent-right, claimed by the plaintiff. The defendant pleaded the general issue, and gave notice that on the trial he would prove "that the pretended new and useful improvement in guns and fire-arms, mentioned and referred to in the several counts in the declaration; also that the said pretended new and useful improvement, or the essential parts or portions thereof, or some or one of them, had been known and used in this country, namely, in the city of New York and in the city of Philadelphia, and in sundry other places in the United States, and in England, in France, and in other foreign countries, before the plaintiff's application for a patent as set forth in his declaration," &c.

On the trial, the following bill of exceptions was taken: "to maintain the issue joined, the plaintiff gave in evidence certain letters-patent of the United States, as set forth in the declaration, issued on the 7th day of May, 1829; and also that the improvement for which the letters were granted, was invented or discovered by the plaintiffs in 1813 or 1814; and that the defendant had sold instruments which were infringements of the said letters-patent.

"And the defendant then proved, by the testimony of one witness, that he had used the said improvement in England, and had purchased a gun of the kind there, and had seen

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muriatic salt, as aforesaid, or of suitable mixtures of any of the before-mentioned compounds ;' and that the said letters-patent continued in force for the period of fourteen years from the time of granting the same."

And the defendant, further to maintain the issue on his part, gave in evidence a certain letter from the plaintiff to the defendant, dated in December, in the year 1824, from which the following is an extract: "Some time since I stated that I had employed counsel respecting regular prosecutions for any trespass against my rights to the patent; I have at length obtained the opinion of Mr. Sergeant of this city, together with others eminent in the law, and that is, that I ought (with a view to insure success) to visit England, and procure the affidavits of Manton and others, to whom I made my invention known, and also of the person whom I employed to make the lock at the time of invention; for it appears very essential that I should prove that I did actually reduce the principle to practice, otherwise a verdict might be doubtful.

It is, therefore, my intention to visit England in May [*313] next, for this purpose; in the mean time *proceedings which have commenced here are suspended for the necessary time."

And the Court, on these facts, charged the jury that the patent of the 7th of May, 1829, having been issued, as appears by its recital, on the surrender and cancelment of the patent of the 19th day of June, in the year 1822; and being intended to correct a mistake or remedy a defect in the latter; it must be considered as a continuation of the said patent, and the rights of the plaintiff were to be determined by the state of things which existed in the year 1822, when the patent was first obtained.

That the plaintiff's case, therefore, came under the Act passed the 17th day of April, 1800, extending the right of obtaining patents to aliens; by the first section of which the

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applicant is required to make oath, that his invention has not, to the best of his knowledge or belief, been known or used in this or any foreign country. That the plaintiff most probably did not know, in the year 1822, that the invention for which he was taking out a patent, had, before that time, been in use in a foreign country ; but that his knowledge or ignorance on that subject was rendered immaterial by the concluding part of the section, which expressly declares, that every patent obtained pursuant to that act, for any invention which, it should afterward appear, had been known or used previous to such application for a patent, should be utterly void. That there was nothing in the act confining such use to the United States ; and that, if the invention was previously known in England or France, it was sufficient to avoid the patent under that act. That the evidence would lead to the conclusion that the plaintiff was the inventor in this case, but the Court were of opinion that he had slept too long on his rights, and not followed them up as the law requires, to entitle him to any benefit from his patent. That the use of the invention, by a person who had pirated it, or by others who knew of the piracy, would not affect the inventor's rights, but that the law was made for the benefit of the public as well as of the inventor ; and if, as appears from the evidence in this case, the public had fairly become possessed of the invention before the plaintiff applied for his patent, it was sufficient, in the opinion of the Court, to invalidate the * patent ; even though [* 314] the invention may have originally got into public use through the fraud or misconduct of his brother, to whom he intrusted the knowledge of it.

Under this charge the jury found a verdict for the defendant, on which a judgment was entered.

There is a general assignment of errors, which brings to the consideration of the Court the principles of law which

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arise out of the facts of the case, as stated in the bill of exceptions.

It may be proper, in the first place, to inquire whether the letters-patent which were obtained in 1829, on a surrender of the first patent, have relation to the emanation of the patent in 1822, or shall be considered as having been issued on an original application.

On the part of the plaintiff it is contended, that "the second patent is original and independent, and not a continuation of the first patent." That in adopting the policy of giving, for a term of years, exclusive rights to inventors in this country, we adopted at the same time the rules of the common law as applied to patents in England; and that by the common law, a patent, when defective, may be surrendered to the granting power, which vacates the right under it, and the king may grant the right *de novo* either to the same or to any other person.

This being the effect of the surrender of a patent in England, it is insisted, that the same consequence should follow a surrender in this country. On this subject it is said, that the decisions of the English Courts are uniform, and that not even a *dictum* can be found, that a second patent is a continuation of the first.

The counsel seems to consider this point of great importance, as the plaintiff was an alien when the first patent was obtained, but had become naturalized before the date of the second; and, consequently, that his rights under the second patent, cannot be governed by the law applicable to aliens. As the inquiry on this head is, whether the second patent has relation to the first, it is not necessary to look into the laws to ascertain the respective rights of aliens and citizens on this subject. In regard to the right of the patentee to surrender a defective patent, and take out a new one, there can be no difference between a citizen and an alien.

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* That the holder of a defective patent may sur- [* 315] render it to the department of State, and obtain a new one, which shall have relation to the emanation of the first, was decided by this Court at the last term in the case of *Grant and others v. Raymond*, 6 Peters, 220. The Chief Justice, in giving the opinion of the Court, says, "but the new patent, and the proceedings on which it issues, have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application; and if the new patent is valid, the law must be considered as satisfied, if the machine was not known or used before that application."

As this decision must be considered as settling the construction of the Patent Laws on this point, it is conclusive in the present case; and it is therefore unnecessary to examine the argument of the plaintiff's counsel, which was designed to lead to a different conclusion.

The second patent being a continuation of the first one, the rights of the plaintiff must be ascertained by the law under which the original application was made.

This law was passed on the 17th of April, 1800, and provides "that all and singular the rights and privileges given to citizens of the United States respecting patents for new inventions, &c., shall be extended to aliens, who at the time of petitioning, shall have resided for two years within the United States, &c. Provided, that every person petitioning for a patent for any invention, art, or discovery, pursuant to this act, shall make oath or affirmation before some person duly authorized to administer oaths, before such patent shall be granted, that such invention, art, or discovery, hath not, to the best of his or her knowledge or belief, been known or used, either in this or any foreign country; and that every patent which shall be obtained pursuant to this act, for any inven-

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tion, art, or discovery, which, it shall afterwards appear, had been known or used previous to such application for a patent, shall be utterly void."

By the Act of the 21st of February, 1793, which limits patent-rights to citizens, it is provided "that every [* 316] person or persons, *in his or their application for a patent, shall state that the machine, &c., was *not known or used* before such application."

The sixth section of this act provides that a defendant, when prosecuted for a violation of a patent-right, may give in evidence, under a notice, among other matters, "that the thing secured by patent was not originally discovered by the patentee, but had been in use, or had been described in some public work anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery of another person; in either of which cases, judgment shall be rendered for the defendant with costs, and the patent shall be declared void."

It would seem, from the above provisions, that citizens and aliens, as to patent-rights, are placed substantially upon the same ground. In either case, if the invention was known or used by the public before it was patented, the patent is void. In both cases the right must be tested by the same rule.

From the facts in the case, it appears that the plaintiff, while residing in England, in 1813 or 1814, invented the instrument secured by his patent. That before he came to the United States, he made known his invention to his brother, to Mr. Manton, a gunmaker in London, and to others. That shortly after he came to the United States, in 1817, he disclosed his invention to a gunmaker in Philadelphia, and that in 1817 or 1818, the plaintiff's brother sold the invention to a gunmaker in London. That in 1819 the invention was sold and used in England; and that in the two following

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years it was in public use there, and in the latter year also in France. That on the 19th of June, 1822, his first patent was obtained.

It also appears that in April, 1807, a patent was granted in England to one Forsyth, for fourteen years, for an invention on the same subject. This fact was shown by the plaintiff, it is presumed, as a reason why he did not take out a patent in England.

The question arises from these facts, and others which belong to the case, whether there was such a use in the public, of this invention, at the date of the plaintiff's first patent, as to render it void.

* By the plaintiff's counsel it is insisted, that if an [* 317] invention has been pirated, or fraudulently divulged, the inventor cannot thereby lose his right to his own invention and property ; and it makes no difference that the public have acquired the use of the invention without any participation in the fraud, unless the inventor has acquiesced in such use.

The right of the plaintiff to his invention, is compared to his right to other property, which cannot be divested by fraud or violence ; and the case of *Miller v. Taylor*, 4 Burr. 2303, where seven judges against four held, that, at common law, an author by publishing a literary composition does not abandon his right, is referred to as illustrative of the principle.

Several decisions by the Circuit Courts of the United States are cited to sustain the right of the plaintiff. In the case of *Whittemore v. Cutter*, 1 Gall. 482, the Court say, " it will not protect the plaintiff's patent, that he was the inventor of the improvements, if he suffered them to be used freely and fully by the public at large for so many years, combined with all the usual machinery ; for in such case, he must be deemed to have made a gift of them to the public, as much as a

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person who voluntarily opens his land as a highway, and suffers it to remain for a length of time devoted to public use."

In the case of *Goodyear v. Mathews*, 1 Paine's Rep. 301, the Court, in substance, say, "that if the plaintiff be the inventor, it is immaterial that the invention has been known and used for years before the application." And in the case of *Morris v. Huntington*, 1 Paine, 354, the Court say, that "no man is to be permitted to lie by for years, and then take out a patent. If he has been practising his invention with a view of improving it, and thereby rendering it a greater benefit to the public, before taking out a patent, that ought not to prejudice him. But it should always be a question submitted to the jury, what was the intent of the delay of the patent, and whether the allowing the invention to be used without a patent, should not be considered an abandonment or present of it to the public."

This was a case where a second patent had been obtained, the first being defective, and this, it would seem, was deemed sufficient to protect the right of the plaintiff, though [* 318] the public * had been in possession of the invention for six years before the emanation of the second patent.

Of the same import are the cases cited from 4 Mason, 108; and 4 Washington, 438 and 703.

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“The true construction of the Patent Law is,” the Court say, “that the first inventor cannot acquire a good title to a patent, if he suffers the thing invented to go into public use, or to be publicly sold for use before he makes application for a patent.”

In this case it appeared that the thing invented had been in use by the public, with the consent of the inventors, and through which they derived a profit, for seven years before the emanation of a patent. And this use was held by the Court to be an abandonment of the right by the patentees.

The policy of granting exclusive privileges in certain cases, was deemed of so much importance in a national point of view, that power was given to Congress in the federal Constitution, “to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries.”

This power was exercised by Congress, in the passage of the acts which have been referred to. And from an examination of * their various provisions, it clearly [* 319] appears, that it was the intention of the legislature, by a compliance with the requisites of the law, to vest the exclusive right in the inventor only ; and that, on condition that his invention was neither known nor used by the public before his application for a patent. If such use or knowledge

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The knowledge or use spoken of in the Act of 1793, could have referred to the public only, for the provision would be nugatory if it were applied to the inventor himself. He must, necessarily have a perfect knowledge of the thing invented and its use, before he can describe it, as by law he is required to do preparatory to the emanation of a patent. But there may be cases, in which a knowledge of the invention may be surreptitiously obtained and communicated to the public, that do not affect the right of the inventor. Under such circumstances no presumption can arise in favor of an abandonment of the right to the public, by the inventor; though an acquiescence on his part, will lay the foundation for such a presumption.

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Vigilance is necessary to entitle an individual to the privileges secured under the Patent Law. It is not enough that he should show his right by invention, but he must secure it in the mode required by law. And if the invention, through fraudulent means, shall be made known to the public, he should assert his right immediately, and take the necessary steps to legalize it.

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In the progress of society, the range of discoveries in the mechanic arts, in science, and in all things which promote the public convenience, as a matter of course, will be enlarged. This results from the aggregation of mind, and the diversity of talents and pursuits, which exist in every intelligent community. And it would be extremely impolitic to retard or embarrass this advance, by withdrawing from the public any useful invention or art, and making it a subject of private monopoly. Against this consequence, the legislature have carefully guarded in the laws they have passed on the subject.

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it validity. But the public stand in an entirely different relation to the inventor.

The invention passes into the possession of innocent persons, who have no knowledge of the fraud ; and at a considerable expense, perhaps, they appropriate it to their own use. The inventor or his agent has full knowledge of these facts, but fails to assert his right ; shall he afterwards be permitted to assert it with effect ? Is not this such [* 321] evidence of acquiescence * in the public use, on his part, as justly forfeits his right ?

If an individual witness a sale and transfer of real estate, under certain circumstances, in which he has an equitable lien or interest, and does not make known this interest, he shall not afterwards be permitted to assert it. On this principle it is, that a discoverer abandons his right, if, before the obtainment of his patent, his discovery goes into public use. His right would be secured by giving public notice that he was the inventor of the thing used, and that he should apply for a patent. Does this impose any thing more than reasonable diligence on the inventor ? And would any thing short of this, be just to the public ?

The acquiescence of an inventor in the public use of his invention, can in no case be presumed, where he has no knowledge of such use. But this knowledge may be presumed from the circumstances of the case. This will, in general, be a fact for the jury. And if the inventor do not, immediately after this notice, assert his right, it is such evidence of acquiescence in the public use, as for ever afterwards to prevent him from asserting it. After his right shall be perfected by a patent, no presumption arises against it from a subsequent use by the public.

When an inventor applies to the department of State for a patent, he should state the facts truly ; and indeed he is required to do so, under the solemn obligations of an oath. If

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his invention has been carried into public use by fraud ; but for a series of months or years, he has taken no steps to assert his right ; 'would not this afford such evidence of acquiescence as to defeat his application, as effectually, as if he failed to state that he was the original inventor ? And the same evidence which should defeat his application for a patent, would, at any subsequent period, be fatal to his right. The evidence he exhibits to the department of State is not only *ex parte*, but interested ; and the questions of fact are left open, to be controverted by any one who shall think proper to contest the right under the patent.

A strict construction of the act, as it regards the public use of an invention, before it is patented, is not only required * by its letter and spirit, but also by sound [* 322] policy. A term of fourteen years was deemed sufficient for the enjoyment of an exclusive right of an invention by the inventor ; but if he may delay an application for his patent, at pleasure, although his invention be carried into public use, he may extend the period beyond what the law intended to give him. A pretence of fraud would afford no adequate security to the public in this respect, as artifice might be used to cover the transaction. The doctrine of presumed acquiescence, where the public use is known, or might be known to the inventor, is the only safe rule which can be adopted on this subject.

In the case under consideration it appears the plaintiff came to this country, from England, in the year 1817, and, being an alien, he could not apply for a patent until he had remained in the country two years. There was no legal obstruction to his obtaining a patent in the year 1819 ; but it seems that he failed to apply for one, until three years after he might have done so. Had he used proper diligence in this respect his right might have been secured, as his invention was not sold in England until the year 1819. But, in the two following

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arise out of the facts of the case, as stated in the bill of exceptions.

It may be proper, in the first place, to inquire whether the letters-patent which were obtained in 1829, on a surrender of the first patent, have relation to the emanation of the patent in 1822, or shall be considered as having been issued on an original application.

On the part of the plaintiff it is contended, that "the second patent is original and independent, and not a continuation of the first patent." That in adopting the policy of giving, for a term of years, exclusive rights to inventors in this country, we adopted at the same time the rules of the common law as applied to patents in England; and that by the common law, a patent, when defective, may be surrendered to the granting power, which vacates the right under it, and the king may grant the right *de novo* either to the same or to any other person.

This being the effect of the surrender of a patent in England, it is insisted, that the same consequence should follow a surrender in this country. On this subject it is said, that the decisions of the English Courts are uniform, and that not even a *dictum* can be found, that a second patent is a continuation of the first.

The counsel seems to consider this point of great importance, as the plaintiff was an alien when the first patent was obtained, but had become naturalized before the date of the second; and, consequently, that his rights under the second patent, cannot be governed by the law applicable to aliens. As the inquiry on this head is, whether the second patent has relation to the first, it is not necessary to look into the laws to ascertain the respective rights of aliens and citizens on this subject. In regard to the right of the patentee to surrender a defective patent, and take out a new one, there can be no difference between a citizen and an alien.

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* That the holder of a defective patent may sur- [* 315] render it to the department of State, and obtain a new one, which shall have relation to the emanation of the first, was decided by this Court at the last term in the case of Grant and others v. Raymond, 6 Peters, 220. The Chief Justice, in giving the opinion of the Court, says, "but the new patent, and the proceedings on which it issues, have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application; and if the new patent is valid, the law must be considered as satisfied, if the machine was not known or used before that application."

As this decision must be considered as settling the construction of the Patent Laws on this point, it is conclusive in the present case; and it is therefore unnecessary to examine the argument of the plaintiff's counsel, which was designed to lead to a different conclusion.

The second patent being a continuation of the first one, the rights of the plaintiff must be ascertained by the law under which the original application was made.

This law was passed on the 17th of April, 1800, and provides "that all and singular the rights and privileges given to citizens of the United States respecting patents for new inventions, &c., shall be extended to aliens, who at the time of petitioning, shall have resided for two years within the United States, &c. Provided, that every person petitioning for a patent for any invention, art, or discovery, pursuant to this act, shall make oath or affirmation before some person duly authorized to administer oaths, before such patent shall be granted, that such invention, art, or discovery, hath not, to the best of his or her knowledge or belief, been known or used, either in this or any foreign country; and that every patent which shall be obtained pursuant to this act, for any inven-

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tion, art, or discovery, which, it shall afterwards appear, had been known or used previous to such application for a patent, shall be utterly void."

By the Act of the 21st of February, 1793, which limits patent-rights to citizens, it is provided "that every [* 316] person or persons, *in his or their application for a patent, shall state that the machine, &c., was *not known or used* before such application."

The sixth section of this act provides that a defendant, when prosecuted for a violation of a patent-right, may give in evidence, under a notice, among other matters, "that the thing secured by patent was not originally discovered by the patentee, but had been in use, or had been described in some public work anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery of another person ; in either of which cases, judgment shall be rendered for the defendant with costs, and the patent shall be declared void."

It would seem, from the above provisions, that citizens and aliens, as to patent-rights, are placed substantially upon the same ground. In either case, if the invention was known or used by the public before it was patented, the patent is void. In both cases the right must be tested by the same rule.

From the facts in the case, it appears that the plaintiff, while residing in England, in 1813 or 1814, invented the instrument secured by his patent. That before he came to the United States, he made known his invention to his brother, to Mr. Manton, a gunmaker in London, and to others. That shortly after he came to the United States, in 1817, he disclosed his invention to a gunmaker in Philadelphia, and that in 1817 or 1818, the plaintiff's brother sold the invention to a gunmaker in London. That in 1819 the invention was sold and used in England ; and that in the two following

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years it was in public use there, and in the latter year also in France. That on the 19th of June, 1822, his first patent was obtained.

It also appears that in April, 1807, a patent was granted in England to one Forsyth, for fourteen years, for an invention on the same subject. This fact was shown by the plaintiff, it is presumed, as a reason why he did not take out a patent in England.

The question arises from these facts, and others which belong to the case, whether there was such a use in the public, of this invention, at the date of the plaintiff's first patent, as to render it void.

* By the plaintiff's counsel it is insisted, that if an [* 317] invention has been pirated, or fraudulently divulged, the inventor cannot thereby lose his right to his own invention and property ; and it makes no difference that the public have acquired the use of the invention without any participation in the fraud, unless the inventor has acquiesced in such use.

The right of the plaintiff to his invention, is compared to his right to other property, which cannot be divested by fraud or violence ; and the case of *Miller v. Taylor*, 4 Burr. 2303, where seven judges against four held, that, at common law, an author by publishing a literary composition does not abandon his right, is referred to as illustrative of the principle.

Several decisions by the Circuit Courts of the United States are cited to sustain the right of the plaintiff. In the case of *Whittemore v. Cutter*, 1 Gall. 482, the Court say, " it will not protect the plaintiff's patent, that he was the inventor of the improvements, if he suffered them to be used freely and fully by the public at large for so many years, combined with all the usual machinery ; for in such case, he must be deemed to have made a gift of them to the public, as much as a

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person who voluntarily opens his land as a highway, and suffers it to remain for a length of time devoted to public use."

In the case of *Goodyear v. Mathews*, 1 Paine's Rep. 301, the Court, in substance, say, "that if the plaintiff be the inventor, it is immaterial that the invention has been known and used for years before the application." And in the case of *Morris v. Huntington*, 1 Paine, 354, the Court say, that "no man is to be permitted to lie by for years, and then take out a patent. If he has been practising his invention with a view of improving it, and thereby rendering it a greater benefit to the public, before taking out a patent, that ought not to prejudice him. But it should always be a question submitted to the jury, what was the intent of the delay of the patent, and whether the allowing the invention to be used without a patent, should not be considered an abandonment or present of it to the public."

This was a case where a second patent had been obtained, the first being defective, and this, it would seem, was deemed sufficient to protect the right of the plaintiff, though [* 318] the public * had been in possession of the invention for six years before the emanation of the second patent.

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Dobson v. Campbell. 1 Sumner.

other cases cited in the note of Sergeant Williams before referred to.

STORY, J. We are of opinion, that the motion in arrest of judgment ought to be overruled. We accede to the doctrine stated at the bar, that a defective title cannot, after verdict, support a judgment; and therefore it constitutes a good ground for arresting the judgment. But the present is not such a case; but is merely the case of a good title defectively set forth. The defect, complained of, is the omission to state, that the assignments, on which the plaintiff's title is founded, were duly recorded in the office of the Department of State, which is made essential to pass the title of the original patentee by the fourth section of the Patent Act of the 21st of February, 1793, ch. 55. The general principle of law is, that, where a matter is so essentially necessary to be proved, to establish the plaintiff's right to recovery, that the jury could not be presumed to have found a verdict for him, unless it had been proved at the trial, there the omission to state that matter in express terms in the declaration is cured by the verdict, if the general terms of the declaration are otherwise sufficient to comprehend it. This was the doctrine of Lord Ellenborough in *Jackson v. Pesked*, (1 M. & Selw. R. 234); and it is very elaborately expounded by Mr. Sergeant Williams in his learned note to *Saunders* R. 228, a. The other authorities cited on behalf of the plaintiff are to the same effect. Now, it seems to us, that taking the whole declaration together, (however inartificially drawn,) the plaintiff sets up a title to the patent-right by assignment, and an enjoyment and use of the right under that title, and that he has been injured in that right under that title, by the piracy of the defendant. This cannot be true, nor could a verdict for the plaintiff have been found by the jury, if the deeds of assignment had not been duly recorded; for, unless

Ames v. Howard et al. 1 Sumner.

that was done, * nothing would pass by the deeds. [* 327]
 The cases of *Hitchins v. Stevens*, (2 Shower R. 233,) and *McMurdo v. Smith*, (7 T. R. 518,) cited at the bar, seem to us very strongly in point. So is *France v. Tringer*, Cro. Jac. 44.

There are stronger analogous cases in equity; for it has been held, that if a feoffment is stated without any averment of livery of seisen, or a bargain and sale without stating an enrolment; it is not a good cause of demurrer, but the Court will intend it perfect.¹ As to livery of seisin, it is far from being certain, that, if a feoffment is in terms pleaded, it is necessary, even at law, to aver it, since it is implied.²

Upon the whole, judgment must be entered for the plaintiff according to the verdict.

Judgment accordingly.

JOHN AMES v. CHARLES HOWARD AND OTHERS.

[1 Sumner 482. October T. 1833.]

Patents and specifications annexed thereto should be construed fairly and liberally, and not subjected to any over-nice or critical refinements.

Where an invention is so loosely and inaccurately described in the specification, that the Court cannot, without resorting to conjecture, gather what it is, then the patent is void; but if the Court can clearly see the nature and extent of the claim, however imperfectly and inartificially it may be expressed, the patent is good.

A patent contained the following words in the description of the invention: "I

¹ *Harrison v. Hogg*, 2 Ves. Jun. R. 323, 328.

² See Co. Litt. 303, b. *Throckmorton v. Tracy*, Plowden R. 144. See *Spieres v. Parker*, 1 T. R. 145, per Buller, J.; 1 Saund. R. 228, a, Williams's note.

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do not claim the felting, vats, rollers, presses, wire-cloth, or any separate parts of the above described machinery or apparatus, as my invention; what I do claim as new, and as my invention, is the construction and use of the peculiar cylinder above described, and the several parts thereof in combination for the purpose aforesaid." *Held*, that it is not the cylinder alone, or its several parts, which are claimed *per se*, but they are claimed in their actual combination with the other machinery, to make paper.

Seem, that no previous notice or claim of a right to the exclusive use of an invention is necessary to enable a patentee to maintain an action for an alleged violation of his patent-right.

It is the practice of this Court, in all cases of surprise at the trial, by new matter proving a ground material to either party, and clearly made out by affidavit, to postpone or continue the cause. If the party interested, however, elects to go on with the cause, relying upon other matters, he is understood to waive the matter of surprise, and he cannot take his chance with the jury and, if successful, then move the matter as a ground for a new trial.

A new trial is not granted upon mere cumulative evidence.

The defendants cannot put in new rebutting evidence to affidavits of the plaintiff, offered in reply to those first offered by the defendants.

[*483] *CASE for an infringement of a patent-right for a new and useful improvement in the machinery for making paper. The specification annexed to the patent contained the following summary of the invention, as claimed by the patentee: "The drawing hereto annexed is to be taken and considered as a part of this specification. But it is to be understood, that I do not claim the felting, vats, rollers, presses, wire-cloth, or *any separate parts of the above described machinery or apparatus, as my invention.* And I hereby declare, that what I claim, as new and as my invention, is the construction and use of the peculiar kind of cylinder above described, and the several parts thereof in combination for the purposes aforesaid." The cylinder here referred to is particularly described in the specification, and it is there stated to be partly immersed and used in the vat containing the paper pulp, "having one end of the cylinder close to the side of the vat, which forms a covering therefor." And in another part of the specification it is stated: "One end of the cylinder thus formed is to be covered, and made water-tight by a copper or other

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sufficient covering, and the other end, uncovered, is to be brought and kept in close contact with the side of the vat or reservoir aforesaid, which is to be so adapted to it, as to form a covering water-tight for that end of the cylinder, which while it revolves is below the top of the vat or reservoir." The specification then proceeds to describe the mode in which the water, draining through the cylinder, is to be conducted off through a hole in the side of the vat, which covers the open end of the cylinder. It was not disputed at the trial, that the cylinder was not capable of, nor intended for, any distinct use separate from the vat; and that to make paper on it, it was indispensable that it should be placed in the vat in the manner above described. Plea, the general issue, with notice of special matter.

* At the trial it was contended by the defend- [* 484] ants, that the true construction of the patent was, that the plaintiff claimed only the cylinder, and the several parts thereof, in combination with each other, as his peculiar invention. The Court thought otherwise; and declared to the jury, "that the patent is for the construction and use of the peculiar kind of cylinder, and the several parts thereof, in combination *with the other parts of the machinery*, for the purpose of making paper. It is for the combination, and not for the separate parts thereof. It is not for the peculiar structure and use of the cylinder alone, as the invention of the plaintiff; but it is for it in, and as a part of, the combination. Nor is it alone for the several parts of the cylinder, in actual combination by themselves with each other; but in the combination with other parts of the machinery to produce paper."

At the trial the cause was argued by *William Bliss* and *Rand* for the plaintiff, and by *George Bliss* and *Fletcher* for

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the defendants. The jury found a verdict for the plaintiff, for \$412.50, single damages.

A motion was afterwards made by the defendants for a new trial, the grounds of which appear in the opinion of the Court, and was argued by *Rand* for the plaintiff, who cited *Smith v. Brush*, 8 Johns. R. 84; *Pike v. Evans*, 15 Johns. R. 210; *Williams v. Baldwin*, 18 Johns. R. 489; *Strong v. Hogg*, 2 Wm. Black. R. 802; *Ford v. Tilly*, 2 Salk. R. 653; *Watson v. Sutton*, 1 Salk. R. 272; *Cooke v. Berry*, 1 Wils. R. 98; *Gist v. Mason*, 1 Term R. 84; *Stander v. Edwards*, 1 Ves. Jr. R. 134.

Fletcher, for the defendants, cited *Smith v. Brush*, 8 Johns. R. 84; *Pike v. Evans*, 15 Johns. R. 213; *Guyot v. Butts*, 4 Wendell R. 579; *Warren v. Hope*, 6 Greenl. R. 480.

STORY, J. The first ground of the motion is on account of a supposed misconstruction of the patent of the [*485] plaintiff by *the Court. And the question now is, whether the direction of the Court was right in point of law. Patents for inventions are not to be treated as mere monopolies odious in the eyes of the law, and therefore not to be favored; nor are they to be construed with the utmost rigor, as *strictissimi juris*. The Constitution of the United States, in giving authority to Congress to grant such patents for a limited period, declares the object to be to promote the progress of science and useful arts, an object as truly national, and meritorious, and well founded in public policy, as any which can possibly be within the scope of national protection. Hence it has always been the course of the American Courts, (and it has latterly become that of the English Courts also,) to construe these patents fairly and liberally and not to subject them to any over-nice and critical refinements. The object is to ascertain, what, from the fair

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sense of the words of the specification, is the nature and extent of the invention claimed by the party ; and when the nature and extent of that claim are apparent, not to fritter away his rights upon formal or subtle objections of a purely technical character.

Now, let us see, what is the invention, as claimed by the plaintiff in the specification in this case. I agree, that if he has left it wholly ambiguous and uncertain, so loosely defined, and so inaccurately expressed, that the Court cannot upon fair interpretation of the words, and without resorting to mere vague conjecture of intention, gather what it is, then the patent is void for this defect. But if the Court can clearly see, what is the nature and extent of the claim, by a reasonable use of the means of interpretation of the language used, then the plaintiff is entitled to the benefit of it, however imperfectly and inartificially he may have expressed himself. And for this purpose we are not to single out particular phrases standing alone, but to take the whole in connection.

The plaintiff * begins by stating negatively, what he [* 486] does not claim as his invention ; and this may well help us to ascertain what he does claim. He says he does not claim "the felting, vats, rollers, presses, wire-cloth, or any separate parts of the above described machinery or apparatus," as his invention. Now, among the above described machinery is the cylinder, and the several parts thereof. The cylinder therefore may fairly be deemed a separate part of the machinery, for it constitutes a part separable in its nature, and distinct in its formation, though adapted to a particular mode of use. He then proceeds to say, "What I do claim, as new and as my invention, is the construction and use of the peculiar cylinder above described, and the several parts thereof in combination for the purpose aforesaid." Now the defendants read this language, as if the words were, I claim the construction and use of this peculiar cylinder, and I claim the

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several parts thereof in combination with each other to form a cylinder for the purpose of making paper. Let us see whether this is consistent with giving a due effect to all the words used, and with the antecedent negative declarations of the plaintiff. He before has said, that he does not claim, as his invention, any of the separate parts of the machinery; therefore it is very clear that he does not claim the separate parts of the cylinder. But then, it is said, he claims these parts in combination with each other. But these parts in combination with each other constitute neither more nor less than the cylinder itself; so that, upon this construction, the words, "and the several parts thereof in combination," are mere repetition and tautology, and have no distinct meaning. The claim is read exactly, as if these words were struck out. Certainly no court of justice is at liberty to strike out any words, which are sensible in the place where they occur, and are capable of a distinct application. We are to [* 487] give, if practicable, * effect to all the words, as containing a distinct expression of the intention of the party. Besides, upon this interpretation of the language, the party does not claim the construction and use of the cylinder as his own, but the application of it to a particular purpose, as his own. It requires no commentary to establish, that the application of an old thing to a new use, without any other invention, is not a patentable contrivance. A man, who should use a common coffee-mill for the first time to grind peas, could hardly maintain a patent for it. A man, who should for the first time card wool on a common cotton carding-machine, would find it difficult to establish an exclusive right to the use of it for such a purpose. So that this construction of the words of the specification could hardly be presumed to express the intention of the party; for then he would not claim the thing, but a particular use of the thing for a particular purpose. The plaintiff in the present case

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claims more than the mere use; he claims the construction of this peculiar cylinder, and the several parts of it. And how does he claim them "in combination"? In what manner? In combination with each other? No; but "in combination for the purpose aforesaid;" that is, for the purpose of making paper. The grammatical connection of the passage, then, requires that we should read it, that he claims, as his invention, the cylinder itself, (as well as the several parts thereof,) in combination for the purpose of making paper. It is not then the cylinder alone, or its several parts, which are claimed *per se*; but they are claimed in their actual combination with the other machinery to make paper. In this view of the clause full effect is given to all the words, and the sense is at once natural and consistent. My judgment, therefore, is, that the construction given by the Court at the trial is correct; and that, as matter of law, there is no error in it.

*The next objection is necessarily out of the [*488] case; for the comment attributed to the Court was, upon a suggestion of the defendants' counsel, immediately withdrawn from the jury by the Court; and the whole matter of fact contained in Gilpin's deposition, as well as its credibility, was left entirely open and free to the jury. I cannot say, that they have misunderstood it; or that they have not drawn the right conclusion deducible from it. It was a matter peculiarly within their province; and the ample comments on Gilpin's testimony, at the trial, by the counsel on both sides, sufficiently evinced, that it was in some parts confused and unsatisfactory, and susceptible of different interpretations.

The next objection is, that in point of law the plaintiff is not entitled, without some previous notice, or claim, to maintain this action under his patent against the defendants, for continuing the use of the machines erected and put in use by them before the patent issued. This objection cannot prevail.

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I am by no means prepared to say, that any notice is, in cases of this sort, ever necessary to any party who is actually using a machine in violation of a patent-right. But it is very clear, that in this case enough was established in evidence to show, that the defendants had the most ample knowledge of the original patent taken out by the plaintiff in 1822, and of which the present is only a continuation, being grounded upon a surrender of the first for mere defects in the original specification. Whoever erects or uses a patented machine, does it at his peril. He takes upon himself all the chances of its being originally valid ; or of its being afterwards made so by a surrender of it, and the grant of a new patent, which may cure any defects, and is grantable according to the principles of law. That this new patent was so grantable is clear, as well from the decision of the Supreme Court in *Grant v.*

Raymond (6 Peters R. 218,) as from the Act of [* 489] * Congress of the 3d of July, 1833, ch. 162. There is no pretence to say, that the defendants were *bona fide* purchasers without any knowledge or notice of any adverse claim of the plaintiff under this original patent ; and the damages were by the Court expressly limited to damages, which accrued to the plaintiff by the use of the machine after the new patent was granted to the plaintiff. Without doubt the jury conformed in their verdict to this direction of the Court.

The other original objections may be passed over without notice, and indeed are insupportable in point of law.

But another ground for a new trial has been since filed, founded partly upon surprise at the trial, and partly upon the discovery of new evidence applicable to the point, stated at the trial, which constitutes the matter of surprise. It came out in evidence on the trial, in the course of the cross-examinations, that the original cylinder constructed by the plaintiff had bars of wood, instead of brass ; and one or more of the

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witnesses asserted, that the brass bars were substituted for wood after the grant of the original patent in 1822. This was explicitly denied by other witnesses on behalf of the plaintiff, who asserted, that the brass bars were substituted before the patent. Upon this point the parties were at issue at the trial; and it was made a strong ground of defence. No application was made to the Court by the defendants for a postponement or continuance of the cause for the purpose of a more full and thorough examination of the point, or to search for farther testimony. The uniform practice of this Court is, in all cases of surprise at the trial by new matters, forming a ground important to either party, and clearly made out by affidavit, to postpone or continue the cause. And if the party interested makes no such application, but elects to go on with the cause, relying upon his other strength to sustain his claim or defence, he is understood to waive the * matter of surprise; and he cannot be permitted to take his chance with the jury, and, if unsuccessful, then to move the matter, as a ground for a new trial. The purposes of justice would be defeated and not advanced by any different course. And Courts, which adopt a different rule, act upon the ground, that in their own modes of trial and practice the party has no opportunity to postpone or continue the cause; but is compellable to proceed in the trial. Upon this short ground, therefore, the objection of surprise is removed from the case.

But it is by no means clear, that the matter so waived was, in point of law, a good ground of defence to the action. That depended upon the fact, whether the plaintiff made it by his specification a constituent part of his invention, that the bars should be of brass, and not of wood; for if they might be made of either, consistently with his general claim, then there was no objection to the patent in this respect. Now, the Court was by no means satisfied, at the trial, that such

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was in fact the claim of the plaintiff. But for the purposes of the trial, the evidence was left to the jury, as if it constituted a complete ground of defence. The jury so acted upon it; and, having decided against it, as matter of fact, it would be a strong ground for the Court to interfere now upon a mere doubt, whether the plaintiff's claim had, in point of law, such an extent or not. I do not state this with any other view, than to say, that it is a matter still *sub judice*, upon which my mind is not so clear, as to induce me to grant a new trial, merely with a view to open anew the discussion of it.

But, then, as to the new evidence offered, what is its nature? It is merely cumulative; and the settled practice of this Court is never to grant a new trial upon mere cumulative evidence, where there is no other ground of objection to the verdict. That point has been fully considered in [* 491] the case * of *Alsop v. The Commercial Insurance Company* at this term. But it has been long since established in the habitual course of proceedings of the Court. The counter affidavits, however, offered on behalf of the plaintiff, go to establish strong cumulative proofs the other way. And under such circumstances, the Court will always decline to interfere; because it will not undertake to measure the weight of the new testimony on either side, or send the parties again to litigation upon the chances of a verdict, upon new conflicting evidence. The defendants have asked, if they may put in new rebutting evidence to the affidavits of the plaintiff, offered in reply to those first offered by themselves. Certainly not. They must present their whole case at once to the Court; and not lead it on through a series of confirming and rebutting proofs, thus protracting the cause to an unreasonable extent.

There is another view, which may properly be taken of this point. The special written notice of defence by the

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defendants, actually includes within its reach the very matter now set up as a surprise. It states, that the invention claimed by the plaintiff by his patent in 1832, "is, according to the specification thereof, wholly different and distinct" from the pretended invention mentioned in the patent of 1822. Of course this notice covers the whole claim of each patent; and it puts in controversy every part of the last patent, which is distinguishable from the first, and does not constitute a part of the invention claimed in the first. The defendant, therefore, was, by his own special notice of defence, bound to institute all proper inquiries into the nature and actual structure of the original machine, and all the differences between that and the structure of the machine described in the patent of 1832. If he had used ordinary diligence, it is now manifest, that he might have obtained full evidence to any point, which *could properly sustain the defence. [*492] He came to the trial, content with the preparation and the points, to which his evidence actually led him; and there can be no reason for letting him into a new trial, merely because he could now, upon farther reflection and farther lights, have made a fuller or a better defence. *Interest reipublicæ ut finis esset litium*, is an old maxim deeply fixed in the fundamentals of the common law. And Voet beautifully expressed its true reason, when he said, "*Ne autem lites immortales essent, dum litigantes mortales sint.*"¹

The motion for a new trial is therefore overruled.

Motion overruled.

¹ Voet ad Pand., Lib. 5, tit. 1, § 53, p. 328.

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JESSE DELANO, JUNIOR, v. JOHN SCOTT.¹

[1 Gilpin, 489. August T. 1834.]

1. The provisions of the sixth section of the Act of 21st February, 1793, are intended to declare the defence that shall be available to a party charged by a patentee with a violation of his right.
2. The provisions of the tenth section of the Act of 21st February, 1793, apply only to cases in which a patent has been obtained by fraud, surreptitiously, or by false suggestions, and are intended to protect the public from imposition.
3. Though a patentee believes himself, *bonâ fide*, to be the original inventor of the improvement patented, yet the fact of his not being so, if it does not constitute a false suggestion in obtaining it, appears to be a sufficient ground for repealing it.
4. The mere existence of a previous patent or specification of an improvement [* 490] is not sufficient to establish the fact of fraud in a subsequent patentee of a similar improvement; actual knowledge of it must be proved.
5. If there be a false suggestion in any of several material facts set forth in a specification, the patent is invalid.
6. An order, on a rule to show cause why a *scire facias* should not issue to repeal a patent, is merely a preliminary proceeding, and does not determine the question of the validity of the patent.
7. An exemplification of a patent afterwards surrendered and cancelled, may be given in evidence to show that an improvement, subsequently patented, is not original.
8. A mere workman, employed by a person who is not the patentee, to make parts of a patented machine, is not liable to a penalty under the provisions of the Act of 21st February, 1793.
9. A mere difference in the manner and form of applying an invention, which is the same in principle with one previously used, will not justify a new patent.
10. A judgment against a patentee, on a *scire facias* issued to obtain a repeal

¹ The provisions of the Act of 1793, relating to the *repeal* of patents by *scire facias*, have not been reënacted by the Act of 1836, revising the previous Patent Laws, and are not now in force.

See *Evans v. Eaton*, *ante*, 68, 193, 243.

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of a patent, vacates the same ; but a judgment in his favor will not prevent his right being contested in a suit he may subsequently institute for its violation.

THIS was a suit brought by *scire facias*, for the purpose of repealing a patent obtained by the defendant from the United States, under which he claimed the sole and exclusive right of using, and vending to others, certain improvements in making iron chests or safes. This patent, the plaintiff alleged, he had obtained surreptitiously and on false suggestions.

The original proceedings in the case were as follows. On the 29th October, 1833, the plaintiff appeared before the district judge of the United States for the Eastern District of Pennsylvania, and on his oath declared and complained — that the defendant, who was a resident of the district, had, on the 12th November, 1830, and within three years from this application, as well as within three years from the issuing of the patent in question, obtained the same from the United States ; that it purported to secure to him the right above stated for fourteen years from the date thereof ; that it was obtained by the defendant surreptitiously and on false suggestions ; that he was not the true inventor of the improvements described in it ; and therefore praying that a rule might be granted, calling on the defendant to show cause why process should not be issued, for * the purpose of repealing [* 491] the patent, according to the provisions of the Act of Congress, in such case made and provided.

On the 14th March, 1834, this application was argued by *Perkins* for the plaintiff, and *Earle* for the defendant.

On the 21st March, Judge HOPKINSON delivered the following opinion :

The affidavit of the complainant in this case was made on

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the 29th day of October, 1833, and set forth, that the defendant, John Scott, within three years antecedent to the date of the said affidavit, to wit, on the 12th day of November, 1830, had obtained, from the United States, a patent, to secure to him for fourteen years the sole and exclusive right to vend to others certain improvements in making iron chests or safes; that this patent was obtained by the said Scott surreptitiously and upon false suggestions; and that the said Scott is not the true inventor or discoverer of the said improvements. Upon this affidavit a rule was granted, calling on the said Scott to show cause why process should not issue to repeal the said letters-patent. The rule was duly served on the defendant, and he has appeared, by his counsel, to show cause against the issuing of the process demanded.

The affidavit contains two allegations, distinctly made. 1. That the patent in question was obtained surreptitiously and by false suggestions. That the patentee is not the true inventor or discoverer of the improvement patented.

To maintain these allegations, the complainant has given in evidence a patent granted to himself for the same improvements, as he avers, dated the 7th March, 1826; and also the depositions of several witnesses to prove the identity, at least, substantially, of the improvements patented in the two patents, and also to show the fraud of the defendant in obtaining his patent. These witnesses swear, in general, that the improvements are substantially the same, and particularly describe both. They also testify, that the defendant, Scott, was em-

ployed by the complainant as a workman in doing
[* 492] the iron work of these chests, for about * two years,

having, during that time, had free access to all parts of the work carried on in the shop, and there become acquainted with the business of making iron chests and safes, and with the peculiar method of saturating the wood with certain materials, so as to render it incombustible. Other

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circumstances are detailed, which need not be repeated now, to show that the patentee got his whole knowledge of the improvements in question by working in the shop of the complainant, and there seeing the manner in which his iron chests were prepared and made. No evidence was produced, on the part of the defendant, to rebut or explain the inference that would be drawn from these facts, to wit, that when he took out his patent he knew that he was not the inventor or discoverer of the improvements he claimed and patented. Nor has he given any testimony of persons skilled in the manufacture of the article in question, to show that his manner of preparing and making these chests is not substantially and truly the same, with that before used and patented by the complainant. If the alleged improvements in both patents are the same, and if the defendant acquired his knowledge of them by working in the shop of the complainant, where they were made, then the whole case of the complainant is made out, to wit, that the defendant is not the true inventor or discoverer of the thing he has patented, and that he did obtain his patent surreptitiously and by false suggestions, by swearing to that which he knew to be untrue. This is not the stage of this proceeding when I am called upon definitively to affirm or deny either of these allegations; they are questions of fact on which the defendant has a right to the opinion and verdict of a jury of his country, on such evidence and arguments as it may hereafter be in his power to offer to them. Having already acted on the opinion, that the matter alleged in the complainant's affidavit was sufficient to grant the rule upon the patentee to show cause why process should not issue against him, to repeal his patent, I have only now to decide whether he has shown such cause, and removed the effect of the complainant's affidavit. I think he has not done so; on the contrary, he has offered no *evi- [* 493] dence to repel, or weaken, or discredit the allega-

tions of the complainant, who has strengthened himself by the depositions of several witnesses. I repeat that the whole case is nevertheless open to the defendant; he may reserve his defence for the future inquiry before a jury, and will not then be prejudiced by any omissions on his part, at this incipient hearing, or by any opinion I may express of his case as it now stands.

Some questions of law, on the construction of the tenth section of the Patent Law of 21st February, 1793, have been mooted in the argument of the case, which I will briefly notice.

If I were called to give a construction, for the first time, to this section, I confess I should have some embarrassment to reconcile and satisfy all its parts. But happily this section has been carefully and critically examined, not only by a learned judge of the Supreme Court of the United States in his circuit, (*Stearns v. Barrett*, 1 Mason, 153,) but afterwards by that Court itself, (*Ex parte Wood*, 9 Wheaton, 603.) The decisions of that Court on the doubtful points in this law, not only bind me by their authority, but entirely satisfy and accord with my own judgment. They give the fullest justice to the parties interested, while they do no violence to any part of the act, but make all its provisions consistent with each other, and with the general principles of justice and law. The following points seem to me to be the settled construction of the section in question. 1. That the proceeding given by it, to procure the repeal of a patent, applies only to cases in which the patent has been obtained by fraud, surreptitiously, by false suggestions, by some wilful misrepresentation and deception. The mere fact that the patentee was not the original inventor of the thing patented, is not such a false suggestion as is contemplated by the act, although there are some words in it which seem to favor that construction, provided that the patentee, *bonâ fide* believed himself to be the true inven-

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tor, when he applied for and received his patent, and did not know of any antecedent use and invention of the thing claimed by him. There must be an intended deception and fraud upon the *government and the public ; a [* 494] wilful wrong to the true inventor, (post p. 713.)

2. That the hearing, on the return of the rule to show cause, is merely an initial proceeding, for a more full and deliberate examination and trial of the cause of complaint, if, in the opinion of the judge, there shall be a good and sufficient ground laid for such further examination ; that the order of the judge, on this hearing, cannot be that the patent is invalid, but only that process shall issue for a trial of its validity ; and it is upon such trial that the question of validity is to be determined, or an issue to be made between the parties, and the letters-patent to be repealed by the judgment of the Court, if the issue shall be decided against the patentee. 3. That on the return of the process issued on the rule, the parties will make up their issue according to the case in controversy ; and the trial will be by a jury or the Court, according as the issue shall present a question of fact or of law. The decision against the patentee will repeal and vacate his letters-patent, but a decision of this issue in his favor will give no strength or confirmation to them, to prevent his right from being contested and tried in any suit he may afterwards bring for a violation of it. The summary proceeding under the tenth section was probably given to protect the public from manifest frauds, in taking out patents, (the fees of office being no check,) for known and common things. The imposing appearance of the patent would deceive the timid and ignorant, who might believe it was conclusive evidence of right, or who might be unable or unwilling to take upon themselves the hazard, and the certain loss of time and money, in which they would be involved by litigation. They would, therefore, wisely prefer to pay something for the peaceable use of the

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pretended invention. Such frauds have been, more than once, successfully practised.

It is ORDERED, that the rule in this case be made absolute, and that process issue, in nature of a *scire facias*, to the patentee, to show cause why the patent should not be repealed, with costs of suit.

[* 495] * On the 2d May, 1834, the writ of *scire facias* issued, to which the defendant subsequently pleaded not guilty, with leave to give the special matter in evidence.

On the 27th May, 1835, the case came on for trial before Judge HOPKINSON and a special jury. It was argued by *Perkins*, for the plaintiff, and *Earle* and *Dallas* for the defendant.

Perkins, for the plaintiff.

This suit is a proceeding under the tenth section of the Act of Congress of 21st February, 1793, (1 Story's Laws, 303,) directing the manner in which a patent may be repealed, if it has been obtained surreptitiously or upon false suggestions. The plaintiff invented a mode of making iron chests so as to render them incombustible. On the 7th March, 1826, he took out a patent for his improvements, which are detailed in his specification. In October, 1827, Scott, the defendant, came to work in the plaintiff's shop, who was then making iron chests according to his patent. He remained working in his shop until September, 1829, when he went to Ohio. He returned to New York in about a year. The plaintiff had heard in the mean time that he had been making iron chests; he charged him with it, but he denied it. He was then allowed to go over the factory. He went away, declin-

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ing employment by Delano, and came to Philadelphia where he set up a manufactory of iron chests the same as those made by Delano. In October, 1830, he took out his patent for them, making the usual affidavit. It is to repeal this patent, as having been obtained surreptitiously and by false suggestions, that this proceeding has been instituted.

The affidavit of Scott, made before Alderman Badger on the 29th October, 1830, was then read. In this he swears that he believes himself to be the true and original inventor of the improvements within specified and described ; and that the same, to the best of his knowledge and belief, had not been known or used either in this or any foreign country.

The counsel for the plaintiff then stated in detail the improvements claimed by Scott, amounting to ten.

He then * offered a certified official copy of a pa- [* 496] tent taken out by the plaintiff, which was afterwards surrendered and cancelled on account of a defective specification ; and a new patent obtained on 13th August, 1834. This cancelled patent was offered to show that Scott's first specification had been previously patented ; it was to be followed by evidence of its use in the plaintiff's shop when Scott worked there.

Earle and Dallas, for the defendant.

We object to this evidence. The paper is imperfect. We should know when it was cancelled ; how and for what defect or reason. If the plaintiff can show that he had used potash in New York, and that Scott knew it, that is sufficient without this paper. He should first show that Scott knew the existence of this paper.

Perkins, for the plaintiff, in reply.

By the third section of the Act of 21st February, 1793, (1 Story's Laws, 302,) "certified copies are competent evi-

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dence in all Courts when any matter or thing, touching a patent-right, shall come in question."

Judge HOPKINSON delivered the following opinion:

I admit the evidence. The plaintiff is to prove two things; 1. That Scott is not the inventor of the improvement in question. 2. That he obtained his patent surreptitiously. To prove the second point, he must show knowledge of the defendant, that he was not the inventor; though he need not do so to prove the first. This evidence is good for the former purpose, that is, to show he was not the original inventor. The copy offered proves the existence of the original in the department of State..

Perkins, for the plaintiff, in continuation.

All the specifications of Scott's patent show that none of them were his inventions. A great number of witnesses examined, all show that these improvements were in Delano's patent; that they were used by him before Scott's application for a patent; and that Scott had full knowledge [* 497] that they were so used. * They further prove that Scott's first knowledge of the business was obtained in Delano's shop; he was entirely ignorant of every part of it when he came there.

Thomas Archbold, being offered by the plaintiff as a witness, was sworn on his *voire dire*. He said he had made springs to the bolt, such as are described in Scott's patent.

Earle and *Dallas*, for the defendant, object.

The witness is not competent; he has an interest in the event of the suit. If, by this verdict and judgment, Scott's patent should be affirmed, it might be given in evidence against the witness in a suit for infringing the patent; he

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has, therefore, an interest to destroy it in order to secure himself. Scott might sue on his patent, even if the verdict and judgment here should declare it invalid. Agents who vend a patented article are liable to damages. The witness has admitted that he has violated the patent ; and is, therefore, liable for damages. He cannot be permitted to take away from Scott the capacity to sue him. *Hayes v. Grier*, 4 Binney, 83 ; *Conrad v. Keyser*, 5 Serg. & Raw. 371.

The witness, being called back by the judge, says, that he has made these bolts in the shop of Mr. Delano, as one of his workmen.

Judge HOPKINSON stopped the counsel for the plaintiff, who was about to reply.

On general principles I should think the evidence admissible. To exclude it, the interest of the witness should be more certain and immediate ; not so contingent, remote, and dubious. The possibility that an action might be brought against him, in case his testimony should not prevail, or the tendency of his testimony to render his liability less probable, would not exclude him ; it may affect his credit, but not his competency. 1 Starkie, Ev. 86, 88. But it is clear to me that the witness would not be liable to any damages for the violation of Scott's patent, should it be found to be a good and valid one. He is not within the terms of the fifth section of the act. It is there enacted, " that if any person shall make, * devise, and use, or sell the [* 498] thing so invented, he shall forfeit and pay to the patentee." In my opinion, this description does not, and was never intended, to embrace every workman who may be employed in making parts of a patented machine ; nor one who may sell them as the shopman or clerk of another. The maker and seller intended by the act, is the principal who employs these subordinate agents ; the person for whom, by

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whose direction, and on whose account, the machines are made and sold; the person who receives the profit of the sale; he is the seller and the maker. It is he who claims title and property in the thing, and who undertakes to transfer it to the purchaser. The workmen employed by him for stipulated wages, have nothing to do with his right, or with his invasion of the rights of another. They work under his direction, and sell on his account. There may be a dozen or more mechanics employed in making one machine; and several attending in the shop where it is sold. Is each of these liable for damages, that is, to forfeit and pay to the patentee a sum at least three times the price for which the patentee has usually sold his invention? If this be the law, the patentee would recover for every invasion of his right, for every machine made and sold, not three times but fifty or an hundred times the price of it; although no one of the defendants made the machine, but it was the joint work of all. The witness now offered, and objected to, made nothing but the spring bolts of the chests. So, as to the persons who may sell it, as the shopmen or clerks of the owner. In common parlance, as well as in the understanding of the law, the seller of an article is the owner for whom it is sold; not the man or boy in the shop who delivers it to the buyer and receives his money. If sold on credit, the buyer becomes the debtor of the owner, of the master of the shop, as the seller.

Perkins, for the plaintiff.

The evidence being closed on both sides, the case was argued by the counsel for the plaintiff, who cited [* 499] *Odiorne v. Winkley*, 2 Gallison, 51; *Stearns v. Barrett*, 1 Mason, 153, 171; *Evans v. Eaton*, Peters, C. C. Rep. 342; Same case, 3 Wheaton, 454; *Ex parte Wood*, 9 Wheaton, 603.

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Earle and *Dallas*, for the defendant.

The evidence of the case shows, that some of the improvements introduced by Scott, were new and useful; but the main question is not, whether he was or was not the inventor of them or any of them; but whether he has falsely and surreptitiously taken a patent for that of which he then knew he was not the inventor. *Evans v. Eaton, Peters*, C. C. Rep. 342.

Judge HOPKINSON delivered the following charge to the jury:

The issue you are now trying, is made under the provisions of the tenth section of the Act of 21st February, 1793. The question is on the repeal of the patent granted to the defendant; you will observe that a patent may also be annulled under the sixth section of this act. By the terms of that section, if the specification of the patentee does not contain the whole truth relative to his discovery; or contains more than is necessary, for the purpose of deceiving the public; or if it was not originally discovered by the patentee; or he had surreptitiously obtained a patent for the discovery of another person, judgment shall be rendered for the defendant, and the patent shall be declared void. Under the tenth section, the patent will also be repealed, if the patentee was not the true inventor of the thing; or had obtained the patent surreptitiously. These sections, however, are essentially different in their objects and provisions. The sixth section declares the defences that shall be available for a party against whom a patentee has brought suit for the invasion of his right; but no process or means are given for the examination of a patent-right, however false and fraudulent it may be, if the patentee will be content to forbear to bring a suit against those who use it. He may thus avoid all examination of his right, and he may go on imposing upon the ignorant or timid, and lay

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his unjust contributions upon them. A case is recorded of a patent for using the common stone coal in a common blacksmith's forge. The patentee went through the country exhibiting his parchment patent with the great seal of the department of State, and the signatures of the high officers of government appended to it. This would naturally alarm an ignorant smith, and as the patentee would sell him a right for two or three dollars, or for whatever he could get for it, a prudent man would prefer paying so small a sum, rather than go to law with an adversary apparently so well armed. To protect the public from such impositions, this tenth section was enacted, and gives the power, to any person, interested or not in the discovery, or the patent, to call upon the patentee for an examination of his right, and have it repealed, if it shall be found that he is not entitled to it. This proceeding, however, must be instituted within three years; for if the public acquiesces for that period in the claim of the patentee, it shall only be questioned by one against whom a suit is brought for a violation of it, when the defendant will always have the benefit of the defence provided for him by the sixth section of the act.

With this explanation of these sections of the Patent Act you will inquire whether the specifications contained in Scott's patent, or any of them, are substantially the same with those used in Delano's chests, or in any other chest, French, English, or German, antecedent to Scott's patent, and his claim of invention. I say substantially, for a difference in the manner or form of applying the invention, if it be the same principle, will not justify Scott's patent. I have also said, 'or any of them,' for the petition and oath claim all and each of them; and if there be a false suggestion in a material fact, the patent is invalid. So, on another settled principle of law, he must not patent more than his invention, or all is invalid. If you

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shall think that all or any of Scott's specifications were used before by Delano, or any other person, his patent can give him no title to them.

But you have to inquire into another question here. Did the defendant obtain his patent "surreptitiously or upon a false suggestion?" If he knew that Delano, or any other person, had *previously used his pre- [* 501] tended inventions, he certainly obtained his patent by falsely suggesting that he was the inventor. An important question on the construction of this section of the act here presents itself; whether the mere fact that the allegation or suggestion of the patentee was false; that is, that in truth he was not the inventor, when he alleged that he was; will be sufficient to warrant a verdict and judgment against him, repealing his patent, in this proceeding; or, whether the complainant must not go further, and show that the defendant knew that he was not the inventor, and of course knew that his allegation was false, and therefore wilfully deceived the government and the public in obtaining the patent. When the application in this case was made to me, in March, 1834, for a rule upon the defendant to show cause why process should not issue to repeal his patent, the question now proposed was not much attended to. The argument was more on the mode of proceeding than the merits of the case. In the opinion (*ante*, p. 493) I then said, that I considered it to be the settled construction of this section "that the proceeding given by it to procure the repeal of the patent, applies only to cases in which the patent has been obtained by fraud, surreptitiously, by false suggestions, by some wilful misrepresentation and deception. The mere fact that the patentee was not the original inventor of the thing patented, is not such a false suggestion as is contemplated by the act, (although there are some words in it which seem to favor that construction,) provided that the patentee, *bonâ fide*, believed himself

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to be the true inventor, when he applied for and received his patent, and did not know of any antecedent use and invention of the thing claimed by him. There must be an intended deception and fraud upon the government and the public; a wilful wrong to the true inventor." On a further consideration of the subject, I am led to doubt the correctness of this opinion; indeed, it is but one of several difficulties which occur, in reconciling the different parts and provisions of this law. The first part of the section unequivocally requires that the oath or affirmation, which is the commencement [* 502] of the * proceeding, the very foundation of the complaint, shall affirm that the patent "was obtained surreptitiously or upon false suggestions." If I were left to give a meaning to these words alone, with nothing more in the act to show the intention of the legislature, I should adhere to the opinion that the falsehood alluded to was a known and wilful untruth, the fraud a surreptitious application, a designed and wilful deception. But when the process has been issued on this affidavit, and the parties appear here, the one to maintain his complaint as set forth in the affidavit, and the other to defend himself against that complaint, which is, that he obtained his patent surreptitiously or by false suggestion, we find the ground of inquiry much widened, and this Court is directed to render a judgment for the repeal of the patent, "in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer." The manner of obtaining the patent, whether by fraud and falsehood, whether *bond fide* or surreptitiously, is left out of the case, and it is your duty and mine to repeal the patent on the grounds I have mentioned.

While this obscurity in the law has brought me to doubt the construction I formerly gave to it, I shall nevertheless instruct you, in your consideration of this case, to take the law

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to be as I held it on the application for this process. I must presume that the defendant has prepared his defence on the law as I then laid it down, and it would be unjust to place him on a worse footing now. He shall have the benefit of my mistake, if it was one, and the other party will have the opportunity, should it be necessary, to have the question more deliberately argued and decided, by this or another Court. For the purpose of this trial you will hold it to be necessary, to justify a verdict against the defendant, that when he applied for and took his patent, he knew that the things, or some of them, that he claimed as his inventions, had been used before, and were not his discoveries.

Knowledge, then, being necessary to bring the defendant under the penalty of this section of the act, we must inquire * what the knowledge is that will be [* 503] sufficient for his condemnation. The complainant, in the first place, insists upon the legal or presumptive knowledge arising from the record of Delano's patent, long before that obtained by the defendant. The record of Delano's patent and its specification could be no notice of his discoveries to Scott, unless there is a substantial identity between the specifications of the two patents. This you will decide. You have them both, and have heard the elaborate arguments of the counsel of the respective parties, affirming and denying this identity. If you shall be satisfied that such identity does exist between the two specifications of Delano and Scott, the question then occurs, whether the record of Delano's patent in the office of the department of State, was such a notice to Scott of that patent and its specifications, as will bring him within the provisions of the tenth section of the Patent Law? Is it such a knowledge or notice as will render his suggestion or allegation that he was the inventor, surreptitious and false, according to the construction I have given to that section? Must actual knowledge be brought home to him of a previous

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use or patent of the same inventions ; or will a legal construction or presumptive knowledge be sufficient ?

With the interpretation I have adopted of this section of the act, a constructive notice of a preceding patent will not be sufficient for the condemnation of the defendant ; to fix the charge of actual falsehood and fraud upon him, actual knowledge must be proved. It is not like the case of a disputed right to property between two purchasers, where, if the first buyer has put his deed on record, he has given all the notice of his title the law requires, and a subsequent purchaser who neglects to make the inquiry at the proper place, will buy at his peril. The case of *Odiorne v. Winkley*, 2 Gallison, 51, was a suit brought under the sixth section of the act for the invasion of a patent-right.

It is probable, however, that you will make up your opinion respecting the knowledge that Scott had of Delano's inventions from the direct evidence in the cause. It is [* 504] certain that Scott * knew Delano had a patent for improvements in making iron chests, and being about to get a patent himself for the same object, you will judge whether it is not to be presumed that he did inquire at the Patent Office, what the improvements of Delano were. In addition to this reasonable presumption, much stronger than the ordinary constructive notice afforded by a recorded instrument, you have evidence that Scott came to Delano's shop as a common smith, having never before been engaged in making iron chests, nor, as far as we know, having ever seen one made ; and that, if you are satisfied of the identity of the improvements claimed, the chests of Scott are the same with those he saw made, and assisted in making, in Delano's shop. If this evidence is relied upon, it brings home to Scott the full knowledge of Delano's improvements, and, of course, when he obtained a patent for them for himself, he did it surreptitiously and by false suggestion. (The judge then reca-

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pitulated to the jury the prominent parts of the testimony, to show the actual knowledge of the defendant, that the improvements he has patented, were those previously patented by Delano, and that he obtained his knowledge of them in Delano's shop.)

The jury found a verdict for the plaintiff.

BENJAMIN WOOD v. WILLIAM WILLIAMS.

[1 Gilpin, 517. November T. 1834.]

1. A controversy, respecting the validity of a patent-right, is one strictly between the parties immediately concerned, although the public may have an eventual interest in it.
2. Under the Patent Laws, the United States are not a party in a litigation respecting the validity of any rights claimed or denied by virtue of those laws.
3. Where the district Court, under the provisions of the Act of 21st February, 1793, orders a *scire facias* to be issued against a patentee, on the prayer of a petitioner, they will not permit the United States to be substituted as plaintiffs in the place of the petitioner.

On the 23d May, 1834, a rule was granted on the defendant, to show cause why process should not be issued to repeal his patent, for a certain machine for hulling and clearing clover seed; under the provisions of the tenth section of the Act of Congress of 21st February, 1793, 1 Story's Laws, 303.

On the 9th December, 1834, the case was argued by *Meredith*, for the plaintiff, and *Kittera*, for the defendant.

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Meredith, for the plaintiff.

The affidavit of the plaintiff, on which the rule was granted, was read. This affidavit was not received as evidence, but read, *de bene esse*, by consent. The depositions of several witnesses, taken under a rule of Court, were also read to support the motion.

Kittera, for the defendant.

It is denied that either the deposition of the plaintiff on which the rule was granted, or a subsequent deposition made by him, is any evidence on this hearing. If the other testimony of the plaintiff furnishes a probable case against the defendant, then the *scire facias* will be issued ; otherwise the process will be refused. The facts of the case do not furnish such a one as will warrant the process prayed for.

[* 518] *Meredith*, for the plaintiff, in reply.

The deposition of the plaintiff is evidence on this hearing. This is a prosecution, by the government of the United States, to repeal a patent improvidently issued by them ; and the complainant is but the mover of the proceeding. The opinion of this Court, in the case of *Delano v. Scott*, (*ante*, p. 492,) shows that the original affidavit, on which the rule was granted, is good evidence at this hearing.

Judge HOPKINSON delivered the following opinion :

No such thing was decided, or intended to be so, in that case. No such question was raised. In my opinion, I referred to the affidavit of the complainant, as exhibiting the ground of the application, and showing the allegations of the complainant against the defendant. I then proceeded to state the evidence by which the complainant had maintained his allegations ; to wit, 1. A certain patent ; 2. Depositions of witnesses. The affidavit of the complainant is not mentioned

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as any part of the testimony. The paragraph quoted, towards the conclusion of the opinion, is a simple declaration, that the defendant had given no evidence to contradict the allegations of the complainant in his affidavit. From this it cannot be inferred that the affidavit was a part of the evidence on which the Court acted. Whether, under the Act of Congress, this affidavit would be sufficient *prima facie* evidence, to call for some proof on the part of the defendant, and would be enough to grant the process upon, if not impeached or contradicted, is a question that remains open.

Meredith, in continuation.

It is contended that, on a full examination of the depositions produced, they are sufficient to sustain this application without the complainant's affidavit.

Judge HOPKINSON observed that there was sufficient cause on the other depositions, exclusive of that of the complainant, which he put out of the case, without giving any opinion on * its competency. It was unneces- [* 519] sary. A probable case had been made out against the defendant.

RULE made absolute, and process in the nature of a *scire facias* ordered to issue.

Afterwards the counsel for the complainant, previous to taking out the *scire facias* as above ordered, moved the Court for an order, that the cause be recorded and docketed, as an action wherein the United States are plaintiffs and William Williams is the defendant, and that the process of *scire facias* be issued as between those parties.

After hearing the argument, on the 9th December, 1834,

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for this motion, Judge HOPKINSON delivered the following opinion :

The petitioner, in this case, has so far sustained his complaint, in the manner prescribed by the Act of Congress, that process has been ordered to issue against the said William Williams to repeal his patent. This process is a *scire facias*, and, previous to taking it out, the complainant has moved for an order, that the cause be now recorded or docketed, as an action wherein the United States are plaintiffs, and the said William Williams is the defendant ; and that the process of *scire facias* be issued as between these parties.

No decision or practice, under the Patent Laws of the United States, has been adduced to support this motion ; but a reliance is had upon the practice in the Courts of England, in cases for the repeal of patents. The whole proceeding, both for obtaining a patent, and for revoking it, is so different in England from that prescribed by our law ; the character and foundation of the right, are so dissimilar in the two countries, that we cannot look, for a rule on this question, to the Courts of England ; especially if, upon an examination of our act, we shall there find such an indication of the course of proceeding intended to be given, as will guide us through the present difficulty. In the case of *Stearns v. Barrett*, 1 Mason, 153, Judge Story adverts to the difference between our Patent Laws and those of England. He says, “ A *scire facias* is a process altogether confined to the crown, with the exception of the single case, where two patents [* 520] * have issued for the same thing, in which case the prior patentee may maintain a *scire facias* to repeal the second patent. But under our Patent Act, any person, whether a patentee or not, may apply for the repeal. There are other differences which it is not now necessary to enumerate.”

I shall not find it necessary to go further than the Act of

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Congress, and the practice that has been adopted under it, so far as I have been able to obtain a knowledge of it, for the decision of the question now under consideration. This simply is, when process has been ordered and issued, by this Court, for the repeal of a patent, and the allegations, upon which the process was ordered, are to be put in a shape for trial, who are the parties to the suit? By and between whom is the issue to be made? Are the United States to be introduced as the plaintiffs to maintain the issue, to prove the truth of these allegations against the patentee, who is, of course, the defendant? Is the petitioner or complainant, at whose instance and on whose affidavit of the truth of the cause of complaint, the proceeding was commenced, who called upon the patentee to answer the complaint, at whose prayer the process was granted, who, up to this point, has appeared alone as the adversary of the patentee, now to withdraw himself from the record and the case, and, at his pleasure, without the coöperation or assent of any officer or authority of the United States, to put them in his place to carry on the war which he has provoked; which he only has the means of sustaining, or ought to have had when he commenced it?

On a careful review of the Patent Laws of the United States, I have found no indication of an intention, that the United States are to be brought in as a party to a litigation, respecting the validity of any rights claimed or denied under those laws. On the contrary, these rights are considered as the private rights of the party who has duly obtained them, and are afterwards to be impeached and defended as such. The parties to every suit for the trial of the right are the petitioner, on whose complaint the inquiry was instituted, and the patentee who asserts the * right. The [* 521] first is bound to make good his allegations that the patent was obtained surreptitiously, or upon false suggestions, and the other to defend himself against them. It is a contro-

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versy strictly between these parties, although the public may have an eventual interest in it. They have the same interest in every suit, in which the validity of a patent is contested ; for if it be defeated, the pretended invention becomes a common property, as fully as if the letters-patent had been repealed by the proceeding here adopted.

The proceeding, now in progress before the Court, was instituted under the authority and directions of the tenth section of the Act of 21st February, 1793. Do any of the provisions of this section give any countenance to the motion of the complainant ? The first step in the proceeding to obtain the repeal of a patent, is an oath or affirmation, made before the District Judge by the petitioner for the repeal, that the patent was obtained surreptitiously, or upon false suggestions. Upon this the judge, if the matter alleged appear to him to be sufficient, shall grant a rule, that the patentee show cause why process should not issue against him to repeal such patent. If, on the return and hearing of this rule, the cause shown to the contrary shall not be sufficient, the judge shall order process to be issued against the patentee. This process is a *scire facias*, upon which an issue is made, of fact or law as the case may be, and, on the trial, the petitioner or complainant is bound to make good the allegations contained in his petition and verified by his affidavit. He must prove affirmatively that the patent was obtained surreptitiously or upon false suggestions. The issue being thus tried, what is the judgment which, by the directions of the act, the Court must render, as it is determined, for the one party or the other ? If it shall be against the patentee, the judgment is, that his patent be repealed ; “ and if the party, (so he is denominated) at whose complaint the process issued, shall have judgment against him, he shall pay all such costs as the defendant shall be put to, in defending the suit, to be taxed by the Court.”

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* Is it not clear that the makers of this law considered the parties before the Court, the parties to the suit commenced by the process of *scire facias*, to be the petitioner or complainant, now the plaintiff, on the one side, and the patentee, now the defendant, on the other? There is no meaning in the language of the act, on the other construction. The complainant is expressly called the party, against whom, if the complaint is not sustained, the judgment of the Court is to be rendered; and who, by that judgment, is to be compelled to pay the costs of the patentee or defendant, as in other cases. Can the judgment in any suit be rendered against a person not a party to it? Is any one of these provisions consistent with the idea, that the United States are, at any stage of the proceeding, to be brought in by the motion of the complainant, and put upon the record as the plaintiffs in the suit, to have a judgment for costs rendered against them as "the party at whose complaint the process issued." The person or party, at whose complaint the process did issue and who was bound to sustain the allegations upon which it was issued, withdraws himself, on his own motion, from the controversy, and puts the United States there in his place, to suffer the penalty of his failure to support his own cause of action or complaint. The judgment is to be rendered against the party at whose complaint the process issued, and this cannot be done, unless the same party is also the party to the suit when the issue is tried and the judgment upon it rendered.

The Act of the 7th June, 1794, was passed to restore suits which had been commenced under the Act of 10th April, 1790, and had been suspended or abated by the repeal of that law. The enactment is, that such suits and process may be restored at the instance of the plaintiff or defendant, and "the parties to the said suits, actions, process, or proceedings are entitled to proceed, provided that, before any order or

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proceeding, other than for continuing said suits, after the reinstating thereof shall be entered or had, the defendant or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into Court [* 523] by summons, attachment, or such other * proceeding as is issued in other cases, for compelling the appearance of a party." Assuredly this provision was never intended for a suit to which the United States are a party; nor could the Court compel their appearance by summons, attachment, or any other proceeding. The complainant and the patentee are clearly considered by this act to be the parties plaintiff and defendant in the suit.

The practice of the Courts, so far as I have obtained a knowledge of it, is in conformity with this view of the law. The case of *Stearns v. Barrett*, 1 Mason, 153, stands on the docket, as reported, as a suit between the complainant and the patentee. Upon the return of the *scire facias*, the patentee, (that is, Barrett,) as the defendant, pleaded, "that his letters-patent were not upon false suggestion or surreptitiously obtained, as set forth in the said writ, and thereof he puts himself upon the country; and the plaintiff (that is, Stearns) puts himself, as to this issue, upon the country likewise." Upon the issue thus formed the parties, that is, Barrett and Stearns, went to trial before a jury. A special verdict was returned, in which the complainant and patentee, and nobody else, are treated and spoken of as the parties plaintiff and defendant. The jury find that the plaintiff has not supported his allegations, and therefore they find for the defendant; and accordingly, the judgment of the Court was rendered for the defendant. The learned judge, throughout a long examination of the case, on several controverted points, uniformly, as the jury in their verdict had done, speaks of the complainant and the patentee, as the plaintiff and defendant in the suit, and no other party is alluded to.

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The clerk of this Court has examined its records, and produced several actions for the repeal of patents. Some of them are upon motions for process, and some after the *scire facias* has issued. In all, the parties are stated on the record to be the complainant, as the plaintiff; and the patentee, as the defendant. Not an instance, in which the United States were introduced as the plaintiffs, or, in any other way, as a party to the * proceeding or suit, has been [* 524] shown by the counsel for this motion, or come to the knowledge of the Court.

The motion was overruled.

RYAN AND OTHERS v. GOODWIN AND OTHERS.

[3 Sumner, 514. May T. 1839.]

It is not necessary to the validity of a patent for a new and useful invention, that any of the ingredients should be new or unused before for the purpose. The true question is, whether the *combination* of materials by the patentee is substantially new.

The public use or sale of an invention, in order to deprive the inventor of his right to a patent, must be a public use or sale by others, with his knowledge and consent, and before his application therefor. A sale or use of it, with such knowledge or consent, in the intermediate time between the application for a patent and a grant thereof, has no such effect.

The Court will give a liberal construction to the language of all patents and specifications; and will, in all cases, by taking the whole together, adopt * that interpretation of a specification, which will give the [* 515] fullest effect to the nature and extent of the claim made by the inventor.

The inventor of a new compound, wholly unknown before, is not limited to the use always of the same precise ingredients in making that compound; and if the same purpose can be accomplished by him by the substitution in part of other ingredients in the composition, which have never been so used before,

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he is at liberty to extend his patent so as to embrace them also. Thus, where an inventor claimed as his invention the combination of phosphorus with chalk, or any other absorbent earth or earthy material, and glue, or any other glutinous substance, using the materials in the proportions substantially as set forth in the specification, in making matches; it was held, that the patent was not void as being too broad and comprehensive.

CASE for an infringement of a patent for "a new and useful improvement in the manufacture of friction matches for the instantaneous production of light." Plea, the general issue; with notice of special matters of defence. At the trial, it appeared, that the patent was obtained by Alonzo D. Phillips, of Springfield, Massachusetts, on the 24th of October, 1836, and had since been assigned to the plaintiffs.

The common proofs, that Phillips was the inventor; that it was a useful invention; and that the defendant had used the same, were all offered to the jury. The defence turned upon the following points, which were stated in the special notice. 1. That Phillips was not the original inventor. 2. That the invention was publicly known, and in public use in divers parts of the United States, (specifying the places and persons,) before the supposed invention of the plaintiff. 3. That the invention was in public use, and the sale with the consent and allowance of Phillips in divers parts of the United States, and particularly in Massachusetts, Connecticut, New Hampshire, New York, and Philadelphia, before the application of Phillips for a patent therefor, specifying the names of the persons, who so used and sold the same. 4. That the specification annexed to the patent was vague, ambiguous, and uncertain, and did not describe in a full, clear, and exact manner, and [* 516] with sufficient *certainty, the invention, and the manner of making and compounding the matches; and that the use of chalk, carbonate of lime, or other absorbent earths or materials, referred to in the specification, was wholly unnecessary and useless, and designed to mislead and deceive the public. 5. That the claim for inventing a

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mode of putting up the matches was frivolous, and the method not new.

The specification was in the following words: —

“TO ALL WHOM IT MAY CONCERN. Be it known that I, Alonzo D. Phillips, of Springfield, in the county of Hampden, and State of Massachusetts, have invented certain new and useful improvements in the mode of manufacturing friction matches, for the instantaneous production of light, which improvements consist in a new composition of matter for producing ignition, and in a new mode of putting the matches up for use, by which the danger of ignition from accidental friction, or from other causes, is obviated. And I do hereby declare that the following is a full and exact description thereof.

“The composition used in preparing the matches usually called loco-foco, and which light by slight friction, is a compound of phosphorus, chlorate of potash, sulphuret of antimony, and gum arabic or glue. That which I use consists simply of phosphorus, chalk, and glue, and in preparing it I use the ingredients in the following manner and proportions. I take one ounce of glue and dissolve it by the aid of water and heat, in the usual manner; to this glue I add four ounces of finely pulverized chalk or Spanish white, stirring it in so as to form a thick paste. I then put in one ounce of phosphorus, keeping the materials at such a degree of heat as will suffice to melt the phosphorus, and incorporate the whole together. Into this composition the matches are dipped, after being previously dipped in sulphur in the usual manner. The composition may be varied in its proportions, but those I have given I consider the best. The ingredients also may be varied; as gum arabic * or other gum may [* 517] be substituted for glue, and other absorbent earths, or materials may be used instead of the carbonate of lime.

“In order to prevent the danger from accidental ignition, I

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prepare the pine wood for my matches in the following manner. I cut my pine into thin slabs about the usual thickness of veneers ; these I cross-cut into lengths for matches, and by means of gangs of circular saws, cut these comb fashion and lengthwise of the grain of the wood leaving a portion of one end uncut, holding the strips together like the back of a comb ; the number of matches on each slab may be about a dozen. These are then dipped in the sulphur, and afterwards in the above named composition, and put up for sale by laying the slabs upon long slips of paper, cut wide enough to lap over the ends of the matches ; the slabs are then doubled up in the paper, much in the manner of papering pins. A slab, when wanted, may be taken out without disturbing the remainder, and the paper effectually removes all danger from friction.

“ What I claim as my invention, is the using of a paste, or composition to ignite by friction, consisting of phosphorus, and earthy material, and a glutinous substance only, without the addition of chlorate of potash or of any highly combustible material, such as sulphuret of antimony in addition to phosphorus. I also claim the mode herein described of putting up the matches in paper, so as to secure them from accidental friction.”

The case was argued to the jury by *S. D. Parker* and *E. Smith, Jr.*, for the plaintiffs, and by *Rand* and *Fiske* for the defendants.

STORY, J., in summing up to the jury, said : — The main points of the defence are, — 1. That the invention claimed in the letters-patent is not new. 2. That if new, the patentee had suffered his invention to be in public use and [* 518] on public * sale, long before his application for a patent. 3. That the terms of the specification are

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too vague and indefinite, and the claim too broad to support the patent.

As to the first point, it is mainly a question of fact. It is certainly not necessary, that every ingredient, or, indeed that any one ingredient used by the patentee in his invention, should be new or unused before for the purpose of making matches. The true question is, whether the combination of materials by the patentee is substantially new. Each of these ingredients may have been in the most extensive and common use, and some of them may have been used for matches, or combined with other materials for other purposes. But if they have never been combined together in the manner stated in the patent, but the combination is new, then, I take it, the invention of the combination is patentable. So far as the evidence goes, it does not appear to me, that any such combination was known, or in use before Phillips's invention. But this is a matter of fact, upon which the jury will judge. The combination is apparently very simple ; but the simplicity of an invention, so far from being an objection to it, may constitute its great excellence and value. Indeed, to produce a great result by very simple means, before unknown or unthought of, is not unfrequently the peculiar characteristic of the very highest class of minds.

As to the second point, it is clear by our law, whatever it may be by the law of England, that the public use or sale of an invention, in order to deprive the inventor of his right to a patent, must be a public use or sale by others with his knowledge and consent, before his application therefor. If the use or sale is without such knowledge or consent, or if the use be merely experimental, to ascertain the value or utility, or success of the invention, by putting it in practice, that is not such a use, as will deprive the inventor of

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[* 519] his title. Our law¹ also requires, * that the use or sale should not only be with the knowledge and consent, of the inventor, but that it should be before his application for a patent. A sale or use of it with such knowledge or consent, in the intermediate time between the application for a patent and a grant thereof, has no such effect. It furnishes no foundation to presume, that the inventor means to abandon his invention to the public ; and does not, because it is not within the words of our act, create any statute disability to assert his right to a patent. It appears from the evidence in the present case, that as early as the 15th of February, 1836, Phillips procured an original specification of his invention to be drawn up, and an application was thereupon made to the proper office for a patent. It does not appear, that any use or sale was allowed to be made by Phillips of his invention until some time afterwards, namely, in March, 1836. The delay in obtaining the patent, which was not granted until October, 1836, was solely owing to certain defects in the original specification, which was returned to the inventor, and afterwards was amended and sent back to the Patent Office. Now, if this be the real state of the facts, (and of this the jury will judge) it seems clear, that in point of law the second objection falls to the ground ; for no use or sale is shown with the knowledge and consent of the inventor, until after he had made an application for a patent.

Then as to the third point. This turns upon the supposed vagueness, and ambiguity, and uncertainty of the specification and claim of the invention thereby. The specification, after adverting to the fact, that the *loco-foco* matches, so called, are a compound of phosphorus, chlorate of potash,

¹ Act of 1793, ch. 55, sects. 3, 6. Act of 1836, ch. 357, sects. 6, 15. *Pennock v. Dialogue*, 2 Peters, R. 1 ; *ante*, 542.

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sulphuret of antimony, and gum arabic or glue, proceeds to state that the compound which he (Phillips) uses, "consists simply of phosphorus, chalk, and glue;" and he then states the mode of preparing the compound, and the proportions of the ingredients; so that as here stated, the essential difference between his own matches and those called *loco-foco*, consists in the omission of chlorate * of potash [* 520] and sulphuret of antimony, and in using in lieu thereof chalk. He then goes on to state, that "the proportions of the ingredients may be varied, and that gum arabic, or other gum, may be substituted for glue; and other absorbent earths or materials may be used instead of the carbonate of lime." He afterwards sums up his invention in the following terms. "What I claim as my invention is the using of a paste or composition to ignite by friction, consisting of phosphorus, and [an] earthy material, and a glutinous substance only, without the addition of chlorate of potash, or of any other highly combustible material, such as sulphuret of antimony, in addition to the phosphorus. I also claim the mode herein described of putting up the matches in paper, so as to secure them from accidental friction." Upon this last claim I need not say any thing, as it is not in controversy, as a part of the infringement of the patent, upon the present trial.

Now, I take it to be a clear rule of our law in favor of inventors, and to carry into effect the obvious object of the Constitution and laws in granting patents, "to promote the progress of science and useful arts," to give a liberal construction to the language of all patents and specifications, (*ut res magis valeat, quam pereat*,) so as to protect, and not to destroy the rights of real inventors. If, therefore, there be any ambiguity or uncertainty in any part of the specification; yet, if taking the whole together, the Court can perceive the exact nature and extent of the claim made by the inventor, it

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is bound to adopt that interpretation, and to give it full effect. I confess, that I do not perceive any ground for real doubt in the present specification. The inventor claims as his invention the combination of phosphorus with chalk or any other absorbent earth, or earthy material, and glue, or any other glutinous substance in making matches, using the ingredients in the proportions, substantially as set forth in the specification. Now, the question is, whether such a claim [* 521] is good, or whether it is void, as being too * broad and comprehensive. The argument seems to be, that the inventor has not confined his claim to the use of chalk, but has extended it to the use of any other absorbent earths or earthy materials, which is too general. So, he has not confined it to the use of glue, or even of gum arabic, but has extended it also to any other gum or glutinous substance, which is also too general. Now, it is observable, that the Patent Act of 1793, ch. 55, does not limit the inventor to one single mode, or one single set of ingredients, to carry into effect his invention. He may claim as many modes, as he pleases, provided always, that the claim is limited to such as he has invented, and as are substantially new. Indeed, in one section, (§ 3,) the act requires, in the case of a machine, that the inventor shall fully explain the principle, and the several modes, in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions. The same enactment exists in the Patent Act of 1836, ch. 357, sec. 6. I do not know of any principle of law, which declares, that, if a man makes a new compound, wholly unknown before for a useful and valuable purpose, he is limited to the use of the same precise ingredients in making that compound ; and that, if the same purpose can be accomplished by him by the substitution in part of other ingredients in the composition, he is not at liberty to extend his patent so as to embrace them also. It is true, that

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in such a case he runs the risk of having his patent avoided, if either of the combinations, the original, or the substituted, have been known or used before in the like combination. But, if all the various combinations are equally new, I do not perceive how his claim can be said to be too broad. It is not more broad than his invention. There is no proof in the present case, that the ingredients enumerated in this specification, whether chalk, or any other absorbent earth, or earthy substance, were ever before combined with phosphorus, and glue, or any other gum or other glutinous substance, to produce a compound for matches. The * ob- [* 522] jection, so far as it here applies, is not, that these gums or earths have been before so combined with phosphorus, but that the inventor extends his claim, so as to include all such combinations. There is no pretence to say, upon the evidence, that the specification was intended to deceive the public, or that it included other earthy materials than chalk, or other glutinous substances than glue, for the very purpose of misleading the public. The party has stated frankly, what he deems the best materials — phosphorus, chalk, and glue, and the proportions and mode of combining them. But, because he says, that there may be substitutes of the same general character, which may serve the same purpose, thereby to exclude other persons from evading his patent, and depriving him of his invention, by using one or more of the substitutes, if the patent had been confined to the combination solely of phosphorus, chalk, and glue, I cannot hold that his claim is too broad, or that it is void. My present impression is, that the objection is not well founded. Suppose the invention had been of a machine, and the inventor had said, I use a wheel in a certain part of the machine for a certain purpose, but the same effect may be produced by a crank, or a lever, or a toggle joint, and therefore I claim those modes also; it would hardly be contended, that such a claim would avoid his pa-

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tent. I do not know, that it has ever been decided, that, if the claim of an inventor for an invention of a compound states the ingredients truly, which the inventor uses to produce the intended effect, the suggestion, that other ingredients of a kindred nature may be substituted for some part of them, has been held to avoid the patent *in toto*, so as to make it bad, for what is specifically stated. In the present case it is not necessary to consider that point. My opinion is, that the specification is not, in point of law, void, from its vagueness, or generality, or uncertainty.

The jury found a verdict for the plaintiff.

Judgment accordingly.

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[3 Sumner, 535. May T. 1839.]

Patents are entitled to a liberal construction, since they are not granted as restrictions upon the rights of the community, but "to promote science and useful arts."

A patent will not be valid, which is simply for a principle or function detached from machinery.

Congress has general power, under the Constitution of the United States, to grant patents to inventors; and it rests in the sound discretion of Congress to say, when and for what length of time, and under what circumstances, the patent for an invention shall be granted. Therefore, an Act of Congress, granting a patent, was not unconstitutional, though it operated retrospectively to give a patent for an invention, which, though made by the patentee, was in public use, and enjoyed by the community at the time of the passage of the act.

A patent was granted by Act of Congress of 1834, ch. 213, but declared void by the Court, on the ground of a defect in the act. Afterwards the grant of the patent was renewed by another Act of Congress, (1839, ch. 14.) *Quære*, whether the latter act would be constitutional, if it gave damages for the construction or use of the machine before the grant of the patent under the act.

An act of Congress ought to be construed so as not to operate retrospectively or *ex post facto*, unless that construction is unavoidable.

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CASE for violation of a patent-right. An action between the same parties for an alleged violation of a patent under the Act of Congress of 1834, ch. 213, was dismissed at a former term. (See *ante*, p. 33.) Since then a new grant of letters-patent was made by Act of Congress, 1839, ch. 14, under which the present action was brought.

The plaintiff's declaration set forth the grant of letters-patent to him for his invention, on the 6th of September, 1819; that these letters were cancelled, being deemed inoperative by reason of a defective specification, happening through inadvertency and mistake, without any fraudulent or deceptive intention; that new letters-patent for the same invention were granted to him on the 20th of January, 1820, for the term of fourteen years; * that [* 536] afterwards, by an Act of Congress, passed the 30th of June, 1834, there was granted to the plaintiff the right of making, using, and vending his invention, for the term of fourteen years from January 12, 1834, which in the said act was described as "An invention of a machine for turning or cutting irregular forms," a description of which is given in a schedule or specification, annexed to the letters-patent granted to the plaintiff for the said invention, which said letters-patent are in the said act by mistake stated to have been granted on the 12th of January, 1820, when in fact, the letters-patent last above-mentioned were meant and intended to be referred to; that by an Act of Congress, passed 6th of February, 1839, entitled "An Act to amend and carry into effect an act entitled an act to renew the patent of Thomas Blanchard," approved June 30th, 1834, it was enacted, that the rights secured to the plaintiff by letters-patent granted on the 6th of September, 1819, and afterwards on a corrected specification on the 20th of January, 1820, be granted to the plaintiff for the further term of fourteen years from January 20th, 1834; and the declaration alleged an infringement by the

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defendant by using the machine within the term mentioned in the last act. These are the material parts of the declaration, which recited at length both the acts last referred to, and set forth the above facts.

The facts, so far as they related to the granting of the letters-patent, and the acts passed with a view to the renewal of them, were not contested. The second letters-patent were granted before the Act of July 3d, 1832.

The plaintiff, in his specification declared, that "as to the mechanical powers, by which the movements are obtained, he claims none of them as his invention. These movements may be effected by application of various powers indifferently. Neither does he claim as his invention the cutter wheel or cutters, or friction wheel as such, nor the use of a model to guide the cutting instrument as his invention. All

[* 537] these are common * property, and have been so for years, but he claims as his invention the method or mode of operation in the abstract explained in the second article, whereby the infinite variety of forms, described in general terms in this article, may be turned or wrought." In another part of his specification he said: "In explaining and describing the different modes, in which he contemplates the application of the principle or character of his said machine, or invention, he does this in compliance with the requirements of the law, and not by way of extending his claim for discovery or invention. His invention is described and explained in the second article of this specification, to which reference is hereby made for information of that which constitutes the principle or character of his machine or invention, and distinguishes it, as he verily believes, from all other machines, discoveries, or inventions, known or used before."

In the second article, to which he refers, the plaintiff explained the principle and character of his machine, and the mode of constructing it to effect the different objects to be

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accomplished, and the mode of operation. This was done at considerable length.

The parties agreed to submit the matters of fact in dispute to a master, instead of a jury, who was to report the facts and his opinion thereupon to the Court, in order that his report might be accepted or rejected, as might be deemed right upon a revision of the evidence to be reported, and that the Court might decide upon the whole case for the plaintiff or the defendant; and if the decision should be for the plaintiff, damages were to be assessed according to an agreement between the parties.

After the examination of a great number of witnesses, most of whom were practical engineers or machinists, occupying the greater part of eighteen days, and hearing the counsel on both sides, upon the various questions raised, the master reported the facts, and the testimony and proofs, from which he drew his * conclusions. And upon the *first* [* 538] *question*, whether the plaintiff's specification was couched in terms so full, clear and exact, as to distinguish it from all other inventions, and to enable any machinist, reasonably and competently skilled in the business, to construct the machine, in all its forms, from the directions there given and other drawings annexed, the master reported his opinion in the affirmative. Upon the *second question*, whether there was a mode, clearly described in the specification of constructing a machine capable of producing, from one model or pattern, different sizes, preserving the proportions as stated in the specification, he reported that a mode was described of effecting it sufficiently near for all practical purposes. Upon the *third question*, whether the machine patented and claimed, or any material part thereof, was known or used before the invention thereof by the plaintiff, and particularly, whether it was so known to one Woolworth, he reported in the negative. Upon the *fourth question*, whether the rights

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secured as alleged in the declaration, had been infringed by the defendant, he reported in the affirmative, and assessed damages at \$521.27.

Upon the hearing before the Court upon the whole case, it was contended by the counsel for the defendant, that the plaintiff's specification was defective, that he claimed the functions of the machine, and not the machine itself, and that the description of the machine, so far as it related to the making of things of different sizes from the same model, as well as to the designation of what was intended to be claimed, was unintelligible and wholly insufficient. It was also contended, that the last act for renewing the letters-patent was inoperative, inasmuch as it granted only the rights secured by the patents of September 6, 1819, and January 20th, 1820, both of which were supposed to be void; and that the act was also retrospective, so far as it regarded those who had used the machine between the time of the expiration of the letters-patent and the renewal of them by the last mentioned act.

[* 539] *B. Rand* and *Fiske*, for the plaintiff.

Willard Phillips and *Parsons*, for the defendant.

STORY, J. My opinion is, that the master has drawn the true conclusions from the facts, which are stated in his report; and I have not the slightest hesitation in adopting them as the basis of my own opinion. The objections, which have been taken at the argument to the present patent granted to the plaintiff by the Act of Congress of the 6th day of February, 1839, ch. 14, I shall now proceed to dispose of, in as few words as may be practicable. In the first place, as to the point, whether the plaintiff has sufficiently expressed in his specification the true nature, character, and extent of the invention, which he claims. I am of opinion that he has.

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Formerly, in England, courts of law were disposed to indulge in a very close and strict construction of the specifications, accompanying patents, and expressing the nature and extent of the invention. This construction seems to have been adopted upon the notion, that patent-rights were in the nature of monopolies, and, therefore, were to be narrowly watched, and construed with a rigid adherence to their terms, as being in derogation of the general rights of the community. At present a far more liberal and expanded view of the subject is taken. Patents for inventions are now treated as a just reward to ingenious men, and as highly beneficial to the public, not only as holding out suitable encouragements to genius and talents and enterprise, but as ultimately securing to the whole community great advantages from the free communication of secrets, and processes, and machinery, which may be most important to all the great interests of society, to agriculture, to commerce and to manufactures, as well as to the cause of science and art.

In America, this liberal view of the subject has always been taken; and, indeed, it is a natural, if not a necessary result, from the very language and intent of the power given to Congress * by the Constitution, on this sub- [* 540] ject. "Congress" (says the Constitution) "shall have power to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right of their respective writings and discoveries." Patents then are clearly entitled to a liberal construction, since they are not granted as restrictions upon the rights of the community, but are granted "to promote science and useful arts."

Looking at the present specification, and construing all its terms together, I am clearly of opinion, that it is not a patent claimed for a function; but it is claimed for the machine specially described in the specification; that it is not for a mere

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function but for a function as embodied in a particular machine, whose mode of operation and general structure are pointed out. In the close of his specification, the patentee explicitly states, that his "invention is described and explained in the second article of his specification, to which reference is made for information of that, which constitutes the principle or character of his machine or invention, and distinguishes it, as he verily believes, from all other machines, discoveries, or inventions known or used before." Now, when we turn to the second article, we find there described, not a mere function, but a machine of a particular structure whose modes of operation are pointed out, to accomplish a particular purpose, function, or end. This seems to me sufficiently expressive to define and ascertain, what his invention is. It is a particular machine, constituted in the way pointed out, for the accomplishment of a particular end or object. The patent is for a machine, and not for a principle or function detached from machinery.

Then it is objected, that the description of the mode of constructing the machine is so defective, that it is not practicable for persons skilled in the art or science to which it belongs or relates, to construct the machine. This objection is put an end to by the master's report, and the facts there stated by intelligent witnesses.

[* 541] * Then, it is suggested, that the grant of the patent by the Act of Congress of 1839, ch. 14, is not constitutional; for it operates retrospectively to give a patent for an invention, which, though made by the patentee, was in public use and enjoyed by the community at the time of the passage of the act. But this objection is fairly put at rest by the decision of the Supreme Court in the case of the patent of Oliver Evans. *Evans v. Eaton*, (3 Wheat. R. 545.)¹

¹ See, also, *Evans v. Eaton*, 7 Wheat. R. 356, *ante*, 336; *Evans v. Hettich*, *Id.* 453, *ante*, 417.

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For myself, I never have entertained any doubt of the constitutional authority of Congress to make such a grant. The power is general, to grant to inventors; and it rests in the sound discretion of Congress to say, when and for what length of time and under what circumstances the patent for an invention shall be granted. There is no restriction, which limits the power of Congress to enact, where the invention has not been known or used by the public. All that is required is, that the patentee should be the inventor.¹

The only remaining objection is, that the act is unconstitutional, because it makes the use of a machine constructed and used between the time of the passage of the Act of 1834, ch. 213, and the grant of the patent under the Act of 1839, ch. 14, unlawful, although it has been formerly decided, that under the Act of 1834 the plaintiff had no valid patent; and so the defendant, if he constructed and used the machine during that period, did lawful acts, and cannot now be retrospectively made a wrong-doer. If this were the true result of the language of the act it might require a good deal of consideration. But I do not understand, that the act gives the patentee any damages for the construction or use of the machine, except after the grant of the patent under the Act of 1839, ch. 14. If the language of the act were ambiguous, the Court would give it this construction, so that it might not be deemed to create torts *retrospec- [* 542] tively, or to make men liable for damages for acts, lawful at the time when they were done. The act of Congress passed in general terms ought to be so construed, if it may, as to be deemed a just exercise of constitutional authority. And not only so, but it ought to be construed, not to operate retrospectively, or *ex post facto*, unless that con-

1 Ibid.

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struction is unavoidable ; for even if a retrospective act is, or may be constitutional, I think I may say, that, according to the theory of our jurisprudence, that interpretation is never adopted without absolute necessity ; and courts of justice always lean to a more benign construction. But, in the present case, there is no claim for any damages, but such as have accrued to the patentee from a use of his machine since the grant of the patent under the Act of 1839, ch. 14.

I am, therefore, of opinion, that there ought to be judgment for the plaintiff for the damages, agreed by the parties. Judgment accordingly.

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[2 Story, 164. May T. 1839.]

Patents for inventions are not granted as monopolies or restrictions upon the rights of the community, but "to promote science and the useful arts," and are to be liberally construed.

The power of Congress to grant to inventors is general ; and it is in their discretion to say, when, and for what length of time, and under what circumstances, the patent for an invention shall be granted.

Congress has power to pass an act, which operates retrospectively to give a patent for an invention already in public use ; but no act will be construed to operate retrospectively, unless such a construction is unavoidable.

In the present case, *It was held*, that the patent was for a machine, and not for a principle or function ; and therefore was valid.

THIS was an action on the case for the infringement of a patent-right of "a machine for turning and cutting irregular forms."

The facts were as follows : Letters-patent were granted to the plaintiff on the 6th of September, 1819 ; and being

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deemed inoperative, by reason of a defective specification, * new letters-patent were granted on the [* 165] 20th of January, 1820, for the space of fourteen years. Afterward, by Act of Congress passed the 30th of June, 1834, the sole right was granted to the plaintiff, to make, use, and vend his invention for the term of fourteen years, from the 12th of January, 1834. This act not being thought to describe with sufficient accuracy the letters-patent, to which it was intended to refer, an additional act was passed on the 6th of February, 1839, renewing the Act of the 30th of June, 1834, and correcting the date of the 12th of January, 1834, to the 20th of January, 1834. The last act was as follows:

" An Act to amend and carry into effect the intention of an act entitled an act to renew the patent of Thomas Blanchard, approved June 30th, 1834.

" Sec. 1. Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the rights secured to Thomas Blanchard, a citizen of the United States, by letters-patent granted on the sixth of September, eighteen hundred and nineteen, and afterwards on a corrected specification on the twentieth day of January, Anno Domini eighteen hundred and twenty, be granted to the said Blanchard, his heirs and assigns, for the farther term of fourteen years from the twentieth of January, eighteen hundred and thirty-four, said invention so secured being described in said last mentioned letters as an engine for turning or cutting irregular forms out of wood, iron, brass, or other material which can be cut by ordinary tools. Provided, that all rights and privileges heretofore sold or granted by said patentee to make, construct, use, or vend the said invention, and not forfeited by the purchasers or grantees, shall enure to and be enjoyed by such purchasers or grantees respectively, as fully and upon the same conditions during the

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period hereby granted as for the term that did exist when such sale or grant was made.

[* 166] “Sec. 2. And be it further enacted, that any person who had *bonâ fide* erected or constructed any manufacture or machine for the purpose of putting said invention into use, in any of its modifications, or was so erecting or constructing any manufacture or machine for the purpose aforesaid, between the period of the expiration of the patent heretofore granted on the thirtieth day of June, one thousand eight hundred and thirty-four, shall have and enjoy the right of using said invention in any such manufacture or machine erected or erecting as aforesaid, in all respects as though this act had not passed. Provided, that no person shall be entitled to the right and privilege by this section granted, who has infringed the patent-right and privilege heretofore granted, by actually using or vending said machine before the expiration of said patent, without grant or license from said patentee or his assignees to use or vend the same.

“Approved, February 6th, 1839.”

The plaintiff, in his specification, declares, that “As to the mechanical powers by which the movements are obtained, he claims none of them as his invention. These movements may be effected by application of various powers indifferently. Neither does he claim as his invention the cutter wheel or cutters, or friction wheel as such, nor the use of a model to guide the cutting instrument as his invention. All these are common property, and have been so for years. But he claims as his invention the method or mode of operation in the abstract explained in the second article, whereby the infinite variety of forms, described in general terms in this article, may be turned or wrought.” In another part of his specification he says, “In explaining and describing the different modes in which he contemplates the application of the prin-

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ciple or character of his said machine, or invention, he does this in compliance with the requirements of the law, and not * by way of extending his claim for [* 167] discovery or invention. His invention is described and explained in the second article of this specification, to which reference is hereby made for information of that which constitutes the principle or character of his machine or invention, and distinguishes it, as he verily believes, from all other machines, discoveries, or inventions, known or used before."

In the second article, to which he refers, the plaintiff explains the principle and character of his machine, and the mode of constructing it to effect the different objects to be accomplished, and the mode of operation. This is done at considerable length.

The parties agreed to submit the matters of fact in dispute to a master instead of a jury, who should report the facts and his opinion thereupon to the Court, in order that his report might be accepted or rejected, as might be deemed right upon a revision of the evidence to be reported, and that the Court might decide upon the whole case for the plaintiff or the defendant; and if the decision should be for the plaintiff, damages were to be assessed according to an agreement between the parties. The substance of the master's report was as follows:

Upon the first question, whether the plaintiff's specification is couched in terms so full, clear, and exact, as to distinguish it from all other inventions, and to enable any machinist, reasonably and competently skilled in the business, to construct the machine, in all its forms, from the directions there given and other drawings annexed, the master reported his opinion in the affirmative. Upon the second question, whether there is a mode, clearly described in the specification, of constructing a machine capable of producing, from one model or pattern, different sizes, preserving the proportions

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as stated in the specification, he reported, that a mode was described of effecting it sufficiently clear for all [* 168] practical * purposes. Upon the third question, whether the machine patented and claimed, or any material part thereof, was known or used before the invention thereof by the plaintiff, and particularly whether it was so known to one Woodworth, he reported in the negative. Upon the fourth question, whether the rights secured as alleged in the declaration, had been infringed by the defendant, he reported in the affirmative, and assessed damages at \$521.27.

Upon the hearing before the Court upon the whole case, it was contended by the counsel for the defendant, that the plaintiff's specification was defective, that he claimed the functions of the machine and not the machine itself, and that the description of the machine, so far as it related to the making of things of different sizes from the same model, as well as to the designation of what was intended to be claimed, was unintelligible and wholly insufficient. It was also contended, that the last act for renewing the letters-patent was inoperative, inasmuch as it granted only the rights secured by the patents of September 6th, 1819, and January 20th, 1820, both of which were supposed to be void; and that the act was also retrospective, so far as it regarded those who had used the machine between the time of the expiration of the letters-patent, and the renewal of them by the last mentioned act.

Rund and Fiske for the plaintiff. *W. Phillips and Parsons*, for the defendant.

STORY, J. My opinion is, that the master has drawn the true conclusions from the facts, which are stated in his report; and I have not the slightest hesitation in adopting them

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as the basis of my own opinion. The objections, which have been taken at the argument to the present patent, granted to the plaintiff by the Act of Congress of sixth day of February, 1839, ch. 14, I shall now proceed to dispose of, in as few * words as may be practicable. In the first [* 169] place, as to the point, whether the plaintiff has sufficiently expressed in his specification the true nature, character, and extent of the invention, which he claims. I am of opinion that he has. Formerly in England, courts of law were disposed to indulge in a very close and strict construction of the specifications accompanying patents, and expressing the nature and extent of the invention. This construction seems to have been adopted upon the notion, that patent-rights were in the nature of monopolies, and therefore were to be narrowly watched, and construed with a rigid adherence to their terms, as being in derogation of the general rights of the community. At present a far more liberal and expanded view of the subject is taken. ~~Patents~~ for inventions are now treated as a just reward to ingenious men, and as highly beneficial to the public, not only by holding out suitable encouragements to genius and talents, and enterprise; but as ultimately securing to the whole community great advantages from the free communication of secrets and processes, and machinery, which may be most important to all the great interests of society, to agriculture, to commerce, and to manufactures, as well as to the cause of science and art.

In America this liberal view of the subject has always been taken; and indeed it is a natural, if not a necessary result from the very language and intent of the power given to Congress by the Constitution on this subject. Congress (says the Constitution) shall have power "To promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective

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writings and discoveries." Patents then are clearly entitled to a liberal construction, since they are granted not as restrictions upon the rights of the community, but are granted "to promote science and useful arts."

Looking at the present specification, and construing [* 170] all its * terms together, I am clearly of opinion, that it is not a patent claimed for a mere function ; but it is claimed for the machine specially described in the specification ; that is, for a function as embodied in a particular machine, whose mode of operation and general structure are pointed out. In the close of his specification, the patentee explicitly states that his "invention is described and explained in the second article of his specification, to which reference is made for information of that which constitutes the principle or character of his machine or invention, and distinguishes it, as he verily believes, from all other machines, discoveries, or inventions known or used before." Now, when we turn to the ~~second article~~, we find there described not a mere function, but a machine of a particular structure, whose modes of operation are pointed out, to accomplish a particular purpose, function, or end. This seems to me sufficiently expressive to define and ascertain what his invention is. It is a particular machine, constituted in the way pointed out, for the accomplishment of a particular end or object. The patent is for a machine, and not for a principle or function detached from machinery.

Then, it is objected, that the description of the mode of constructing the machine is so defective, that it is not practicable for persons skilled in the art or science to which it belongs or relates, to construct the machine. This objection is put an end to by the master's report, and the facts there stated by intelligent witnesses.

Then, it is suggested, that the grant of the patent by the Act of Congress of 1839, ch. 14, is not constitutional ; for it

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operates retrospectively to give a patent for an invention, which, though made by the patentee, was in public use and enjoyed by the community at the time of the passage of the act. But this objection is fairly put at rest by the decision of the Supreme Court in the case of the patent of Oliver Evans. *Evans v. Eaton, (3 Wheat. R. [*171] 545).¹ For myself, I never have entertained any doubt of the constitutional authority of Congress to make such a grant. The power is general to grant to inventors; and it rests in the sound discretion of Congress to say, when and for what length of time and under what circumstances the patent for an invention shall be granted. There is no restriction which limits the power of Congress to cases where the invention has not been known or used by the public. All that is required is, that the patentee should be the inventor.¹

The only remaining objection is, that the act is unconstitutional, because it makes the use of a machine constructed and used before the time of the passage of the Act of 1834, ch. 213, and the grant of the patent under the Act of 1839, ch. 14, unlawful, although it has been formerly decided, that under the Act of 1834 the plaintiff had no valid patent; and so the defendant, if he constructed and used the machine during that period, did lawful acts, and cannot now be retrospectively made a wrong-doer. If this were the true result of the language of the act, it might require a good deal of consideration. But I do not understand, that the act gives the patentee any damages for the construction or use of the machine except after the grant of patent under the Act of 1839, ch. 14. If the language of the act were ambiguous the Court would give it this construction, so that it might not be deemed to create rights retrospectively, or to make men

¹ See also Evans v. Eaton, 7 Wheat. R. 356, *ante*, 386; Evans v. Hettich, 7 Wheat. R. 458, *ante*, 417.

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liable for damages for acts lawful at the time when they were done. The Act of Congress passed in general terms ought to be so construed, if it may, as to be deemed a just exercise of constitutional authority ; and not only so, but it ought to be construed not to operate retrospectively, or *ex post facto*, unless that construction is unavoidable ; for even if a retrospective act is or may be constitutional, I think I may say that, according to the theory of our jurisprudence, such an interpretation is never adopted without absolute necessity ; and courts of justice always lean to a more benign construction. But in the present case there is no claim for any damages but such as have accrued to the patentee from a use of his machine since the grant of the patent under the Act of 1839, ch. 14.

I am, therefore, of opinion, that there ought to be judgment for the plaintiff for the damages agreed by the parties.

Judgment accordingly.

END OF VOL I.

[illegible]



